(21,425.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1910.

No. 106.

STANDARD PAINT COMPANY, APPELLANT,

vs.

TRINIDAD ASPHALT MANUFACTURING COMPANY.

APPEAL FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

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aa Pleas and proceedings in the United States Circuit Court of Appeals for the Eighth Circuit, at the May Term, 1908, of said Court, begun and held at the United States Court House in the City of St. Paul, Minnesota, on the first Monday in May, to-wit: the fourth day of May, A. D. 1908, before the Honorable Walter H. Sanborn, the Honorable William C. Hook and the Honorable Elmer B. Adams, Circuit Judges.

[Seal United States Circuit Court of Appeals, Eighth Circuit.]

Attest:

JOHN D. JORDAN,
Clerk of the United States Circuit Court of Appeals for the Eighth Circuit.

Be it Remembered that heretofore, to-wit: on the sixteenth day of May, A. D. 1907, a transcript of record pursuant to an appeal allowed by the Circuit Court of the United States for the Eastern District of Missouri was filed in the office of the Clerk of the United States Circuit Court of Appeals for the Eighth Circuit in a certain cause wherein the Trinidad Asphalt Manufacturing Company was Appellant and the Standard Paint Company was Appellee, which said transcript of record is in the words and figures following, to-wit:

a The United States of America to Standard Paint Company, a Corporation, Greeting:

You are hereby cited and admonished to be and appear in the United States Circuit Court of Appeals, Eighth Circuit, at St. Louis, Missouri, sixty days from and after the day this Citation bears date, pursuant to order granting appeal filed in the Clerk's office of the Circuit Court of the United States for the Eastern Division of the Eastern Judicial District of Missouri, wherein Trinidad Asphalt Manufacturing Company, a corporation, is appellant, and you are appellee, to show cause, if any there be, why the decree rendered against the said appellant, as in order allowing appeal mentioned, should not be corrected, and why speedy justice should not be done the parties in that behalf.

Witness, the Honorable G. A. Finkelnburg Judge of the Circuit Court of the United States for the Eastern District of Missouri, this eighteenth day of March in the year of our Lord one thousand nine hundred and seven.

G. A. FINKELNBURG,
United States District Judge for the Eastern District of Missouri.

Service of the within Citation accepted this 18th day of March 1907.

JUDSON & GREEN,
Solicitors for Standard Paint Company.

No. 5174. United States Circuit Court, Eastern Division of the Eastern Judicial District of Missouri. Standard Paint Co., vs. Trinidad Asphalt Manufacturing Co. Citation. Filed Mar. 18, 1907. James R. Gray, Clerk.

UNITED STATES OF AMERICA,
Eastern Division of the Eastern Judicial District of Missouri, ss:

In the Circuit Court of the United States Eastern Division of the Eastern Judicial District of Missouri.

Be it Remembered: that on the 13th day of May, A. D. 1907 there was filed in the Clerk's office of said Court, a stipulation which is in words and figures following, to-wit:

b *Stipulation as to Transcript.*

In the Circuit Court of the United States in and for the Eastern Division of the Eastern Judicial District of Missouri.

STANDARD PAINT COMPANY, Complainant,
v.
TRINIDAD ASPHALT MANUFACTURING COMPANY, Defendant.

Stipulation Regarding Record on Appeal to the United States Circuit Court of Appeals for the Eighth Circuit.

It is hereby stipulated and agreed by and between Standard Paint Company, complainant, and Trinidad Asphalt Manufacturing Company, defendant, that in making up the record for appeal in the above entitled cause to the United States Circuit Court of Appeals for the Eighth Circuit, the Clerk of the Circuit Court of the United States in and for the Eastern Division of the Eastern Judicial District of Missouri shall treat the record printed in the last mentioned Court as the entire record of the pleadings and testimony in said cause, but shall add to said printed record the following exhibits:

Complainant's certificate of registration being dated May 28, 1901 and numbered 36485.

Defendant's Exhibit Defendant's Trade Mark.

Defendant's Exhibit Frary File Wrapper and Contents.

Defendant's exhibit Frary Trade Mark.

Defendant's exhibit Trade Mark Rubberoid Company.

Defendant's exhibit Clark Letters Patent No. 1 (letters patent being numbered 184341).

Defendant's exhibit Clark Letters Patent numbered 2 (Letters Patent No. 201992).

Defendant's Exhibit Jellenik's Affidavit.

Defendant's Exhibit Defendant's Label.

That in place of reproducing the whole of Defendant's Exhibit

Complainant's Advertisement No. 2, which exhibit consists of an advertising book of the complainant, the record shall contain only the first portion of said book, which shall be treated as said Defendant's Exhibit Complainant's Advertisement No. 2, for the purposes of said record and appeal, that is to say, the following words:

"Ruberoid.

"When Ruberoid was first placed on the market in 1892 it attracted considerable attention, because it was the first, and it is now the only prepared roofing made, that could be used with equal efficiency on very light, temporary structures, or a large brick, stone or iron building."

That in place of reproducing the whole of Complainant's Exhibit Advertising Matter No. 4, which exhibit consists of an advertising book of the complainant, the record shall contain only the first portion of said book, which shall be treated as the "Complainant's Exhibit Advertising Matter No. 4, for the purposes of said record and appeal, that *it* to say, the following words:

"Analysis of Ruberoid Roofing.

"Ruberoid Roofing is made of the finest quality of selected wool felt obtainable. This individual feature of the roofing, however, is the material with which every fiber of this wool is thoroughly saturated. I refer to Ruberoid Compound or "Gum," which is manufactured solely and exclusively by the Standard Paint Company, and which is not and cannot be used in any other prepared roofing. It is this fact which places Ruberoid Roofing in a class by itself, for none of the saturations commonly used equal it in efficiency and permanency. We venture to figuratively dissect a piece of the Ruberoid Roofing that we may make clear its peculiar characteristics. We will look at it with a section of Ruberoid Compound.

"In appearance this "gum" with which, in a liquid state, the roofing is saturated, resembles rubber in its crude state. In fact it was this close resemblance to rubber which suggested the name "Ruberoid," now so universally and favorably known. Holding a piece of this Ruberoid Compound between the fingers one finds that it has all the elasticity of rubber as well as all its toughness. There the similarity ceases, however, for there is absolutely no rubber composition in Ruberoid, and it partakes of none of the corrosive or oxydizing nature of the former material."

That in place of reproducing the whole of Complainant's Exhibit, Certified Copy Charter, it is mutually agreed that for the purpose of this record and appeal, and in place of said exhibit, the following portion thereof only shall be inserted in the record, that is to say:

"It is mutually agreed by and between the parties that the complainant is a corporation duly incorporated under the laws of the State of West Virginia."

JUDSON & GREEN,
Solicitor for Complainant.
W. B. HOMER,
Solicitor for Defendant.

The printed record referred to in said stipulation is in words and figures following, to-wit:

1 In the Circuit Court of the United States in and for the Eastern Division of the Eastern Judicial District of Missouri.

In Equity. No. 5174.

STANDARD PAINT COMPANY, Complainant,
vs.
TRINIDAD ASPHALT M'F'G CO., Defendant.

Abstract of Entire Record.

Pleadings.

Bill of Complaint.

The Standard Paint Company, a corporation organized under the laws of the State of West Virginia and a citizen of said State, and having its principal office and factory at Bound Brook in the State of New Jersey, brings this bill of complaint against The Trinidad Asphalt Manufacturing Company, a corporation duly organized under the laws of the State of Missouri, with its principal office in the City of St. Louis in said State, and thereupon your orator complains and says:

First. That your Orator for more than twelve (12) years has been and is now engaged in the business of manufacturing, vending, exporting and otherwise dealing in a certain kind of roofing
2 material for covering houses and other buildings, called by them "Ruberoid" roofing, but said roofing has no rubber whatsoever in its composition, and complainants have advertised said roofing very extensively under the said name "Ruberoid" roofing and have built up a large and valuable trade therein in all parts of the United States and in foreign countries, and more than twelve years since complainant adopted as a trade mark and trade name for said roofing the word "Ruberoid" and has ever since been using said word as a trade mark and trade name for said product.

Second. Said roofing is manufactured by this complainant in three different thicknesses called one (1), two (2) and three (3) ply roofing, according to the thickness thereof, and is then cut and made up into rolls, the strips of roofing on each roll being about three feet in width and about seventy feet in length, and these rolls are then covered with paper wrappers on which are printed in large type the words "Ruberoid Roofing," and inclosed therein directions for handling and laying the same, and the name of the complainant company as manufacturers.

Third. Complainant further says that for more than twelve years past it has been and now is engaged in advertising said roofing by preparing samples thereof in the form hereto attached and made part hereof as Exhibit "A," on the covers of which are printed in large

type the word "Ruberoid," followed by the words "Trade Mark registered, 1, 2 and 3 ply Ruberoid Roofing in rolls 36 inches wide, containing 216 square feet, which are sold as 200 square feet," etc.

Fourth. Complainant's said trade mark "Ruberoid" was duly registered in the Patent Office at Washington, D. C., on the
3 28th day of May, 1901, under the provisions of the statutes of the United States in such cases made and provided, a copy of said certificate of registration being hereto attached as Exhibit "C" and made part hereof. That by reason of the long experience and great care used by complainant in manufacturing said "Ruberoid" roofing, and by reason of the good and durable quality thereof, distinguished as it has been by its trade mark and trade name "Ruberoid" and the form and shape of the rolls into which it is made by complainant, and the samples thereof used by complainant in advertising the same, said roofing material has become widely and favorably known throughout all the United States and in many foreign countries, as a useful, durable, economical and valuable roofing material and has acquired a high reputation as such and has commanded and still commands an extensive sale throughout the United States and foreign countries, and its manufacture and sale has been and is a source of great profit to complainant. That said trade mark and trade name are of a value of over two thousand dollars.

Fifth. Complainant states that notwithstanding the long and quiet use and enjoyment by it of said trade mark and trade name of "Ruberoid" and of the form and descriptive matter of said packages, wrappers and labels and of the form of the sample packages above referred to, and the descriptive matter printed thereon, the defendant well knowing the premises and with the preconceived intention to injure the complainant, and with the purpose to defraud and with the purpose to deprive this complainant of the benefits and profits resulting from the great reputation acquired by complainant's said roofing, and the consequent demand therefor, and
4 with the intent to acquire for themselves the benefits and profits of said reputation, and in wilful disregard of complainant's right in the premises, has been since the 18th day of January, 1900, and is now engaged in manufacturing, advertising for sale and selling to the general public in the City of St. Louis, Missouri, and elsewhere throughout the United States, a roofing material similar in appearance to that made by complainant under the name of "Rubbero" roofing, which roofing is cut by defendant into widths and made into rolls similar in form to those made by complainant for its product, making similar thicknesses of said material and using the same terms, to-wit; "1, 2 and 3 ply" to describe these various thicknesses thereof, and which rolls are also wrapped in paper when completed on which wrappers defendant places labels bearing in large type the words "Rubbero Roofing," followed by the name of the manufacturer and directions for handling and using the same; and defendant also advertises its roofing product by sending out to prospective purchasers samples thereof prepared in the form and bearing the printed matter thereon shown by Exhibit "B"

hereto attached and made part hereof being very similar in form and printed matter thereon to the samples prepared and sent out by complainant as aforesaid. And complainant says that defendant uses said name "Rubbero" roofing to describe its roofing product because of its close resemblance and similarity to the name and trade mark "Ruberoid" adopted and used by complainant for its roofing material in order to deceive the public and the buyers and consumers thereof and in order to lead them to believe that said roofing manufactured by defendant is the "Ruberoid" roofing made by complainant, and complainant says that the public has been thereby deceived and a large amount of said roofing so manufactured and advertised by defendant has been purchased and used by consumers under the mistaken belief that it was the "Ruberoid" roofing manufactured by complainant.

Sixth. That by reason of the use of the said word "Rubbero" by defendant as a name for and to describe its said roofing material, and employment by it of the aforesaid methods of preparing and advertising the same, the business of complainants has been greatly damaged and injured and its profits have been largely reduced, and the excellent reputation of its roofing has been injured or destroyed.

Seventh. Forasmuch as your orator can have no adequate relief except in this court, and to the end therefore that defendants may, if they can, show why your orator should not have the relief hereby prayed, and may make a full disclosure and discovery of all the matters aforesaid, according to the best and utmost of their knowledge, information and belief, full, true, direct and complete answer make to the matters hereinbefore stated and charged, but not under oath answer under oath being hereby expressly waived, and that the defendant may be decreed to account for and pay over adequate damages arising from their acts aforesaid in violation of your orator's rights, your orator prays that your Honors may grant a writ of injunction issuing out of and under seal of this Honorable Court, perpetually enjoining and restraining said defendants, its officers, agents and employees from using the word "Rubbero" as a name or to describe the roofing manufactured by it, and from using said name upon any of the wrappers or labels enclosing said product, or from using said name upon any samples of its roofing or in any advertisements thereof, or from using any name of a like or similar sound for said purposes, and that defendant deliver up to your orator all wrappers, labels, samples and other advertising matter which contains said word "Rubbero," that may be in its possession or under its control, and that your Honors upon the rendition of the decree above prayed, may assess or cause to be assessed the damages your orator has sustained by reason of the premises.

May it also please your Honors to grant unto your orator a writ of subpœnae of the United States of America directed to the said defendant commanding it to appear and answer this complaint on a day certain and to bide and perform such order and decree in the premises as to the court shall seem proper and required by the principles of equity and good conscience.

JUDSON & GREEN,
Attorneys for Complainant.

UNITED STATES OF AMERICA
State of Missouri, City of St. Louis, ss:

Ralph L. Shainwald, on behalf of complainant and duly authorized to act for it herein, being first duly sworn, on his oath says that he has read the above bill of complaint, and that the matters therein set forth are true.

(Signed) RALPH L. SHAINWALD.

Subscribed and sworn to before me this 26th day of April, 1905. My term expires March 30, 1906.

(Signed) FELIX JELLEUIK,
Notary Public.

7 *Affidavit of J. N. Richards Attached to the Bill of Complaint.*

STATE OF NEW YORK,
County of ——, ss:

J. N. Richards, being first duly sworn, on his oath states that he is the manager sales department of the Standard Paint Company, which company is engaged in manufacturing and selling "Ruberoid" roofing, and that said company has been engaged in the manufacture and sale of said "Rubberoid" roofing for the past twelve years.

Affiant furt[illegible]ays that said company has built up an extensive and profitable trade in said roofing material and sells the same in all parts of the United States, in the Dominion of Canada and in foreign countries, and has advertised the said roofing product very extensively under the name of "Ruberoid" roofing, and said roofing product is known to the trade and the general public by the said name of "Ruberoid" roofing and the said word "Ruberoid" has for the last twelve years been so adopted and used by the said Standard Paint Company as a trade mark and trade name for said roofing product. Affiant further says that the said word "Ruberoid" is a purely fanciful or arbitrary term, and is not descriptive of any materials used in the manufacture of said roofing, there being no rubber and no product of rubber whatsoever used in its manufacture. Affiant further says that the Trinidad Asphalt Manufacturing Company is and has for a year or more been engaged in manufacturing and selling a roofing product similar in appearance to the "Ruberoid" roofing made by the Standard Paint Company, which
8 said roofing so made by said Trinidad Asphalt Manufacturing Company has been and is being extensively advertised and sold to the general public under the name of "RubberO" roofing, and affiant say- that the word "RubberO" is not descriptive of any material used in the manufacture of said roofing by said Trinidad Asphalt Manufacturing Company; that no rubber and no product of rubber is used in manufacturing the same and the said word "RubberO" is a purely fanciful or arbitrary term adopted and used by said Trinidad Asphalt Manufacturing Co., because of its simi-

larity to the name "Ruberoid" used by the said Standard Paint Co. to designate its roofing product. Affiant further says that the resemblance between the two terms "Ruberoid" and "RubberO" is such as to mislead consumers and the general public and cause them to confuse the two said roofing products, and many consumers have ordered and purchased "RubberO" roofing from the said Trinidad Asphalt Manufacturing Co. under the mistaken impression that they were ordering the "Ruberoid" roofing made by the said Standard Paint Co., as appears from the letter of Keith Summons & Co. hereto attached and made part hereof as Exhibit "A."

Affiant further says that the Standard Paint Co. has requested said Trinidad Asphalt Manufacturing Co. to discontinue the use of the name "RubberO" for its roofing product, which request it has refused to comply with, as appears from the letter of its attorney copy of which is hereto attached and made part hereof as Exhibit "B." And further, Affiant saith not.

[SEAL.] (Signed) J. N. RICHARDS.

Sworn to and subscribed before me this 15th day of May, 1905.
My term expires ——.

(Signed) FELIX JELLEUIK,
Notary Public.

9 *Amended Answer of Defendant.*

The said defendant, saving and reserving unto itself all and all manner of advantage or exception to the manifold insufficiencies of the said bill of complaint, thereunto answering says, that the Trinidad Asphalt Manufacturing Company is a corporation duly incorporated under the laws of the State of Missouri with its principal office in the City of St. Louis in said State; and further says that it has no knowledge whether the complainant is a corporation organized under the laws of the State of West Virginia, or is a citizen of the said State, or has its principal office and factory at Bound Brook in the State of New Jersey.

And this defendant denies on information and belief that the complainant for more than twelve years has been engaged in the business of manufacturing, vending, exporting and otherwise dealing in a certain kind of roofing material for covering houses and other buildings called "Ruberoid" roofing, and further denies on information and belief that the complainant has advertised said roofing very extensively under the said name "Ruberoid" roofing and has built up a large and valuable trade therein in all parts of the United States and in foreign countries, or that for more than twelve years since complainant adopted as a trade mark and trade name and has been using said word as a trade mark and trade name; and defendant on information and belief further denies that for more than twelve years past complainant has been engaged in advertising said roofing by preparing samples therefor in the form attached to complainant's bill as Exhibit "A" on the covers of

which are printed in large type the word "Ruberoid" followed
10 by the words "Trade Mark registered, one two and three ply Ruberoid Roofing in rolls 36 inches wide, containing 216 square feet which are sold as 200 square feet."

Defendant further says that it has no knowledge, except as stated in said bill of complaint, whether the complainant's alleged trade mark was registered in the Patent Office at Washington, D. C., on the 28th day of May, 1901, or at any other time.

This defendant on information and belief denies that by reason of long experience and great care alleged to have been used by complainant in manufacturing said "Ruberoid" roofing, or by reason of the good and durable quality thereof distinguished by its alleged trade mark and trade name, the form and shape of the rolls into which it is made by complainant, or the samples used by complainant in advertising the same, the said roofing material has become widely and favorably known throughout the United States and in many foreign countries as a useful, durable, economical and valuable roofing material, or has acquired a high reputation as such and still commands an extensive sale throughout the United States and foreign countries, or that its manufacture and sale has been or is a source of great profit to complainant, or that said alleged trade mark and trade name are of the value of two thousand dollars.

This defendant further denies that it has had any intention to injure the complainant or any purpose to defraud the complainant or any purpose to deprive the complainant of the alleged benefits and profits of any reputation which complainant's roofing has acquired, or to acquire for itself any benefits or profits of the said alleged reputation of the said alleged trade mark.

11 This defendant says that it is engaged largely in selling and advertising to the general public in the City of St. Louis and elsewhere a roofing under the trade mark of "RubberO" roofing; and that this name is so dissimilar in appearance and the labels which are used upon the manufactured product are so diverse from complainant's alleged trade mark or trade name that the public could not, and never has been in any way deceived into buying any of the product of the defendant believing the same to have been the product of the complainant.

This defendant says that it is true that the roofing of complainant and defendant are both cut into widths and made into rolls similar in form and that their similarity is the same as that which is used by all manufacturers of ready made roofing.

This defendant says that there is no similarity or resemblance in the name and trade mark "RubberO" of the defendant and the alleged trade mark "Rubberoid" of the complainant; that the defendant has committed no act for the purpose of deceiving the public and the buyers and consumers of the defendant's roofing into the belief that the roofing manufactured and sold by the defendant is the roofing manufactured by the complainant, and further alleges that the public, and no part of the public have ever been deceived or misled.

This defendant further denies that the business of the complain-

ant has been greatly or at all damaged or injured or its profits reduced or its reputation injured or destroyed by reason of the use by the defendant of the word "RubberO" in its business and upon its packages.

And defendant further says that while the appearance of complainant's and defendant's roofing is similar, many other
12 manufacturers are and have for many years manufactured roofing which is similar in appearance, and that among others such names as the following have been used and applied to roofing similar in appearance to that of complainant's and defendant's roofing, that is to say:

Compo-Rubber Roofing, Miko-Rubber Roofing, Galvanized Rubber Roofing, Vulcanite Rubber Roofing, and Pioneer Rubber Roofing, Paroid Roofing, Indruroid Roofing, Perfection Rubber Roofing, Flintcote Roofing, Original Rubber Roofing, and Lasticite Roofing.

Defendant further says that none of the said roofings are manufactured from India Rubber, but that they have the resemblance and appearance of rubber.

This defendant further says that there is no resemblance between the wrappers or between the labels used in connection with the complainant's and defendant's roofings and that the manner in which the complainant's and defendant's roofings are put up for shipment and sent out are in many respects dissimilar and that no person could mistake the defendant's roofing, wrapper or label for the roofing, wrapper or label of the complainant.

This defendant further says that the word "Ruberoid" spelled "Rubberoid" was in use long prior to the use thereof by the complainant and that the same was used in 1878 in the State of Pennsylvania by the Rubberoid Company, a corporation duly incorporated with an authorized capital of $500,000, on the 3rd day of May, 1878, under the laws of the State of Pennsylvania; that the said word "Rubberoid" was used and applied to a certain gum resembling India Rubber which was manufactured and sold by the said Rubberoid Company under letters patent issued by the United States to Henry A. Clark of Boston, State of Massachusetts, under date
13 of November 14, 1876, No. 184341, — oid Company under letters patent issued by the United States to said Henry A. Clark under date of April 2, 1878, No. 201992; which material made under said letters patent and having a resemblance to India Rubber and known and sold as Rubberoid was manufactured from certain oils and was used as a coating for cloth or felts which should be water proof, flexible, elastic and unsusceptible to either heat or cold.

Defendant further says that the roofing manufactured by the complainant is made of cloth or felt which is saturated with a kind of gum manufactured by the said complainant under certain letters patent belonging to the said complainant, which said gum is manufactured out of certain oils or fats and is used for coating said felt for the purpose of making the same water proof, flexible and unsusceptible to either heat or cold.

Defendant further says that there was registered in the Patent Office of the United States on the 9th day of July, 1878, a trade mark by the Rubberoid Company of Bristol and Philadelphia, Pennsylvania, for the word "Rubberoid" for a gum resembling India Rubber produced under the process described in the above set forth letters patent issued to Henry A. Clark of Boston, Massachusetts.

Defendant further says that there was registered in the Patent Office of the United States a trade mark on January 8, 1884, by James D. Frary & Son Co., for the word "Rubberoid" which was affixed to a composition used as a substitute for rubber.

Defendant further says that the said word "Ruberoid" is not such a word as is capable of being made a trade mark as it is descriptive of the article upon which it is placed, meaning that the
14 same resembles or is like rubber; that it is composed of the word "rubber" and the suffix "oid" which suffix bears the meaning of "like," "resembling," "in the form of"; that long prior to the registration or use by the complainant of said trade mark "Ruberoid" the said word "Rubberoid" was in common use and its meaning well known and understood and that the same was published in the dictionaries, in which the word "Rubberoid" was described and defined as meaning a composition in imitation of commercial India Rubber, and that the same specifically was published in the Standard Dictionary published in the City of New York and copyrighted 1890, 1893 and 1894.

This defendant further states that the word "Ruberoid" is simply a misspelling of the word "Rubberoid" and that the same was adopted by the complainant for use upon its roofing for the reason that the roofing upon which it was used bore a resemblance to rubber.

This defendant further says that it caused its trade mark "RubberO" to be duly registered on the 22nd day of November, 1904, in the office of the Secretary of State of the State of Missouri, in accordance with the statutes of the State of Missouri, in such case made and provided for such registration.

This defendant denies that it has advertised its roofing by sending out to prospective purchasers samples thereof prepared in any form similar, or having printed matter thereon which bore any resemblance, or similarity, to the alleged name or trade mark "Ruberoid," or that this defendant has done anything to deceive the public, or the buyers and consumers of roofing, for the purpose, or in order to lead them to believe that the roofing of plaintiff was manu-
15 factured by the defendant, and further denies that the public has been deceived, or that a large amount, or any of the said roofing, manufactured and advertised by the defendant, has been purchased or used by consumers, under the belief that it was the roofing of the complainant; on the contrary, this defendant alleges and states that its trade mark "RubberO" is so dissimilar to the complainant's word "Ruberoid" that it is not possible that any one could mistake one for the other.

All of which statements and defenses this defendant is ready to

aver, maintain and prove as this Honorable Court shall direct, and it prays hence to be dismissed with its costs in this behalf sustained.

In Witness Whereof the said defendant Trinidad Asphalt Manufacturing Company, has hereunto affixed its corporate seal and caused the same to be attested by Frank W. Terpening, its secretary.

[SEAL.] FRANK W. TERPENING, *Secretary.*

W. B. HORNER,
Solicitor and Counsel for the Defendant.

STATE OF MISSOURI,
City of St. Louis, ss:

On this 10th day of March, A. D. 1906, before me personally appeared Frank W. Terpening and made oath that he has read the foregoing answer and knows the contents thereof and that the same is true of his own knowledge, except as to matters which are therein admitted or stated to be upon information and belief, and as to these matters he believes the same to be true.

My commission expires September 3, 1906.

[SEAL.] M. F. HOLDEMAN,
Notary Public, City of St. Louis, Missouri.

16 *Replication.*

Comes now complainant and, saving and reserving to itself all and every manner of advantage or exception which may be had or taken to the manifold errors uncertainties and insufficiencies of the answer of said defendant, for replication thereto, saith that it doth and will aver, maintain, and prove his said bill to be true, certain, and sufficient in the law to be answered unto by the said defendants, and that the answer of the said defendants is very uncertain, evasive and insufficient in law, to be replied unto by this repliant; without that, that any other matter or thing in the said answer contained, material or effectual in the law to be replied unto, and not herein and hereby well and sufficiently replied unto, confessed or avoided, traversed or denied, is true; all which matters and things this repliant is ready to aver, maintain and prove as this Honorable Court shall direct, and humbly prays as in and by his said bill he hath already prayed.

——— ———.

17 *Complainant's Evidence.*

The Complainant's counsel now produces for the inspection of defendant's counsel the original charter from the State of West Virginia incorporating the complainant company, and asks whether defendant's counsel will either admit the incorporation of the complainant company or whether he will consent that a copy, or a certified copy be annexed to the deposition in lieu of the original.

Mr. Homer, defendant's counsel states that he will consent that a certified copy be annexed.

Complainant's counsel agrees to procure a certified copy and

annex it to the deposition before it is forwarded. Such certified copy is to be marked "Complainant's Exhibit Certified copy Charter."

JAMES N. RICHARDS, a witness called on behalf of the complainant, being first duly sworn, testified as follows:

Direct examination by Mr. BRIESEN:

Q. 1. What is your name, age, residence and occupation?

A. My name is James N. Richards; age 48; residence, New York City; occupation, sales manager of The Standard Paint Company, the complainant.

Q. 2. How long have you been connected with the complainant company, and in what capacity?

A. Between 11 and 12 years. Original capacity, salesman; manager of sales department since 1898 temporarily, and permanently the following year.

Q. 3. As salesman, what did you do?

A. I traveled pretty much over the United States selling goods, in every part of the country. I have been one of the in-
18 troducers of it. After it got started up I made a specialty of pushing it more than anything else.

Q. 4. And since 1899 you have been in absolute control of the sales department of The Standard Paint Company?

A. Yes, sir.

Q. 5. Please now state what are the leading branches which you have charge of as sales manager of that company?

A. I take charge of all salesmen; hire them, and direct their movements; keep informed of all sales; regulate prices and see that the sales do not fall behind by following them up day by day, so that I know exactly where the business stands and what the volume is.

(Question repeated to witness.)

A. The principal branch is the manufacture of Ruberoid Roofing, that is the largest portion of the business. There are various others, such as insulating papers and compounds.

Q. 5. Let us take up the matter of this roofing which constitutes the chief product of the complainant company. Will you state for how many years, so far as you know, the company has been engaged in the business of manufacturing, selling and dealing generally in that kind of roofing material?

A. You mean specially the Ruberoid Roofing or roofing material?

Q. 7. I mean the Ruberoid roofing.

A. We began to manufacture Ruberoid Roofing in 1891; that is, we put it on the market commercially. We manufactured it previous to that experimentally, but it was put on the market as a success in 1891, as Ruberoid. We manufactured it continually since that time, and it has increased very largely; there has been no cessation of manufacture.

Q. 8. You export or sell to countries foreign to the United States this roofing which you call Ruberoid?

19 A. Yes, sir. We not only export from the American factory, but also manufacture in Hamburg, Germany, where we have a factory to supply foreign markets, under the same name in foreign countries as it is in this country.

Q. 9. Please state what is your understanding of the expression "Ruberoid" that you have used as a trade name?

A. The only understanding we have is that it is a trade name adopted when the roofing was first made because of its durability and flexibility.

Q. 10. You mean that it is your understanding that the word "Ruberoid" is and was used since 1891 as the distinguishing trade mark for this roofing of the Standard Paint Company?

A. Yes, sir, it was adopted; and we have had a great many offers to furnish it under other names, but we have declined to do it. We make only one roofing, that is Ruberoid, and we base our entire business on it.

Q. 11. As sales manager of the complainant company, have you any means of knowing whether the word "Ruberoid" is identified in the minds of dealers and purchasers generally with the product of the Standard Paint Company, the complainant?

A. Yes, sir; we get a great many——

DEFENDANT'S COUNSEL: Just one moment. Question objected to as being irrelevant as to what is known regarding the manufacture of the Standard Paint Company except as having reference to the roofing in question.

COMPLAINANT'S COUNSEL: I intended it to have reference to the roofing in question.

A. We receive a great many letters addressed to the Ruberoid Company in consequence of our roofing being known by the
20 name Ruberoid; they come addressed to the Ruberoid Company, New York, and they reach us that way.

DEFENDANT'S COUNSEL: The answer is objected to for the reason that the letters themselves are the better evidence, and for the further reason that the question of letters has no bearing on the merits of the case.

Q. 12. While you were salesman of the complainant company, what was your experience in the following respect: When dealers with whom you talked spoke of Ruberoid roofing, whose product did they refer to?

DEFENDANT'S COUNSEL: Objected to as being immaterial as to any conversations regarding the product.

A. It was invariably known as the Standard Paint Company's product, because they are known as the sole manufacturer. We have many customers who express a preference and write us to send them the genuine Ruberoid, and they ask us if we are the manufacturers of the genuine Ruberoid.

DEFENDANT'S COUNSEL: Same objection to the answer as to the question, and an additional objection that the same calls for the

expressions contained in written documents and the statements of other parties; therefore not the best evidence and hearsay.

Q. 13. Then it is your testimony that about 14 years ago the complainant company adopted as its trademark or trade name for roofing the word "Ruberoid," and has ever since used that word as its trade mark or trade name for that product?

A. Yes, sir.

Q. 14. In marketing such product—Ruberoid—did the complainant company advertise at all, and if so, to what extent, if you can state?

DEFENDANT'S COUNSEL: Question objected to as the advertising of the company is not a material question in the case.

21 A. The advertising of the company has been very extensive, and has increased every year.

Q. 15. You are referring only to Ruberoid?

A. Ruberoid only. The expense for advertising Ruberoid has become one of the heaviest items in our business. We have a department for that purpose, and I can give you from a memorandum I have the expense that we have gone to for five years back in advertising it.

Q. 16. Advertising Ruberoid?

A. Yes, sir.

Q. 17. Please do so?

DEFENDANT'S COUNSEL: I object to the question on the same reasons as stated.

A. In 1900 we spent over $19,000 for advertising Ruberoid. In 1901, more than $20,000. In 1902, more than $22,000. In 1903, more than $25,000. In 1904, more than $35,000. And to October 1, 1905, we spent more than $34,000.

Q. 18. Can you also testify as to the business transacted by the complainant company for a series of years last past showing, for instance, approximately—I don't ask for particular figures—the amount of Ruberoid Roofing sold and the gross receipts for the same?

DEFENDANT'S COUNSEL: I object to the question as immaterial to the issues in the case.

A. In 1900 there were over 100,000 rolls marketed, for which we got more than $450,000.00. In 1901, more than 140,000 rolls sold for which there was received over $550,000.00. In 1902, more than 190,000 rolls, and more than $750,000.00 received. In 1903, more than 250,000 rolls, for which there was received over $950,000.00. In 1904, more than 260,000 rolls, for which there was received over $950,000.00. And for the first six months of 1905, there has been more than 125,000 rolls sold, for which there 22 was received more than $450,000. Of course in speaking of that I am speaking of the American factory's output.

Q. 19. Can you give us any information regarding the output of any of your foreign factories?

A. The Hamburg factory in 1902 sold over $100,000 worth; the number of rolls I can't give you offhand; and in 1903 it was more than $100,000 worth. In 1904 it was over $120,000, and for 1905 I have not the figures; but there was an increase.

Q. 20. Can you state how many persons are employed in the factories of the complainant company?

DEFENDANT'S COUNSEL: Same objection.

A. Approximately, 160 people in the factories, including Hamburg.

Q. 21. Can you state how many selling agents you have in different parts of the United States and foreign countries?

DEFENDANT'S COUNSEL: Objected to as immaterial.

A. We have a main office in New York, and a direct branch house in Chicago, Boston, Cincinnati, Atlanta, Ga.; Portland, Ore., and San Francisco, Cal.; and we have over 500 sub-agents through the United States. In Europe we have five direct agencies who have over 200 sub-agents. In Australia also we have eight direct agencies, with their contingent sub-agencies.

Q. 22. Explain briefly the difference between a branch house and a sub-agent?

A. The branch houses are those conducted by the direct employees of our company to whom we pay salaries; and we rent warehouses and offices, and carry stock for our own account. The sub-agents are those with whom we have agreements and to whom we ship for their account, and who have the exclusive sale of Ruberoid
23 and who agree not to push any other roofing or handle any other roofing similar to Ruberoid.

Q. 23. What representation, if any, have you in St. Louis, Mo.?

A. The Graham Paper Co. are our agents there under agreement, and they cover all of the territory tributary to St. Louis, where it is convenient to ship from that point, where freight rates are in favor of St. Louis.

Q. 24. I understand from your testimony given so far that your company's business in making and selling roofing under its trade name Ruberoid extends into every State of the Union and every part of Europe and Australasia. Is that understanding correct?

A. Yes, sir; it embraces all States and Territories, and I might say, every civilized country, not only Australasia and Europe, but Asia, China, Japan—all foreign countries; and Africa.

Q. 25. You also include Canada, Mexico and South America?

A. Yes, sir; Canada, Mexico and South America, and the West Indies and Cuba.

Q. 26. Have you any figures showing the business done in any of the foreign countries mentioned by you?

A. Individually, no sir. I can obtain them, of course. I have already given them collectively in the figures testified to.

Q. 27. Prior to the time when the Standard Paint Company adopted the word "Ruberoid" as a trade mark or trade name, in

1891, do you know whether any other person, firm or corporation had ever used that word in connection with roofing materials?

A. I know they had not; that is, we never heard of it.

Q. 28. You would have heard of it at the time, if such a thing had existed, because of your intimate contact with the dealers in your capacity as salesman?

24 DEFENDANT'S COUNSEL: Question objected to as leading and showing that it is impossible that the witness could answer the question any way.

A. Covering the whole United States. I should have heard of it.

Q. 29. Speaking of the roofing made by the complainant, The Standard Paint Company, have you any knowledge as to how it is manufactured and in what grades it is manufactured?

A. Yes, sir. The manufacture of the roofing is the saturation of a high-grade of felt with a composition or product that we call Ruberoid, which is liquified and the felt is impregnated with it. We make different weights, but only one grade. All the roofing we make is one grade. There are half, one, two, and three-ply thicknesses.

Q. 30. Are the details of the processes for manufacturing the composition with which the felt is impregnated to a certain extent secret processes?

A. Yes, sir.

Q. 31. Do you feel at liberty to state, without injuring the business of The Standard Paint Company by a disclosure of any of its secret processes, what the basis of such impregnating compound is?

DEFENDANT'S COUNSEL: Question objected to as it is not a question of the feeling of the witness, whether he feels at liberty to state or not.

A. Well, the information that I can give is the same information that we have circulated and published from time to time by correspondence and in posting our salesmen which is not any secret. The information I would give is not particularly the secret processes; it is the product that is used in the manufacture, which is composed of a residuum of animal fats.

25 Q. 32. Can you state whether any India rubber or compound of rubber, or any product of rubber, is used, or ever has been used in connection with the manufacture of this impregnating composition for use with roofing by the Standard Paint Company?

A. Absolutely none. No rubber has ever been used, nor do we use any now.

Q. 33. In what form is the roofing manufactured, in sheets or how?

A. In sheets, which are put up in rolls to be shipped commercially.

Q. 34. Describe those rolls?

A. The rolls containing one square and two squares each, 36 inches one square containing 100 square feet, and two squares, —

square feet, with an additional allowance for the lapping in laying the roofing of 8 feet for each 100 square feet. The length of the double roll is 72 lineal feet, and 36 inches wide; and the single roll 36 lineal feet, and 36 inches wide.

Q. 35. When these rolls come from the factory you ship them just as they are, or are they packed in some manner?

A. They are shipped in the United States just as they reach us from the factory without any outside protection excepting the wrappers bearing the trade-mark name "Ruberoid" and description of the contents.

Q. 36. You mean these rolls are covered with paper wrappers having certain printing on them?

A. They are covered with paper wrappers, with the printed description of the trade-mark and the ends are covered with muslin caps.

Q. 37. Have you one of those wrappers of which you speak with you?

A. Yes, sir.

(Witness produces a piece of paper about 3 feet long and 3½ feet wide).

26 The WITNESS: The wrappers used are all alike, the only difference being that the various plys are stenciled at the top above the label.

Q. 38. The wrappers which you have produced contains reading matter as follows, does it not:

"216 Sq. Ft.
"1-2 Ply.

Printed in large black rectangle the following:

"Stand on End.
"Ruberoid.
(Trade Mark Registered)
"Roofing
"Strong, Durable and Easy To Lay.
"Unaffected by Changes of Temperature.
"No Tar.
"Outlasts Tin and Iron.
"Directions for Laying Inside of each Roll.
Copyrighted by The Standard Paint Company, 1901.
"Stand on End.

" 'Ruberoid' appears every four feet on under side of all genuine Ruberoid Roofing.
(Trade Mark Registered).
"The Standard Paint Company,
"Sole Manufacturers."

A. Yes.

Complainant's counsel offers in evidence to be attached to this deposition the wrapper produced by the witness, and requests that

the same be marked Complainant's Exhibit "Large Wrapper." So marked by Notary.

Q. 39. For what purpose is the Standard Paint Company's Rubcroid roofing used?

A. Principally for roofing buildings and for siding. It is
27 also used for roofing cars, locomotive cabs, and any structure to keep out the weather.

Q. 40. Referring now to the advertising of which you have spoken in respect to this roofing manufactured and sold by the complainant company under the name of Ruberoid, please state generally the extent of such advertising; in what parts of the country, and in what manner such advertising has been distributed?

. DEFENDANT'S COUNSEL: Question objected to as immaterial. It is not material what advertising has been done.

A. The advertising has been done in every State of the Union, through trade papers, local papers, by circular letters, by mailing cards and by personal representation of traveling salesmen. We have display signs and samples that are distributed with the circular letters. Every buyer of Ruberoid receives a large supply with each shipment, of display signs, samples, descriptive pamphlets, all bearing the Ruberoid trade mark. The foreign advertising is done on the same plan in each country. All our letter heads not only bear the trade mark name Ruberoid, but the various medals of award that we have received at exhibits all over the world—the highest awards—and we reproduce fac similes of these medals in our advertising matter.

Q. 40. Have you with you any of the advertising matter of which you have spoken in your last answer, and if so kindly produce some specimens?

A. Yes, sir, I can produce quite a variety showing the advertising in this country and also in foreign countries.

(Witness produces samples of advertising).

Q. 41. These samples of advertising matter that you have produced—do they represent a complete line of all your advertising, or are they only a part?

28 A. Only a part, sir. I would like to add to that that the general expressions descriptive of the goods is the same, however, in all the rest of the line.

Complainant's counsel now offers in evidence these samples of advertising matter produced by the witness, being 19 sheets, pamphlets and cards, and being marked respectively, "Complainant's Exhibit Advertising Matter" No. 1 to No. 19.

DEFENDANT'S COUNSEL: Objected to, as not being material to any issue in the case, and some of them are not advertisements of the complainant, but simply copies of letters of other persons, which letters would be the better evidence, and which letters themselves would not be material evidence in this case.

COMPLAINANT'S COUNSEL: None of these 19 exhibits is offered

as proof of the contents, but only to show the extent and variety of advertising, and the form of such advertising.

Q. 42. Can you produce samples of your Ruberoid roofing, such as you say are sent out to prospective customers?

A. Yes, sir, in two forms; the mailing sample, letter size, and the large sample book made for the use of architects for reference, with descriptive matter attached. I would like further to call your attention to the fact that all samples now being sent out are identified as the genuine Ruberoid by having the name "Ruberoid" embossed on the reverse side of the sample to distinguish them from the imitations that are on the market.

(Witness produces two sets of samples, the small one for mailing, letter size, and the larger one in book form for filing with architects.)

Q. 43. Both of these samples of the roofing contain the word "Ruberoid" in large letters on the outside sheet and the
29 statement "Manufactured solely by The Standard Paint Company," do they not?

A. Yes, sir.

Complainant's counsel offers in evidence the two samples of Ruberoid roofing produced by the witness, and the same are marked respectively, Complainant's Exhibit "Mailing Sample of Ruberoid Roofing," and Complainant's Exhibit "Arch. Sample of Ruberoid Roofing."

Q. 44. During the last 14 years under what name has the Standard Paint Company's roofing material such as contained in the Exhibit "Samples of Ruberoid Roofing" been known?

A. By the name Ruberoid only.

Q. 45. All over the United States?

A. All over the world.

Q. 46. Is that the only name under which it was known to the trade during these years?

A. Yes, sir.

Q. 47. And I presume it is ordered by dealers and purchasers under that name?

A. Under the name of Ruberoid Roofing.

Q. 48. From your figures which you gave above I gather that your sales have been growing steadily during the last few years. Have you any information which would enable you to testify as to the extent of sales, not giving detailed figures, from 1891 until 1900, generally; the first year about how many; I do not want details?

A. Well, the first year of manufacture—I can show you an increase for the period from 1893 to 1899 from 1,500 rolls in 1893 to 68,000 rolls and over in 1899.

Q. 49. And this was a steady increase throughout that period?

A. It was a very steady increase, largely increased every year, without any break at all.

Q. 50. Is the business of The Standard Paint Company
30 in the manufacture and sale of roofing under the name Ruberoid a profitable business?

A. Yes, sir. It has been much more profitable until the last few years in consequence of the reduced price of imitations that have been put on the market, and to-day while we are selling Ruberoid for less than we did four or five years ago, we still sell it on its merits.

Q. 51. Is the ownership of the trade mark "Ruberoid" worth more than $5,000 to The Standard Paint Company?

DEFENDANT'S COUNSEL: Question objected to as leading, and for the further reason that you cannot prove the value of a trade-mark in that way.

A. The increase in the sales and in the output would show that the value of the Ruberoid trademark is very much more than that.

Q. 52. In the manufacture of the roofing known as Ruberoid roofing, is the Standard Paint Company careful in the selection of its material, and does it make any effort to deliver only the best grade?

DEFENDANT'S COUNSEL: Question objected to as leading, and for the reason that the evidence would not be material.

A. The materials used by us are all of the highest grades, and if not found up to our standard are rejected. The materials used, to my knowledge, are of higher grade than are used in other roofings.

Q. 53. Then you can say that The Standard Paint Company throughout these years has been delivering roofing material under the name "Ruberoid," so made and of such character as to warrant a reputation being built on it?

31 DEFENDANT'S COUNSEL: Question objected to as leading.

A. The reputation of Ruberoid has been established in consequence of its durability and the fact that customers, as shown in the letters received from them, re-order continually from year to year. The general increase of the business will show that the quality must have been maintained.

Q. 54. Prior to the time that the Trinidad Asphalt Manufacturing Company began to make use of the word "RubberO" do you know whether any other manufacturer of roofing material had ever adopted or used or tried to use the name of "Ruberoid" or "RubberO," or any similar name, to designate its or their products?

A. I never heard of the name "RubberO" until the Trinidad Asphalt Manufacturing Company used it; and we have never been able to obtain any samples or rolls of material that have been sold with the word "Ruberoid" on them by others; that is, that were manufactured by others than The Standard Paint Company, and I have no knowledge of any other manufacturer than The Standard Paint Company adopting the name "Ruberoid."

Q. 55. Have you any knowledge as to about when it was that you first became aware of the Trinidad Asphalt Manufacturing Company's use of the name "RubberO" in connection with felt roofing?

A. I think from my recollection it was in the early part of this year. Perhaps it might have been the latter part of last year; I am not positive of that fact.

Q. 56. Have you any knowledge as to the manner in which sales of the Trinidad Asphalt Manufacturing Company's roofing under the name "RubberO" affected—I mean, do you know anything of their advertising, or sending samples to the trade, or anything about that?

32

A. We have received samples and have seen it advertised in their advertising circulars, and I know of sales that have been made.

Q. 57. Have you any of the samples of advertising matter of the Trinidad Asphalt Manufacturing Company with you?

A. Not to-day. I think there was some attached to the original complaint, but I have samples at the office.

Q. 58. Have you ever seen the roofing material sold by the Trinidad Asphalt Manufacturing Company under the name "RubberO?"

A. Yes, sir.

Q. 59. Please describe its appearance and get-up?

A. It is put up in rolls of the same general character and description as Ruberoid and other prepared roofings, and containing the same number of square feet. The appearance of the roofing very closely resembles Ruberoid.

Q. 60. Do you mean that the Trinidad Asphal- Manufacturing Company's "RubberO" roofing is cut into widths and made into rolls similar in form to those which The Standard Paint Company makes, as described by you in Question 34 above?

A. As far as I know it is.

Q. 61. So far as you know, do they make similar thicknesses of material and use the same terms, 1, 2 and 3-ply, that The Standard Paint Company does?

A. I would have to look up their printed matter to answer that question. I think I can get the printed matter this afternoon.

Recess.

Q. 62. Have you been able to obtain any of the circulars and samples of the Trinidad Asphalt Manufacturing Company referred to in your last few answers?

33

A. Yes, I submit a sample of RubberO, 1, 2 and 3-ply, with a circular descriptive of them.

Complainant's counsel offers in evidence the sample and circular and the same are marked Complainant's Exhibit "Defendant's circular," and Complainant's Exhibit "Defendant's sample."

DEFENDANT'S COUNSEL: Objected to as not being material to the issues of the case, as they are simply advertising matter.

Q. 63. I call your attention to the second inside page of Exhibit "Defendant's circular," and ask you to state how the roll of roofing represented there in an upright position corresponds with the appearance of the roll of roofing made by the Trinidad Asphalt Manufacturing Company?

A. My recollection is that it is the same. I identify it by the Bull Dog brand, and the word "RubberO" was on it. In general appearance it is the same.

Cross-examination.

By Mr. HOMER:

X Q. 1. As I understand you, you have been connected with The Standard Paint Company from its inception?

A. Between 11 and 12 years.

X Q. 2. You were not then with it at the time of the incorporation?

A. No sir.

X Q. 3. Are you now an officer of the corporation?

A. I imagine I am, to a certain extent; I have full control of the sales. I am General Sales Manager of the Company, and I sign for the Company.

X Q. 4. But you do not hold any official relations to the Company; by that I mean officer of the Company?

A. Not otherwise than General Sales Manager of the Company.

X Q. 5. Who are the officers of the Company?

A. The President, Mr. Ralph L. Shainwald; Secretary
34 and Treasurer, Mr. Felix Jellenik; Vice-president, Mr. Max Drey. Those are all except the Board of Directors.

X Q. 6. You have to do only with the American end of the business?

A. I have control of the American end of the business. The foreign end of the business I have nothing to do with beyond knowing about it. I have access to the accounts.

X Q. 7. You say 12 years you have been connected with the business; that would be what year did you begin?

A. Over 11 years ago, 1894, I began with the Company.

X Q. 8. Your testimony which you gave this morning regarding the sales in 1893 was acquired from the records, and not from your own knowledge at all?

A. Yes, from the records.

X Q. 9. The rest of the evidence that you gave in regard to the amount of sales, I suppose you acquired from the bookkeeper or from some one having charge of the books?

COMPLAINANT'S COUNSEL: Objected to unless the particular years for which the testimony was given are mentioned.

A. For the years prior to the time I took charge of the sales it was acquired from the records in the books, but since I have been in charge of the sales I have actual knowledge of the volume of the sales from day to day. The sales are figured every day; the amount of orders we receive tabulated, and I have them during the day, and the records are kept. I always have the records of every year's business.

X Q. 10. Those you get from the books of the Company?

A. I know them before they go on the books, and I have them checked up at the end of the month to see if they are the
35 same. They are figured on receipt of the orders, so that we can keep track of our business and know what we are doing each day in comparison with the preceding day.

X Q. 11. You have produced here a considerable amount of advertising matter. Has that been put forth by yourself, or some one else connected with the Company?

A. It is put forth by our department specially organized for advertising, under my supervision.

X Q. 12. You described partially this morning the way in which the Ruberoid roofing was put up. I will get you to give that a little more in detail in order that I may call your attention exactly to what I refer to. You speak of its being put up in a roll wrapped with a wrapper, similar to the one produced here. What else, if anything, was there in connection with the rolls than the sheet of roofing itself?

A. We have various ways of putting up our rolls for shipment. Some are put up in what we call one-square rolls, and some in two-square rolls. The material that is put inside the wrapper is the roofing itself, and in many instances the fixtures are also enclosed in the hollow part of the roll. In other instances the fixtures are shipped separately; but they are very largely shipping the fixtures inside the roll to-day. The package——

X Q. 13. You might state in that connection how long you have been shipping them in that way?

A. The fixtures inside the rolls—about two years.

X Q. 14. What do those fixtures consist of?

A. Nails, caps and roofing cement.

X Q. 15. Describe the nails and the caps.

COMPLAINANT'S COUNSEL: This whole line of testimony
36 objected to; it is quite immaterial to any issue in this suit, which is purely a trade-mark suit involving the word "Ruberoid" and the imitation thereof.

A. The nails furnished are what is ordinarily known as barbed wire roofing nails; tin caps, and cement.

X Q. 16. Is that all that you include in the package?

A. We also include printed directions for applying the roofing, and a slip of paper to show who the operator was at the factory who packed the roll,—a machine tender's slip.

X Q. 17. You speak of barbed wire nails——

A. Barbed wire roofing nails; that is a trade term.

X Q. 18. What does it consist of?

A. You mean the quantity?

X Q. 19. No; I mean describe the nail.

A. The nail so far as I know,—the name describes it. It is a barbed wire roofing nail, and that is all the description. It has a head and a sharp point, and is scored in the center, so it will hold against the roofing. It is a straight wire nail.

X Q. 20. Is there any washer connected with it?

A. Tin caps are used with some of them; with others a different nail is used. We use a broad headed nail that does away with the tin cap also.

X Q. 21. Prior to two years ago you sent them out, all these connections, in a carton, did you not?

A. Not all; no, sir. We sent some of them in cartons and boxes, and some of them in bulk.

X Q. 22. By bulk you mean?

A. We would send the nails in kegs, and the tin caps and washers would be sent by the pound package, and the cement also in separate package, that is where there were large jobs that required lots of fixtures. We also do that to-day, and send the fixtures in cartons
37 as well to-day. But we are to-day shipping a very large quantity, and have been for fully two years—and may be a little longer than that—with fixtures inside the rolls in packages, for the convenience of the small trade.

X Q. 23. What do you place on the ends of your rolls of roofing, or does the wrapper cover the ends also?

A. We place a muslin cap on the ends of the roll.

X Q. 24. Is that done equally when the connections are sent inside the roll as well as when they are not?

A. Yes, sir; it is done for the protection of the edge of the material, to keep it from being broken in transit; and we do it in every case, except where we may send a very large shipment to comprise, a car, to be used immediately on one job, and then we save the expense of the muslin cap, as we know it will be packed tight in the car and not injured.

X Q. 25. In pronouncing the word "Ruberoid" I noticed you this morning invariably divided the syllables, as follows: Ru-ber-oid. Is that correct?

A. We write it Ruberoid without any hyphen. If it is pronounced so that it seems to be separated in that way it is unintentional.

X Q. 26. What I want you to indicate by your answer is the pronunciation of the word?

A. We pronounce it as Ruberoid, because it only has one B in it.

X Q. 27. That is, you make the first syllable sound as if it were spelled ru?

A. Yes, sir. We avoid any pronunciation that would suggest at all that it is rubber. We call it Ruberoid. We do not desire to have it in any way known as a rubber product, because it is not.

X Q. 28. Do I understand *that* your last answer that this is
38 the reason why you pronounce it Ruberoid instead of Rubberoid?

A. Yes, sir. It has never been pronounced by us in any other way.

X Q. 29. If there had been two b's in it, you would have been compelled to have pronounced it with the word "rubber" and the suffix "oid" added, I suppose?

A. I presume we should. But in adopting the word that was no doubt intentional, to leave the second b out for that purpose.

X Q. 30. I call your attention to complainant's Exhibit "Advertising Matter, No. 4."—"In appearance this 'gum,' with which, in a liquid state, the roofing is saturated, resembles rubber in its crude state. In fact, it was this close resemblance to rubber which suggested the name 'Ruberoid,' now so universally and so favorably

known." This is a proper quotation from this exhibit, advertising matter, is it not?

A. From that issue it is, yes, sir.

X Q. 31. It is a fact, then, that it got its name from its resemblance to rubber, is it not?

COMPLAINANT'S COUNSEL: This line of examination objected to on the ground that this witness has already testified that he was not connected with The Standard Paint Company at the time of the adoption of the trade mark Ruberoid, and he therefore can have no knowledge of the facts inquired into.

A. I can explain a certain thing as to that. The gentleman who wrote that article was not connected with the company when the company was formed, and he wrote it for advertising purposes only. The manager of our advertising department wrote it for advertising purposes.

X Q. 32. If I remember rightly, you stated this was done under your supervision?

A. My supervision, yes, sir.

39 X Q. 33. You were connected with the company at the time the application for the registration of the trade mark was made, were you not?

A. Yes, sir.

X Q. 34. Can you give the exact date when you became connected with the company?

A. August, 1894.

X Q. 35. Then, so far as your testimony relates to anything which occurred prior to that, it is simply that which you have been told by others, isn't it?

A. What I have from the official records of the company.

X Q. 36. Been told by others, or from the records of the company?

A. From the official records of the company.

X Q. 37. Then when you testified that the company began to manufacture Ruberoid in 1891 and has manufactured the same for fourteen years, you were simply telling what you had found in the records or what some one else told you?

A. Prior to 1894, yes, sir.

X Q. 38. You speak in your direct examination of the time when you first learned that the defendant was manufacturing and selling its roofing, which it called "RubberO," was in 1905, or perhaps 1904, you said?

A. Yes, sir.

X Q. 39. How do you recall that you learned this fact. I speak of it now because you commenced to say something in your answer about a letter?

A. From the reports—the letters we received from our traveling salesmen reporting there was such a roofing being sold.

X Q. 40. You referred to a letter. Have you reference to the letters of Keith, Simmons?

A. Not particularly, because we had knowledge of it before we had any word from Keith, Simmons. I recollect some correspond-

ence with Keith Simmons about RubberO which reached us
40 after we knew that RubberO was being sold.

X Q. 41. Where are Keith, Simmons & Co.?

A. Nashville, Tenn.

X Q. 42. They handle your goods, I believe?

A. Yes, sir.

X Q. 43. They are not a branch house?

A. They are under a contract with us; distributing agents.

X Q. 44. You divided your agents this morning into two classes; one, branch houses, and the other, distributing agents?

A. Yes. These are the contract agents.

X Q. 45. You spoke this morning about the various thicknesses of the roofing which you sold. These thicknesses are the ordinary and usual thicknesses which are used and sold in the market?

A. They were not so until we established the standard.

X Q. 46. They have become so now?

A. They have become so now; but we established it.

X Q. 47. There are a large number of manufacturers of prepared roofing now engaged in manufacturing and selling the same, are there not, in the United States?

A. Yes, sir.

X Q. 48. There are a large number of these concerns which use names for their roofing which indicate that they are like or have some resemblance to rubber, are there not?

A. No, sir. There are very few that use that.

X Q. 49. You do know of some, do you not—I mean outside of the complainant and the defendant?

A. I know of one other.

X Q. 50. What concern is that, and what is the name?

A. F. W. Bird & Son, of East Walpole, Mass., who make a roofing they call "Paroid," which word would indicate that it is de-
41 rived from Para Rubber, the highest grade of rubber.

X Q. 51. Have you never known of a roofing being put upon the market under the name of the Compos-Rubber Roofing?

A. I have heard of it as a name being put upon the market by a supply house. I do not know who the manufacturer is. It is probably a private brand.

X Q. 52. Have you ever heard of the name "Galvanized Rubber Roofing"?

A. Yes, I have heard of it in a very small way; and that I can put in the same class. But I would not consider that imitating the name of our roofing, Ruberoid.

X Q. 53. You have seen both of those labels, have you, the last referred to, the Compos-Rubber and the Galvanized Rubber?

A. I have seen the Compos-Rubber on a sample, but never on a roll. The other I have never seen.

X Q. 54. Have you ever seen roofing under the name of Perfection Rubber Roofing?

A. No, sir.

X Q. 55. Nor never heard of it?

A. Not that I know of.

X Q. 56. These which you have heard of, like your own roofing, contain no rubber, I suppose?

A. Personally, I have no knowledge of what they contain. It is the appearance and the representation of the name would be the only thing that would attract my attention, as they would appear in the market.

X Q. 57. They have the same appearance, have they?

A. The roofings spoken of; yes, sir.

X Q. 58. These are put out, are they, in the market in a way similar to Ruberoid—I refer of course to the rolls?

A. Well, for that matter, all prepared roofing is put out
42 in the same way, all in rolls; it is the universal custom.

X Q. 59. Prepared roofing has been put up in rolls, I suppose, for a great many years?

A. Yes. Tarred felt roofing and the apshalt gravel surface roofings have all been put up in rolls and put on the market in the same way.

X Q. 60. For how many years have you known this to be done; the tarred felt roofing, for instance?

A. I presume, as far as I know, as long as I have been connected with the trade it has been done.

X Q. 61. Were you connected with the trade in any way before you became connected with this company?

A. Not in the roofing trade, no sir.

X Q. 62. You have referred to a large number of advertising exhibits. I suppose they are the ones which you are now sending out at the present day?

A. Yes, sir.

X Q. 63. Take, for instance, Complainant's Exhibit "Advertising Matter, No. 2," did you send out a similar one to that prior to this year. I see that is dated January, 1905?

A. We have been in the habit of sending out signs for years, and whether the general style was the same or not, I could not state, but the character of the sign is the same.

X Q. 64. The words are the same?

A. No; if we sent out this sign two or three years ago, we always change our record. We have here 14 years' record. This is a sign gotten up this year. Last year that sign would have read 13 years.

X Q. 65. Did it? Do you from your own memory, state that it did so read last year?

A. Yes; we have been very careful to change that record.

X Q. 66. You recall the fact now that you have changed it from year to year?

A. We have, yes, sir

43 X Q. 67. Can you tell when you began with a sign of that sort?

A. Putting the number of years on it? I don't think we began it until—I think we began to publish 12 years' record, from my memory; I could not state positively; it might have been 10; but I can look it up on our records and ascertain.

X Q. 68. Otherwise were the signs the same?

A. The character- generally were. We changed our style every little while of signs. We are continually getting out new ideas for signs; sometimes they are cloth, and sometimes painted metal. This happens to be a card-board sign.

X Q. 69. You gave a brief description of the goods which you sell under the name of Ruberoid. What is the foundation of the product; I mean the material?

A. Wool felt, or composition felt as they call it, is used to contain the saturation.

X Q. 70. You speak of the material with which you saturated the felt; if I understand you correctly, as being called Ruberoid, or a compound of some name of that kind, I don't exactly recall?

A. Compound; that is manufactured from the residuums of animal fats.

X Q. 71. That is the compound which is used to saturate the felt?

A. Yes, sir.

X Q. 72. That you also call by the name Ruberoid?

A. Yes, sir.

X Q. 73. Do you manufacture it yourself?

A. We manufacture it solely, that is our specialty.

X Q. 74. By specialty, what do you mean?

A. No one else makes it. No one else can manufacture it.

X Q. 75. Why do you say no one else can manufacture it?

A. For the reason that the processes are not known.

X Q. 76. Is it not a patented article?

A. There is a patent on it, I believe.

44 X Q. 77. I notice in Complainant's Exhibit "Advertising Matter, No. 19," on the first page, this expression: "The secret of its remarkable durability, however, is that it is thoroughly saturated and coated with a compound, Ruberoid, which is non-oxydizing, water, acid, alkali, and weather proof. This compound is patented, and used in no other roofing." That is correctly read, is it not?

A. Yes, sir.

X Q. 78. The patent is a patent issued by the United States Government?

A. Yes, sir.

X Q. 79. To The Standard Paint Company?

A. Yes, sir.

X Q. 80. I show you a booklet and ask you what it is?

A. That is one of our issue of Ruberoid Roofing circulars.

DEFENDANT'S COUNSEL: I will ask the Notary to mark this, for identification, "Defendant's Exhibit 'Complainant's advertisement, No. 2.'" So marked.

X Q. 81. Can you tell about the date when it was issued, from an examination of it?

A. I can trace it; I can't tell now without tracing it. The way I can identify it is by the first picture, the launching of Emperor William's yacht; so it was later than 1902.

X Q. 82. Do I understand from your statements in answer to

your counsel, that the only business of The Standard Paint Company is making Ruberoid Roofing?

A. No, sir; we manufacture various other products.

X Q. 83. What are they?

A. Insulating papers, iron and wood preservative paints, colored paints, electrical insulating compounds and electrical insulating tape, lining papers, and various others.

X Q. 84. You have had to do, I think you said, wholly with the American business; is that correct?

45 A. Yes, with directing and managing the sales of the American business.

X Q. 85. Has the American house or houses furnished the foreign trade, or has that been done from Hamburg?

A. The Hamburg factory furnishes the European trade and the trade that is supplied from the European markets.

X Q. 86. What, if any, foreign trade has been furnished by the American house?

A. We make very few shipments now excepting to Australia and South American ports, Mexico and Canada.

X Q. 87. In answer to your Counsel's question you stated that you never had heard of the name Ruberoid being applied to any other roofing material except that of the complainant; have you known the name Ruberoid being applied to any other material than roofing?

A. Not since I have been connected with the company.

X Q. 88. Well, prior to that?

A. I have no knowledge.

X Q. 89. You mean by that, I suppose that what you do know is solely hearsay?

A. No; I don't know of it.

X Q. 90. You have heard of its being applied to other materials, have you not?

A. I have heard that it may have been, yes. I have heard that it was applied in years gone by. I have no absolute knowledge of it.

X Q. 91. From whom did you hear it?

A. Why, from our own company, and as far as I know, there was some transaction with some one who formerly had or used the word Ruberoid for another product.

Redirect examination by Mr. BRIESEN:

Q. 64. Can you state the names of some of the other felt roofings that are on the market and that do not contain any sound like or resemblance to the word "Ruberoid"?

A. Yes, sir; the Amitite Roofing; Lincoln Roofing; the

46 Flint-kote Roofing, and they make also a similar kind that they call Rexoid. There are various others.

Q. 65. Is Mr. Shainwald in Europe?

A. Yes, sir.

Recross-examination by Mr. HOMER:

X Q. 92. These roofings that you have just mentioned; they are similar in their appearance to the roofing of the complainant?

A. The appearance is similar; yes, sir.

X Q. 93. The form in which they are put up is the same, is it?

A. Very much the same. They are all put in rolls.

JAMES N. RICHARDS.

Subscribed and sworn to before me this 24th day of October, 1905.

A. E. HASKINS,
Notary Public.

FELIX JELLENIK, a witness called on behalf of the complainant, being first duly sworn, deposes as follows:

Direct examination by Mr. BRIESEN:

Q. 1. Please state your name, age, residence and occupation?

A. Felix Jellenik; 50 years of age; lawyer; residence, New York City.

Q. 2. Please state what relation you bore to the complainant, The Standard Paint Company, and for how long a time you have been in such relation?

A. I have been and am now the secretary and treasurer of the complainant company, since its inception in the month of May, 1889.

Q. 3. Does the complainant company, The Standard Paint Company, of which you are secretary and treasurer, manufacture and deal largely in a certain roofing, for which you have adopted the trade name or trade mark Ruberoid?

A. It has and does.

47 Q. 4. Can you give a brief history of the development of the business of the complainant company, The Standard Paint Company, in this business of manufacturing roofing under the name of Ruberoid?

A. I know that the complainant company experimented at its works with respect to the making of a roofing; that was prior to 1891, and finally when the company became satisfied that it had a good roofing, they put out the roofing called Ruberoid at that time and ever since on the market and have continued to deal in it and sell it and make it; and deal in it and sell it in annually increasing sales from the time it first came on the market until the present moment.

Q. 5. And at the present time your business in that roofing is a very large one?

A. It forms the major part of the business of the company.

Q. 6. It amounts to not very far from a million dollars a year?

A. Yes, sir.

Q. 7. You say that in 1891 The Standard Paint Company began to put roofing on the market under the name of Ruberoid?

A. About that time; I cannot be specific as to the exact date.

Q. 8. Can you state whether or not the roofing made by The Standard Paint Company in 1891 was known as Ruberoid before they began making it or whether they selected and invented that particular word to designate their product in contradistinction from others on the market?

A. I know that that time was the first time that I had ever heard the word Ruberoid; I was not concerned with the creation of the word or its adoption; I belonged to the executive part of the business.

Q. 9. But it was your understanding that the word was
48 adopted as a distinguishing mark for the goods of The Standard Paint Company?

Mr. HOMER: I object to the witness's understanding.

A. It was adopted to my knowledge for the roofing manufactured by the company exclusively.

Q. 10. Did you hear the testimony of Mr. Richards this morning?

A. Only in part.

Q. 11. Did you hear that part where he spoke of the distribution of agencies and branch houses and the amount of business done by your company, the number of rolls sold and the prices received therefor in this and foreign countries?

A. Yes, sir.

Q. 12. And your own testimony would be simply a repetition of those figures. if you were questioned in regard to them?

Mr. HOMER: That question is objected to; evidence cannot be taken in that way.

A. From my knowledge as treasurer of the company and my examination of the books and the receipt of the moneys from the various sales of the company during all that time, I know that the sales to which he testified have been made by the company and paid for, for Ruberoid roofing; and also as to the branch houses.

Q. 13. What is the relation, so far as you know, between the word Ruberoid, as applied to roofing, and the complainant company?

A. The complainant company is the originator of the word which it applies, the word Ruberoid, as it is spelled, and they were the first ones ever to use it in connection with roofing.

Q. 14. You mean that they claim to own this word as applied to roofing?

A. Yes, sir.

Q. 15. Do you know anything about the value of the ownership of this word as applied to roofing as an asset of the com-
49 plainant company?

A. I know what the company values it at and I know what the company could get for it if it wished to sell it.

Q. 16. The value of your proprietorship of this trade mark, Ruberoid, as applied to roofing, is far in excess of $5,000, isn't it?

A. Oh, infinitely in advance of that sum.

Q. 17. The Standard Paint Company caused its trade mark to be registered in the United States Patent Office, did it not?

A. It did.

Q. 18. Can you produce a patent office copy of this certificate of registration that you received?

A. I don't know that I have it here. They may have it at the company's office. A patent office copy was attached to the bill of complaint as Exhibit "C."

Mr. HOMER: And the same may be considered as offered in evidence in this suit at this time. Same is marked "Complainant's 'Certificate of Registration.'"

Q. 19. That certificate of registration was dated May 28, 1901, and received the No. 36485?

A. Yes, sir.

Q. 20. Do you know how the roofing sold by the complainant company under the name of Ruberoid is manufactured?

A. Only from hearsay.

Q. 21. You have always understood, however, that no rubber or any compound of rubber or any substance containing rubber is used in connection with the manufacture of it?

A. I know that rubber is not used in any possible form or shape at all from witnessing the manufacture of Ruberoid at the factory at Bound Brook, New Jersey.

Q. 22. You never got any bills for rubber?

A. We never have paid for any rubber in connection with our manufactures.

Q. 23. What knowledge have you as to the product of
50 the defendant company known as RuberO?

A. I first had knowledge of the existence of such roofing from having read the reports made by some people in the West that such a roofing was offered on the market some few months ago.

Q. 24. The result of this information was the bringing of this suit?

A. As a result of that, this suit was instituted.

Q. 25. You also know and can testify that the complainant company has invested and spent large sums of money in advertising its roofing under the name of Ruberoid?

Mr. HOMER: Question objected to as immaterial as to the amount of money expended on advertising.

A. Yes, I do.

Q. 26. Summarizing your testimony, is it your intention to have this Court understand that after experimenting for some time The Standard Paint Company, in 1891, began to manufacture a roofing for the market and adopted and appropriated for the same the trade name or trade mark Ruberoid; that thereafter the business of making and selling this roofing under the name Ruberoid was advertised and advanced steadily, assuming very large proportions in the last few years and making the trade mark or trade name Ruberoid, as applied to roofing, a very valuable and essential asset of the complainant company?

Mr. HOMER: That question is objected to as leading and as not a fair statement of the witness's testimony.

A. I do.

Q. 27. And what effect on the integrity of that asset, the trade mark Ruberoid, has the appearance on the market of the defendant's roofing Rubbero had?

51 A. I know from the reports received from that particular territory in which Rubbero is manufactured and contiguous territory that there has been a falling off of the sales of Ruberoid in that territory during the last few months.

Q. 28. Can you testify of your own knowledge whether such falling off in sales is due to the sale of the defendant's product in that territory?

A. I can only give you what has been reported to the company by dealers in those roofing products.

Q. 29. Do you know of any other reason why your sales should decrease in that territory, except that there is a competing roofing on the market under the name of Rubbero; is there any other reason than that?

A. There is another reason to my mind, from the fact that the sales have not decreased in any other part of the United States so far as is yet observable to us; that this decrease in that territory is due to the fact of the offer of Rubbero to purchasers; and I will add that there is no reason, so far as the Ruberoid is concerned, why the sales should not continue to increase now as they have for many years past.

Q. 30. Can you think of any reason why the defendant company should adopt the name Rubbero for its roofing?

Mr. HOMER: I object to that upon the ground that it is not material what the witness thinks of the question.

A. I can think of no reason on earth why that word should have been adopted by the defendant for its roofing except the popularity which had been attained by Ruberoid.

Q. 31. Do you know of any other reason except the one just stated by you?

A. I know of none and can conceive of none.

52 Cross-examination by Mr. HOMER:

X Q. 1. Do you know of other roofings being made and sold under names in which the word rubber forms a component part?

A. I do not.

X Q. 2. You have heard Mr. Richards testify in regard to the same, have you not?

A. I heard him speak of some competing roofings by various names.

X Q. 3. But you did not hear him refer to any roofings of that kind in which the word rubber was used?

A. I did not; I was probably out of the room at the time.

X Q. 4. So, if there are such other kinds of roofing in which the

word rubber in various forms is used, you have not been informed of that?

A. I have not.

X Q. 5. You are familiar, however, with the fact that of late there have come to be various roofings of materials bearing a resemblance to the complainant's roofing, which have become competitors of the complainant, have you not?

A. I know that there are roofings similar in appearance to that manufactured by the complainants offered and sold on the market.

X Q. 6. How can you then say that it is the effect of the sale of defendant's material that has lessened the sale of the complainant's material?

A. Because, as I have testified, there has been a falling off in the district in which this defendant's roofing is offered and sold.

X Q. 7. Are not these other roofings to which reference has been made sold in the same district?

A. I don't know.

X Q. 8. Do you know in what district the defendant company sells its goods?

A. Only in a general way, that it is the country contiguous to St. Louis.

53 X Q. 9. You do not know then to what extent they sell their goods?

A. I do not.

X Q. 10. At what points has the falling off occurred?

A. Within that territory; the exact limits of it I cannot specify.

X Q. 11. Well, you mean the State of Missouri, for instance?

A. Yes.

X Q. 12. How has there been a falling off in the State of Missouri?

A. That I cannot tell you specifically.

X Q. 13. What other districts did you refer to?

A. I would not undertake to name them; that is not a part of the complainant's business that I give any attention to as a rule.

X Q. 14. You then are not familiar, as a matter of fact, with the extent to which there has been any falling off yourself?

A. I can only tell it from the records of the complainant company, which show about the sales made by our agents at St. Louis and in that territory.

X Q. 15. Well, how much at St. Louis?

A. I haven't got any detailed figures; I only know about the total amount.

X Q. 16. Do you know how much the sales of the Graham Paper Company had fallen off?

A. Not specifically, no.

X Q. 17. You know them as your representatives at St. Louis?

A. I believe they are the agents of the complainant company.

X Q. 18. You cannot give us any idea of the amount of falling off at St. Louis, can you?

A. I cannot.

X Q. 19. Or in Missouri?

A. I cannot.

X Q. 20. Or in any other State surrounding?

A. No.

X Q. 21. This is not a part of your share in the business, I suppose, either?

A. No.

54 X Q. 22. So that what you know about it is what you have been told by some one else connected with the company?

A. No; from reading the reports of our agents and from the amount of sales shipped to that territory; and I get the money for those sales.

X Q. 23. Do you mean to say that you yourself can testify anything in regard to the falling off of the sales at St. Louis or in Missouri?

A. Only from the sources that I have named.

X Q. 24. Well, from those sources, how much has been the falling off?

A. As far as I know, about $8,000.

X Q. 25. How did you learn that; do you mean that that is the falling off in the Graham Paper Company's business?

A. From that territory; I don't know whether the complainant company also sells goods through traveling agents of its own in that territory or not; I am not familiar with its manner of doing business there.

X Q. 26. When you use the words "$8,000" from that territory, what territory do you mean?

A. The territory covered by the agencies established at St. Louis and thereabouts.

X Q. 27. Well, what do you mean by thereabouts?

A. I mean the surounding country.

X Q. 28. Do you mean the State of Illinois?

A. I cannot tell whether that is a part of that territory or not; I don't know.

X Q. 29. Do you mean the whole State of Missouri?

A. I don't know as to that.

X Q. 30. Do you mean Arkansas or Kentucky? Can't you explain it on the record?

A. I can explain that my source of information is simply that from the moneys received from the Western sales coming

55 from the region of St. Louis, St. Louis and the country thereabouts, there have been about $8,000, or perhaps a little more, that we have received less in the last few months than in the corresponding period of last year.

X Q. 31. In order that we may understand about it, "Western" is a very large word. You don't mean to include Chicago or west of that, do you?

A. I cannot say; I only know that is the territory to which my testimony relates, but its outlines I cannot give you; I don't know specifically just what it does include.

X Q. 32. Then, as a matter of fact, you don't know whether the falling off has been in the places where the defendant company has made sales or not, do you?

A. I do know that, because I know of sales it has made in territory very close to St. Louis.

X Q. 33. And you don't know where its sales are made, do you?

A. Not except in the specific instances in which I heard about it.

X Q. 34. Those specific instances were at St. Louis?

A. I really don't just now recollect where the specific instances were, but I received the impression at the time I heard of it that they were at St. Louis or to some people in that territory.

X Q. 35. Now, you are a lawyer, and I wish you would state it in such a manner that we can understand exactly what you do mean?

A. Well, I must answer that I think I have stated it very clearly already.

X Q. 36. I understood you to say in answer to my previous question that you did not know in regard to it specifically. Do I understand you correctly?

A. I did not know except in the manner in which I have already testified I received the information.

X Q. 37. From whom was that information received?

A. From the cashier of the complainant company as to
56 the moneys received, and from Mr. Richards as to the sales in that territory.

X Q. 38. Mr. Richards is familiar with this whole matter, isn't he?

A. I think he is; he ought to be.

X Q. 39. Much more familiar with the facts regarding it than you are?

A. Certainly.

X Q. 40. And the agents of the Company at St. Louis and thereabouts would be able to make this thing much more clear than you can?

A. They may be more specific as to the facts and places, but not as to the results to which I has just testified.

X Q. 41. Well, you got it, as I understand, from the cashier and from Mr. Richards?

A. Yes, sir.

X Q. 42. You spoke about the time this roofing was first put upon the market and you stated that you could not state it accurately, but it was about in 1891?

A. Yes, sir.

X Q. 43. Might it have been 1894?

A. Impossible.

X Q. 44. Well, then, you say about 1891——

A. (Interrupting.) By which I wish to be understood as meaning a very few months either after 1891 or prior to the close of 1891 as the time when it first became to be commercially used.

X Q. 45. (Handing witness paper.) I call your attention to the statement in defendant's exhibit for identification, complainant's advertisement No. 2, being the first statement in the printed matter—I mean after the title page—when Ruberoid was first placed

upon the market in 1892, it attracted considerable attention, and I ask you if you now notice that statement in that printed matter?

A. Yes.

X Q. 46. Now, you in your answer on the direct testimony stated that you had never known the word Ruberoid to be used in
57 connection with roofing. Had you known it to be used in connection with anything else?

A. I learned some years after the Ruberoid roofing was put upon the market that a Connecticut firm had registered the word rubberoid, and I was asked to examine the matter. I found that the Connecticut firm which had adopted that word were manufacturers of knife handles and matters where handles were put upon brushes and other articles of a like character; knife handles and brushes and such things; and I also found that the firm had become insolvent and had, under the laws of Connecticut, transferred all of its property for the benefit of its creditors to a Trustee. I visited the Trustee and spoke to him about the matter and he said the Company had gone utterly out of existence, out of business; and I purchased from him all the right, title and interest of the insolvent owners and of himself as Trustee in and to the word Rubberoid and obtained from him a written assignment of the same to the complainant company.

X Q. 47. You were acting as counsel for the complainant company in registering the trade-mark with the United States Government, were you?

A. I would answer no to that; Messrs. Briesen & Knauth have been the advisers of the Company on all matters connected with trademarks.

X Q. 48. Do you recall that Briesen & Knauth reported to you that they had discovered that the word Rubberoid had been previously registered?

A. I do not recall how that fact was brought to the attention of the Company. I think that must be very likely the way.

X Q. 49. And that information, however you received it, was what led you to seek out and purchase the trade-mark of
58 James D. Frary & Son & Company?

A. Yes, sir.

X Q. 50. You were advised that it was necessary to do so in order to get your trademark registered, were you not?

Mr. Briesen: I object to that question.

A. I received no advice about that matter whatever. I was simply asked to go and get it if I could.

X Q. 51. You learned at that time that a trademark had been issued for the word Rubberoid in 1884, upon a composition as a substitute for hard rubber?

A. I learned that about the time at which I succeeded in buying it, that the trademark had been registered.

X Q. 52. (Handing witness paper.) I show you a paper which purports to be your affidavit or a copy of your affidavit already made in this case.

A. That is a copy of my affidavit.

X Q. 53. It was made in your office here I suppose?
A. No, sir, that was not made in my office; it must have been made in Judson & Green's office.

Paper marked Defendant's Exhibit, Jellenik's affidavit for Identification.

X Q. 54. If that is not a copy of your affidavit, you may indicate in what way it is not.
A. The word in the sixth line in quotation marks should be Rubberoid, and in the next succeeding line it should also be Rubberoid.
X Q. 55. Where is your place of business?
A. Our principal place of business is at Bound Brook, N. J.
X Q. 56. That is where the manufactory is?
A. That is where the factories of the complainant company are situated.
X Q. 57. And where is the principal office of the company—I mean by the principal office, where the principal business
59 is done?
A. That is also at Bound Brook, N. J.
X Q. 58. Is that your shipping office?
A. All the offices.
X Q. 59. All the offices except the branch office?
A. Except the branch office in New York.
X Q. 60. Where is that?
A. That is at 100 William street.
X Q. 61. Were you in business in any way prior to the formation of the corporation?
A. Prior to the formation of the complainant company, there existed the Standard Paint Company of New York, which dissolved and surrendered its charter and became the Standard Paint Company of West Virginia, with the same stockholders and the same business, being simply a transfer of title of all its property to the West Virginia company.
X Q. 62. Well, at the time the change was made, you were not then doing any roofing business at all?
A. Yes, we were doing a roofing business, but not with the same roofing that we manufactured under the name of Ruberoid.

(Cross-Examined Closed.)
Adjourned to Tuesday, October 24, 1905, at 12 o'clock noon.

Subscribed and sworn to before me this 24th day of October, 1905.
(Signed) FELIX JELLENIK.

60 JAMES SCOTT PORTER, of lawful age, being produced, sworn and examined on the part of the plaintiff, deposeth and saith:

Direct examination by Mr. GREEN:

Q. What is your full name?
A. James Scott Porter.

Q. You reside where?
A. In St. Louis.
Q. What business are you engaged in, Mr. Porter?
A. I am with the Graham Paper Company.
Q. How long have you been with that company?
A. I think since the latter part of 1902.
Q. Prior to that time, in what business were you engaged?
A. I was for four years Treasurer of the Trinidad Asphalt Manufacturing Company.
Q. That is the Company which is the defendant in this suit?
A. Yes, sir.
Q. During all the time you have been with the Graham Paper Company, have you been handling roofing products?
A. Yes, sir.
Q. The Graham Paper Company, I believe, is the local agent for the roofing product manufactured by the Standard Paint Company, the complainant in this case, is it not?
A. Yes, sir, we control the agency in two or three States out here.
Q. How long has the Graham Paper Company been handling this product of the Standard Paint Company?
A. My impression is since 1901.
Q. That is about four years, then, approximately?
A. Yes, sir.
Q. Is there any other agent handling that product in this territory?
A. No, sir, not from the Standard Paint Company; we have agents, sub-agents, we call them.
61 Q. Under the Graham Paper Company?
A. Under the Graham Paper Co.
Q. In other words, the Graham Paper Company has the exclusive agency for the Standard Paint Company in this territory?
A. Yes, sir.
Q. By what name is the roofing product of the Standard Paint Company known to the trade in this territory?
A. "Ruberoid."
Q. Is it ever known, or called for, or advertised in this territory by any other name than that?
A. No.
Q. Do dealers and customers in ordering it ever order it under any other name, or is it ordered by the name of "Ruberoid?"
A. By "Ruberoid;" once in a while they order "the kind manufactured by the Standard Paint Company."
Q. Do you know anything about the advertisement of this product of the Standard Paint Company, as to the name under which it is advertised?

Objected to by Mr. Homer, because the advertisements are the best evidence.

A. It is advertised under the name of "Ruberoid."
Q. Do you know anything about the extent of the advertising in

this territory, whether it has been extensively advertised, or otherwise?

A. Well, yes; we have advertised ourselves a great deal, in the way of samples, in circulars, sent them to all the hardware and lumber people, in the spring and fall of the year; and the Standard Paint Company advertise it with the Architects and in the farm papers; we get a great many inquiries from farm papers.

Q. Has this product of the Standard Paint Company a sale in foreign countries, as well as in this country, if you know?

A. I understand that it has.

Q. Do you know of your own knowledge?

A. No.

62 Q. Does your firm sell it in foreign countries?

A. No, we are not allowed to sell outside of our territory.

Q. Do you know how long this roofing product of the Standard Paint Company has been on sale in this territory, whether it was being sold in this territory prior to the time the Graham Paper Company took charge of its sales?

A. When I first got into the roofing business in Ninety-eight, it was on sale then.

Q. In 1898?

A. Yes, sir.

Q. Has been on sale in this territory ever since?

A. Yes, sir.

Q. Do you know the roofing product now being manufactured and sold by the Trinidad Asphalt Manufacturing Company under the name of "RubberO" roofing?

A. I have seen samples of it.

Q. Do you know whether their roofing product is now being sold in this territory?

A. Well, we have had correspondence about it, it is my general understanding that it is.

Q. You have no particular knowledge about the extent of the sales?

A. No, sir.

Q. Do you know whether it is being advertised in this territory for sale?

A. Well, I see slips enclosed in the mail that we receive from that firm, advertising it.

Q. Under what name do they advertise their product?

A. "Rubbero."

Q. Does the Trinidad Asphalt Manufacturing Company itself manufacture this "Rubbero" roofing?

A. To the best of my knowledge, no, sir.

Q. Where is it manufactured?

A. I cannot state positively.

Q. Is it manufactured for them by a firm in Pennsylvania?

A. I understand it is.

63 Q. And brought into this territory and sold by them?

A. Yes, sir.

Q. How long did you say you had been in the business of selling roofing products?

A. About seven years altogether.

Q. Now, from your knowledge and experience, gained in handling and dealing in different roofing products, can you tell us which of these two roofing products, "Ruberoid" manufactured by the Standard Paint Company, the complainant in this case, or "Rubbero," manufactured by the Trinidad Asphalt Manufacturing Company, the defendant, is the better roofing product?

Question objected to by Mr. Homer as it does not appear that the witness has made any tests or has any technical knowledge regarding the qualities of the two roofings.

A. Why, I cannot say from my knowledge of what goes into the roofings to make them a durable or satisfactory roofing, as I cannot state positively what goes into either one of them. But from a dealer's standpoint, I should say that the "Ruberoid" roofing is the best. It enjoys a reputation as being a roofing that has had fourteen or fifteen years' service, and is well recognized as a thoroughly durable roofing.

Q. Have you ever examined any of the samples of the roofing manufactured by the defendant in this case, "Rubbero" roofing?

A. Not closely.

Q. From your knowledge and experience of the roofing business, and of the trade in these various roofing products, state whether or not in your opinion the names "RubberO" and "Rubberoid" are so sufficiently similar, as to mislead and deceive the public, to lead the people to buy one product thinking it was the other?

64 Objected to by Mr. Homer, as it does not appear that the witness is an expert, or that he has any special knowledge that qualifies him for testifying in regard to this matter, and that the question is irrelevant for the further reason that the witness cannot testify without having submitted to him the labels or trade-marks themselves, which it does not appear that witness has ever seen.

A. To a person not thoroughly familiar with the many kinds of roofings, in my opinion I should say that the word "Rubbero" was misleading and being so similar to "Ruberoid" that a purchaser might think he was buying the genuine "Ruberoid" roofing.

Q. Have you ever seen the samples, advertising samples, of "Rubbero" roofing sent out by the defendant in this case with the trade-mark stamped on them?

A. I have seen the samples, but I cannot recall the trade-mark. I have a recollection, I believe of the samples.

Q. Did you see the word "Rubbero" on those samples?

A. Yes.

Q. You have seen the advertising matter sent out of "Ruberoid?"

A. Yes, sir.

Q. The trade-mark and the word "Ruberoid" on it?

A. Yes, sir.

Cross-examination by Mr. HOMER:

Q. Why do you say that to those not familiar with roofing that there might be a mistake made between "Ruberoid" and "RubberO?" What is your reason for that answer?

A. Well, what brought that to my mind,—I had a customer in the office one day to whom I quoted a price on "Ruberoid" roofing, and he told me I was too high, and that he could buy it from the Trinidad Asphalt Manufacturing Company at a lower price.

65 I told him that they were not handling it, and he said it was the same. I happened to have some samples there, and I showed him the samples and showed him the difference in the words.

Q. When he saw the two words he saw the difference?

A. Well, when I pointed out to him that one had "i-d" on the end of it.

Q. What I was trying to get at was whether you, this man or you,—were speaking of the label which was on the goods, or whether you were speaking of the sound of the word?

A. I could not speak of what he was speaking of, but of course my knowledge on it was perfectly clear.

Q. I mean what did you base your idea upon it,—is it the sound of the word?

A. Why, in that case I should say that the similarity in the sound of the word, led him to believe he was getting "Ruberoid" roofing.

Q. In other words, he probably pronounced the word "Rub-beroid?"

A. I do not know what he pronounced the word, but he said he could get the same thing cheaper from the Trinidad Asphalt Manufacturing Company.

Q. Are you positive that he used the word "Ruberoid?"

A. As to whether he used one or two b's in it?

Q. Yes, in pronouncing it?

A. I could not say as to that.

Q. In that case, this gentleman, so far as you are able to understand what it was, the difficulty arose because of the mispronunciation of your word?

A. No, I would not say that; I think that the similarity of the words led him to believe he could get the same roofing as we had there, until his attention was called to the fact that they were different articles.

Q. Now, is that word in your business called "Ruber-oid"

66 or "Rub-beroid?"

A. "Ruberoid,"—one "b."

Q. Now, what was the name of this man with whom you were talking?

A. I don't recall his name; that was some time last spring or last summer.

Q. Did you sell him?

A. No, sir; he promised to come back, but didn't.

Q. Could not you recall it in some way if you took time to look it up?

A. No, sir; there was men coming in there every day; I didn't——

Q. You are quite sure that you could not find out the name of that man by any amount of investigation or thought?

A. No, sir.

Q. There are on the market here quite a large number of roofings which are spoken of in a general way as rubber roofings, are there not?

A. Yes, sir.

Q. Can you mention some of those?

A. Why, "Compo-Rubber Roofing," "Original Rubber Roofing," "Huttig's Rubber Roofing," "Galvanized Rubber Roofing," "Perfection Rubber Roofing." I would have to get my list to name others.

Q. These rubber roofings which you have mentioned and others which you say you cannot recall now, are roofings which bear in their general appearance a similarity to the "RubberO" and the "Ruberoid," are they not?

A. Yes, sir.

Q. They are ready-manufactured roofings, which are put up in rolls and sold to the trade all over?

A. They are.

Q. You speak of "Huttig's Rubber Roofing?"

A. "Huttig's Rubber Roofing," I think, is the name.

Q. Is that manufactured and sold here?

A. It is sold here: Huttig does not manufacture it.

Q. Where is the concern that makes the Huttig's Rubber
67 Roofing, if you know?

A. I don't know who makes the Huttig's Roofing.

Q. Who sells it?

A. Huttig Sash & Door Company.

Q. They are a St. Louis city concern?

A. Sash and door company, as manufacturers of sash and doors.

Q. And this "Original Rubber Roofing," was that the right name for that?

A. Yes, I think that is the name it goes by.

Q. Do you know where that is manufactured?

A. No, I cannot say where it is manufactured, positively. It has been represented to us by salesmen and dealers as being sold by an Indianapolis paper company, the Capitol Paper Company.

Q. Do you know of a roofing called Miko Rubber Roofing?"

A. I have heard of the roofing; yes, sir.

Q. There are a large number of these roofings which go under the general term "rubber roofing," which gets its name; no doubt, from the appearance of the roofing, is not that a fact?

A. Yes, I think that is the case.

Q. You spoke about the product of the defendant company, that which is sold as "RubberO," do you know anything about this product yourself?

A. Do I know anything about it?

Q. Yes?

A. In what way?

Q. You spoke of it as if you did know about it; do you know anything about its manufacture?

A. Well, I have a general knowledge on that; not positive, but I have been told where it is manufactured.

Q. You don't know of your own knowledge where it is manufactured?

68 A. No, I could not swear to that, but I am satisfied it is manufactured where I think it is.

Q. As to the component part of either of these roofings, either the complainant's or the defendant's, you do not know?

A. As to what goes into them?

Q. Yes, as to what goes into them?

A. No, I could not say.

Q. What States does the Graham Paper Company have under their contract?

A. Southern Illinois, Missouri, Kansas, part of Arkansas, Indian and Oklahoma Territories.

Q. When did you say you severed your connection with the defendant company?

A. I think it was in November, 1902.

Q. You have now no interest in that company?

A. None whatever.

Q. Well, at that time, were you a stockholder?

A. Yes, sir.

Q. Did you leave the defendant company in good feeling towards the officers of the company?

A. In view of the circumstances under which I left them; no, sir.

Q. Have you brought with you to-day a statement of the sales by your company of "Ruberoid" Roofing?

Objected to by Mr. Green, as we had not gone into that.

A. No, sir.

Q. Have you looked into that question at the suggestion of counsel?

A. No, sir.

Q. Have you looked into it at the suggestion of the New York office of the Standard Paint Company?

A. No, sir.

69 Q. Have you made any statement to them regarding the sales and the comparison between the sales of the last year and the sales for the year before?

A. No, I don't remember of any statements. They keep all the records of our sales; they don't ask us for what they are. They know better than we do.

Q. You never have had any experience in comparing labels and trade-marks with other labels or trade-marks in trade-mark cases?

A. No, sir.

Q. Have you ever made any attempt to compare the label which is used upon the Standard Paint Company goods with the words "Ruberoid" and the label which is used on the Trinidad Asphalt Manufacturing Company goods with the words "RubberO?"

A. Never have seen a roll of the Trinidad Asphalt Manufacturing Company's "RubberO."

Redirect examination by Mr. GREEN:

Q. You spoke of having had an unfriendly feeling against the defendant in this case at the time you left its employment: Has that feeling continued until the present time?

A. No, sir.

Q. Your relations at present with that company and its officers is perfectly friendly?

A. Yes, sir; so far as I am concerned they are. I took my medicine like a man and charged it to experience.

—— ——.

Subscribed and sworn to before me this — day of December, 1905. My commission expires January 13th, 1908.

—— ——,
Notary Public.

Counsel for complainant then offered stipulation signed by solicitors for complainant and defendant, and Exhibits A, B and C, thereto attached, and requested that the stipulation and exhibits be attached as an exhibit to this deposition; which was done by consent of counsel for defendant.

Complainant's counsel then notified defendant's counsel that this closes complainant's case in chief.

70 *Defendant's Evidence.*

WILLIAM L. R. GIFFORD, of lawful age, being duly sworn, deposeth and saith as follows:

Direct examination by Mr. HOMER:

1 Q. State your name, age, residence and occupation?

A. My name is William L. R. Gifford, my residence is No. 4329A Maryland avenue, in the City of St. Louis. I am Librarian of the Mercantile Library.

2 Q. Do you know the Standard Paint Company, or the Trinidad Asphalt Manufacturing Company, or its officers?

A. I do not. I am not conscious that I ever heard of them.

3 Q. In what business or occupation have you been engaged during your life?

A. Librarian only.

4 Q. Are you a graduate of any Educational institution?

A. Yes, sir; I am a graduate of Harvard.

5 Q. Where have you been engaged as Librarian?

A. I was Assistant Librarian in New Bedford, Massachusetts, Librarian in Cambridge, Massachusetts, and have been Librarian here at the St. Louis Mercantile Library.

6 Q. How many years does that cover?

A. That covers a period ever since I left college, which is something over twenty-one years.

7 Q. Has this given you an opportunity to familiarize yourself with language and words?

A. More or less, inevitably, using languages of one sort or another all the time.

8 Q. I will ask you if you have looked up and considered the word "rubberoid" or "ruberoid?"

A. Yes, sir.

71 9 Q. What do you understand to be the meaning of that word or words?

Objected to as irrelevant, incompetent and immaterial to any of the issues in this case.

A. Something like rubber, or resembling rubber.

10 Q. How do you arrive at that?

Objected to for the same reason as above stated.

A. Simply because the suffix "oid" is a very common suffix in scientific terms, and has that distinct meaning, and nothing else. It means like, or resembling the word to which it is added as a suffix.

11 Q. Is that the universal meaning of the suffix?

Same objection.

A. It is, so far as I know.

12 Q. Can you illustrate that by words in common use?

Objected to for the reason before stated.

A. Yes, sir; if you wish an example. I can illustrate it by several words. A very common one is "typhoid," which, in its origin means resembling typhus, and there are numerous examples in mathematics. "Sphereoid" means a figure that resembles a sphere, but is not a sphere, and "asteroid" means like a star, joined right on, of course to the original word "aster." A common word that we hear of in geology is "amygdaloid." That simply refers to a geological structure in which there are certain cavities which resemble almonds in shape. That is where the name has come from,—"resembling almond."

13 Q. Have you examined dictionaries for this word "rubberoid?" Have you found it?

Objected to as immaterial, incompetent and irrelevant.

A. I have found it in several dictionaries.

72 Further objected to on the ground that the dictionaries themselves would be the best evidence.

14 Q. Have you the definition as it is in the Standard Dictionary?

A. I have. I have a copy of that.

15 Q. Have you it here?

A. Yes, sir.

Mr. GREEN: That may go in as a correct copy.

WITNESS: I made a copy of the definition as given in the Standard Dictionary.

16 Q. Just give it, please.

Witness reads "Rubberoid: Compositions in imitation of commercial india rubber." There were three forms given here,—rubberite, rubberide and rubberoid.

17 Q. What is the imprint of the copyright?

A. On this copy of the Standard Dictionary the copyrights are 1890, 1893 and 1894.

18 Q. Your understanding of the meaning of the word would be that it was like or resembled rubber, but was not necessarily made of rubber?

Further objected to as suggestive.

A. I should prefer to stick exactly to the definition, which is all I know of the subject—to the exact meaning, like or resembling rubber. As to its composition, I had better not go into any details.

Cross Examination declined.

FRANK W. TERPENNING, of lawful age, being produced, sworn and examined, deposeth and saith, as follows:

Direct examination by Mr. HOMER:

1 Q. State your name, residence and occupation?

A. My name is Frank W. Terpenning. I reside in St. Louis, Missouri, and am Secretary and Treasurer of the Trinidad Asphalt Manufacturing Company.

73 2 Q. What is the business of the Defendant Company?

A. The manufacturing of roofing and paving and insulating material.

3. How long have you been connected with or had knowledge of the roofing business?

A. Since 1892.

4 Q. Have you since that time been constantly engaged in the manufacturing of roofing?

A. Yes, sir; I have, practically all the time.

5 Q. Have you been engaged in the manufacture of what is known as prepared or ready roofing?

A. Yes, sir.

6 Q. Has your concern a trade mark which you used on prepared roofing?

A. We have several of them.

7 Q. Have you one which is known as "Rubber O?"

A. Yes, sir.

8 Q. I will ask you if this is a certified copy from the Secretary of State of Missouri of the trade mark?

A. Yes, sir.

Defendant offers in evidence trade mark of Defendant and asks the same to be marked "Defendant's Exhibit, Defendant's Trade Mark."

Objected to as being irrelevant, immaterial and incompetent to any issue in this case.

9 Q. Have you a sample of the label upon a roll of roofing, of the Defendant's Trade Mark here?

A. Yes, sir.

10 Q. Will you produce it?

Witness produces same.

11 Q. What is this which you now show?

A. It is a roll of RubberO roofing, with the necessary trimming for applying same tacked in the center of the roll, with directions for applying it.

12 Q. I will ask you to read and describe the label.

Counsel for Defendant at this point offers in evidence the
74 label and the roll produced, and asks the Examiner to mark the same "Defendant's Exhibit Defendant's label and roll," which is accordingly done.

13 Q. Is this label and wrapper the same wrapper which you use in selling all of the goods which you mark "RubberO?"

—. Yes, sir.

14 Q. What is the size of the label?

A. 14 inches by 10 inches.

15 Q. This green label is pasted upon the wrapper which encloses the roll, is it?

A. Yes, sir.

16 Q. And the color of the wrapper is what?

A. The color of the wrapper is pink.

17 Q. The ground work of the label is green, and the type is black?

A. Yes, sir.

18 Q. Have you a sample of the roll and wrapper of the Plaintiff roofing?

A. I have a sample of a roll of the roofing with the wrapper, label and the carton in which they packed the trimming.

19 Q. Will you produce it?

A. Yes, sir. (Witness produces same.)

20 Q. Is this it?

A. Yes, sir.

Defendant offers in evidence said roll and wrapper, and asks the Examiner to mark the same: "Defendant's Exhibit, Complainant's Roll and Wrapper," which is accordingly done.

21 Q. The printed matter on this wrapper is printed immediately on the wrapper, and not on a label pasted upon the roll, is it?

A. Yes, sir; with the exception that the words "Graham Paper Company, St. Louis and Kansas City, Missouri," are pasted on.

22 Q. Leaving off the words regarding the amount and number of the ply, what is the measurement of the printed matter which form the real label?

A. Nineteen inches in length by twelve inches.

75 23 Q. That does not include the mark of the Graham Paper Company, nor the mark regarding the amount in the roll or the number of the ply?

A. No, sir.

24 Q. What is the color of the wrapper?

A. It is a light brown manilla.

25 Q. The groundwork upon which the printing rests is black, is it?

A. Well, it is a plate which is known as a reverse plate, showing the brown through black. That is done with a plate.

26 Q. State whether there is known in the trade a variety of roofings which go under the general name of "rubber roofings?"

Objected to as incompetent.

A. There are very many of them. As many as forty.

27 Q. State whether you are familiar to any extent with the materials of such roofing?

A. I am.

28 Q. I mean as to whether or not they are made of rubber?

A. I am.

29 Q. State whether or not they are made of rubber?

A. There are none of them, so far as my knowledge extends that contain any rubber.

30 Q. Have you samples of the rolls with the labels on them of other manufactures? I show you a roll, and ask you what it is?

A. That is a roll of compo rubber, known as "compo rubber roofing."

31 Q. Who are the manufacturers?

A. Made by the Lincoln Water Proof Cloth Company, Bound Brook, N. J., the same town in which the rubberoid roofing is made.

Defendant offers in evidence said wrapper and roll and requests the Examiner to mark the same: "Defendant's Exhibit
76 Compo Rubber Roofing, Label and Roll," which is accordingly done.

31 Q. What is this roll and wrapper which I show you?

A. That is a roll of roofing known as paroid roofing, made by F. W. Bird & Son, East Walpole, Mass.

Defendant offers in evidence said label and roll and asks the Examiner to mark the same "Defendant's Exhibit Paroid Roofing," which is accordingly done.

Complainant's counsel objects to the same as being immaterial.

33 Q. What is this roll and wrapper that I show you?

A. It is Indruroid Roofing. It is made by H. F. Watson & Co., Erie, Pa.

Defendant offers in evidence the wrapper and roll referred to, and asks that the same be marked: "Defendant's Exhibit Indruroid Roofing," which is accordingly done.

34 Q. What is this that I show you?

A. That is the Perfection rubber roofing, made by the General Roofing Manufacturing Company, East St. Louis, Ills.

Defendant offers the label and the roll in evidence, and asks the Examiner to mark the same: "Defendant's Exhibit Perfection Rubber Roofing," which is accordingly done.

35 Q. What is this which I show you?
A. That is a roll of roofing known as Galvanized Rubber Roofing, manufactured by Ford & Co., Vandalia, Ills.

Defendant offers in evidence the roll and label referred to, and asks Examiner to mark the same: "Defendant's Exhibit Galvanized Rubber Roofing," which is accordingly done.

36 Q. What is this which I show you?
A. That is a roll of roofing known as Flint Kote, which is
77 a similar roofing to the others manufactured by J. A. & W. Bird & Co., which I understand is also manufactured at Bound Brook, N. J.

Defendant offers in evidence said roll with the wrapper, and asks that the same be marked: Defendant's Exhibit Flintkote Roofing," which is accordingly done.
Plaintiff's counsel objects to the same as being immaterial.

37 Q. What is this which I show you?
A. That is a roll of roofing sold by the Capitol Paper Company, Indianapolis, Ind., under the name of Original Rubber Roofing. This roll was obtained from them, the- advising us that they were out of the label such as they were using, and we simply stenciled it to identify the roofing.
38 Q. It is sold, is it, under the name of The Original Rubber Roofing?
A. They sell it under the name of The Original Rubber Roofing.

Defendant offers in evidence said roll, and asks the Examiner to mark the same: "Defendant's Exhibit, Original Rubber Roofing," which is accordingly done.
Complainant's counsel objects to the same as being immaterial.

39 Q. What is this?
A. That is a roll of Lasticite roofing, sold by The Crescent Paper Company of Indianapolis.

Defendant offers in evidence said roll and wrapper, and asks that the same be marked "Defendant's Exhibit Lasticite Roofing," which is accordingly done.
Plaintiff's counsel objects to the same as being immaterial.

40 Q. State whether all of these various roofings which are shown to you are put up and sold in substantially the same manner
78 as the roofing of the Complainant?
A. Yes, sir.
41 Q. Are they sold under different plys?
A. Yes, sir.
42 Q. What are the usual plys which are sold?
A. One, two and three ply, some of them half plys.
43 Q. State whether the exterior appearance of these rolls is similar to that of the Complainant's?

Objected to, on the ground that the rolls will speak for themselves.

A. In my opinion, it is.

Cross-examination by Mr. GREEN:

1 X Q. Where is your roofing manufactured, which you sell under the name of RubberO?

A. It is manufactured in Erie, Pa.

2 X Q. By what firm?

A. H. F. Watson & Co.

3 X Q. It is put up in rolls by them?

A. Yes, sir.

4 X Q. And labeled?

A. No, sir.

5 X Q. Where is it labeled?

A. It is labeled and the trimmings are packed here in St. Louis, usually.

6 X Q. By the Trinidad Asphalt Mfg. Co.?

A. Yes, sir.

7 X Q. What is this roll of roofing here entitled "Black RoofO?"

A. That is not the same character of roofing at all. That is two-ply tarred felt roofing. It is not the so-called "rubber roofing."

8 X Q. Isn't that the roofing sold by the defendant in this case?

A. Yes, sir.

9 X Q. Is it similar to the roofing sold under the name of RubberO?

A. No, sir.

10 X Q. What is the difference?

A. One is tarred felt product, and the other is not.

11 X Q. Which is tarred felt?

A. The Black RoofO.

12 X Q. What is the RubberO?

79 A. The RubberO is made of a different compound entirely, no coal-tar used in it.

13 X Q. This Black RoofO is coal tar?

A. Yes, sir.

14 X Q. Where is the Black RoofO made?

A. That is made by the Barrett Mfg. Co.

15 X Q. In St. Louis?

A. Yes, sir.

16 X Q. Are they both used for the same purposes?

A. Well, the Black RoofO is a much cheaper piece of goods, and as a rule, is used for temporary work.

17 X Q. The trade-mark which you were shown a few minutes ago is one issued by the State of Missouri, is it not?

A. Yes, sir.

18 X Q. Why did you never have your trade-mark registered in the Patent Office at Washington?

Objected to as wholly immaterial, and not calling for the knowledge of the witness.

A. I know of no reason, except, I supposed that the registering in Missouri was all that was sufficient.

19 X Q. Did you ever apply for registration at Washington?

A. No, sir.

20 X Q. You knew that under the laws you could have it registered there if you wanted to?

A. I suppose we could, but we never thought it necessary, as long as we had it registered here?

21 X Q. How long have you been acquainted with the Rubberoid Roofing manufactured by the Standard Paint Company?

A. I have known of it for several years.

22 X Q. How long?

A. Probably seven or eight years, when I first knew of it.

23 X Q. How long has it been selling in this territory?

A. I don't know.

24 X Q. At least ten years, hasn't it?

A. I couldn't say as to that.

80 25 X Q. How long, to your knowledge?

A. Well, I have known of it for the past seven or eight years, it was brought to my attention.

26 X Q. When did you commence selling roofing under the name of RubberO Roofing?

A. I think it was in early part of 1904.

27 X Q. You knew at that time that the Standard Paint Co. had been selling a roofing known as Ruberoid Roofing for seven or eight years, didn't you?

A. I knew there was such a roofing on the market; yes sir.

28 X Q. You knew they had a large trade in the roofing product sold under that name?

A. I had no way of knowing how much they were selling.

29 X Q. You had seen their roofing?

A. I had seen their roofing and advertising matter.

30 X Q. Their labels and trade-marks?

A. I knew nothing of their trade-marks; I had seen their rolls frequently.

31 X Q. You had seen their rolls and that says on its face that it has a registered trade-mark doesn't it?

A. I don't know whether it does or not. I see this roll here says: "Trade Mark."

32 X Q. "Registered"?

A. Yes; in very fine print.

33 X Q. You had seen that when you commenced selling your product?

A. I had seen that, as well as other roofing.

34 X Q. You had seen the sample in which the trade — was registered?

A. No, I don't recall any samples where the registration was made.

35 X Q. You are familiar with the samples sent out, small square samples?

A. Yes, sir.

36 X Q. You sent out samples of RubberO made up in the same way?

A. No, sir.

37 X Q. Made up in the same sheets, put together in the

81 same way?

A. O, we send out samples put together with a fastener in

it, which is usual with all manufacturers of roofing. Our samples of roofing are much similar.

38 X. Q. You knew at the time you began selling your roofing under the name of RubberO roofing that the Standard Paint Company had advertised its Rubberoid Roofing very extensively?

A. I don't know to what extent; I had seen their advertisements.

39 X Q. Do you know anything about the extent of the trade and business they were doing?

A. No, sir.

40 X Q. Why did you adopt the name RubberO for your roofing product?

A. Simply because we adopted a trade name, and all that class of roofings are a substitute for rubber; no rubber in them at all. We wanted to use the word rubber, and we added the Letter "O" to it, as we have to the word "Black RoofO." Another brand that we have is called "ActiniO."

41 X Q. You could have adopted some form of it using the word "rubber," and it would have carried less resemblance to the word "Ruberoid" than the word RubberO does, would it not?

A. I don't know of any.

42 X Q. That is the only word that you could think of, was it?

A. The only word I did think of at the time. There were other words that I could have used that I thought would conflict with other names, which I was anxious to avoid.

43 X Q. You tried to select a word that would not conflict with any of the names?

A. I did, that we could use as a distinctive brand.

44 X Q. Do you have an extensive trade in RubberO Roofing?

A. Not very large.

82 45 X Q. Where does it sell generally?

A. Well, in different parts of the country.

46 X Q. All through the United States?

A. No, not all through the United States.

47 X Q. Do you sell any in foreign countries?

A. Not that I know of; I don't recall any foreign sales.

48 X Q. What is the extent of your sales, say for the year ending December 31st, 1905?

A. I couldn't tell you that.

49 X Q. Have you any idea? Could you approximate it?

A. No, because we handle many other brands and kinds of roofing, and I could not from memory tell you what we do sell of any one particular brand.

50 X Q. This label bearing the name "Graham Paper Company, St. Louis and Kansas City, Missouri," which is on the roll of paper manufactured by the Standard Paint Co. offered in evidence here as an exhibit was placed on there after it was shipped to the Graham Paper Co. at St. Louis, was it not?

A. I couldn't say as to that.

51 X Q. You know the Graham Paper Co. handles the product of the Standard Paint Company in St. Louis, in this territory?

A. Well, it would be either put on after it came here or previous to shipment from the factory.

52 X Q. Roofing manufactured by the Standard Paint Company would not bear that label, would it?

A. No, I presume not. If it was some other jobber he would stick his name on it.

53 X Q. Does the RubberO roofing handled by the defendant in this case sell at a lower price than the Rubberoid Roofing manufactured and sold by the Standard Paint Company?

Objected to, because it does not appear that the witness is
83 familiar with the price at which the Rubberoid roofing is sold.

A. Why, I couldn't state positively as to that, but all of these roofings such as are shown here, the price is probably about the same. Some of them, I expect, are sold for less and perhaps some of them for more; I couldn't say.

54 X Q. You don't know whether this is a cheaper roofing than the roofing of the Standard Paint Company or not?

A. No, sir; I don't know what their prices are at the present time.

Defendant offers in evidence trade-mark of the word "Rubberoid," issued to James D. Frary & Son Co., registered January 8th, 1884, and asks the Examiner to mark the same: "Defendant's exhibit Frary Trade Mark," which is accordingly done.

Defendant also offers in evidence contents of file-wrapper in the aforementioned trade mark, and asks the same to be marked: "Defendant's Exhibit Frary File Wrapper," which is accordingly done.

Defendant also offers in evidence certified copy of trade mark on the word "Rubberoid," issued to the Rubberoid Company, the same being registered under date of July 9th, 1878, and asks that the same be marked "Defendant's Exhibit trade mark Rubberoid Co.," which is accordingly done.

Complainant's counsel objects to the above offer of proof, as being immaterial.

Subscribed and sworn to before me, this — day of February, A. D. 1906.

____ ____,

Notary Public and Special Examiner.

84 *Stipulation.*

It is hereby stipulated and agreed by and between the parties hereto that the following evidence may be considered as offered in regular form in the above entitled cause in behalf of the defendant; complainant, however, reserving the right to object to the relevancy or competency of the said evidence:

1. Letters Patent of the United States issued to Henry A. Clark of Boston, Massachusetts, dated November 14, 1876, bearing number 184,341, and marked "Defendant's Exhibit Clark Letters Patent No. 1."

2. Letters Patent of the United States issued to Henry A. Clark of Boston, Massachusetts, dated April 2, 1888, bearing number 201,992, and marked "Defendant's Exhibit Clark Letters, Patent No. 2."

Complainant consents to the use of the office copies of said Letters Patent without the same being certified.

3. Advertisement of complainant identified by John N. Richards, and heretofore marked for identification by examiner taking said Richards' evidence, the same being marked "Defendant's Exhibit Complainant's Advertisement No. 2."

4. Affidavit of Felix G. Jellenik identified by said Jellenik and marked "Defendant's Exhibit Jellenik's Affidavit."

5. Label identified by witness Tarpening and marked "Defendant's Exhibit, Defendant's Label."

JUDSON & GREEN,
Solicitors for Complainant.
W. B. HOMER,
Solicitor for Defendant.

NOTE.—It is understood and agreed that the exhibits introduced in evidence and marked by the Examiner may be retained by the Defendant's Solicitor and produced at the hearing.

85 *Complainant's Evidence in Rebuttal.*

FELIX JELLENIK, being produced as a witness on the part of the complainant, being first duly sworn, deposes as follows:

By Mr. BRIESEN:

Q. 1. You are the same Felix Jellenik who has heretofore testified in this cause, are you not?

A. I am.

Q. 2. And your name, age, residence and occupation remain the same, except for the passage of time?

A. Yes.

Q. 3. I understand that Counsel for the defendant has offered in evidence an affidavit made by you and entitled in this cause, dated June 29, 1905: In this affidavit you state that the word "Ruberoid" or "Rubberoid," or any similar word, was not in use, nor had ever been used anywhere for any kind of roofing material prior to the adoption thereof as a trade mark by The Standard Paint Company: You refer in your affidavit to the use of the word "Rubberoid" by a Connecticut firm as a trade-mark for handles for cutlery: Your affidavit is not quite clear as to when this cutlery concern abandoned its business and trade mark and went out of business?

A. The Connecticut firm to which I referred in my said affidavit made an assignment for the benefit of creditors and went out of business in the year 1884, and never thereafter resumed business. The plaintiff acquired the title to the trade-mark used by such Connecticut firm by a purchase from the Trustee of such firm in the year 1901, for the purpose of avoiding any question on the part of

the Patent Office at Washington in making a record of the trade-
mark adopted by the complainant herein, and to prove to the
86 Patent Office that such use of the word "Rubberoid" had
been absolutely abandoned since 1884.

Q. 4. I also understand that the defendants have offered in evidence certain trade-marks and Letters Patent taken by Henry A. Clark of Boston, in 1876 and thereafter: Please state when you first had knowledge of these alleged trade-marks and patents?

A. The first time I ever heard of them was subsequent to the commencement of this action, and some time after the affidavit which I made, bearing date June 29th, 1905, and was first brought to my attention in the winter of 1905 through a communication from the Patent Office in answer to an application made by the complainant company for registration of the word "Ruberine" as a trade-mark for paint.

Q. 5. The Patent Office made no such objection to your recent registration of the word "Ruberoid" for roofing, did it?

A. None at all.

Q. 6. These patents and trade-marks, as I understand it, seem to refer to a substitute for rubber, and not to any roofing, or any analog-us material; that is your understanding, is it not?

A. Yes.

Q. 7. And consequently the Patent Office very correctly did not object to the registration of "Ruberoid" as a trade-mark for roofing, but did object to the trade-mark "Ruberine" when applied to paints, which might be said to be in the nature of a rubber substitute?

A. I presume that was the theory of the Patent Office.

Q. 8. Since receiving notice of the use of the word "Rubberoid" by Clark's Company in the late '70's, have you made any effort to discover what the true facts regarding the use of that word was, and if so, please state what you have found.

A. Yes; we immediately instituted inquiries amongst our
87 salesmen and the persons with whom we had been dealing
for the past fifteen years, as to whether they, or any of them, had ever heard of the use of the word "Rubberoid" as a trademark in connection with rubber substitutes as called for by Clark's trade-marks, and have been universally advised that the word had never been heard of by any of these people, and that there was no product on the market during said last named period sold under that name whatever.

We then learned that the patents and trade-marks had been acquired by the Rubberoid Company in the 70's. The Rubberoid Company was on record as doing business in Philadelphia, Penn., in the late '70's. We also learned that that Company at that time had discontinued its business, and we looked up all the officers of the Rubberoid Company in Philadelphia, and learned that Charlemagne Tower (the father of the present Minister of the United States to Germany) was the president of the Rubberoid Company, anl that said president died many years ago. We learned that a Mr. Bailey was the secretary, and the administrator of said Tower, and from him we learned that the Company did no business what-

ever subsequent to 1879 or 1880, and said Bailey also stated that he did not remember that said Company ever did any active business whatever. All of the other officers of the Company (which had established its headquarters at Philadelphia) had disappeared and could not be found.

We also sought information from the trade papers concerning the Rubberoid Company and its business, and were advised that the Company was not at all known in the trade.

We next discovered that the Rubberoid Company had obtained its charter in the State of Connecticut, and upon examination
88 of the records we discovered that one, A. B. Nettleton, was an officer of the company in 1878. We were informed by the Secretary of State of the State of Connecticut that the Rubberoid Company had not filed any annual reports or done any business for the last twenty-five years, and for this reason its charter had been revoked by the State of Connecticut. We obtained a certificate to this effect, and filed the same with the Patent Office at Washington. I am ready to obtain another for the use of this Court if it should be desirable.

Next, we tried to trace Nettleton. We searched through his various residences in Philadelphia, and were finally told he was in New York. We hunted for him through New York, but could not find him. We heard of an A. B. Nettleton, quite by accident, as residing in Chicago, and upon directing a letter of inquiry, found that the Chicago Nettleton was the same person who was Secretary of the Ruberoid Company in 1878. I was advised by said Nettleton that the Rubberoid Company had gone out of business, and had been entirely out of the market for any product whatsoever since the late '70's.

From my investigations, conducted during the last three or four months, of the Rubberoid Company and its use of the word "Rubberoid," I find that the Rubberoid Company may have gone as far as to attempt the introduction of a rubber substitute under the name of "Rubberoid," but having failed in introducing it commercially, for use, abandoned its business, and its use of the word "Rubberoid" in that or any other connection whatever, and has remained out of business since the year 1880, and that if this concern ever did use the word "Rubberoid," it was never used as a trade-mark or
89 trade name in connection with a product that could be said actually to have been on the market, and that the same was never applied to roofing or any analogous substance.

Subscribed and sworn to before me this 2nd day of April, 1906:

Defendant's Objections to Evidence of Felix Jellenik Made and Filed in Accordance with Stipulation under Which said Evidence was Taken.

Defendant objects to question 3, and the answer thereto for the reason that the question calls for, and the answer gives evidence which is not in anyway material to the issues in the case; and (2)

that the best evidence of the alleged assignments are the assignment themselves.

Defendant objects to question 4 and the answer thereto for the reason that the question calls for and the answer gives evidence which is not in any way material to the issues in the case; (2) that the answer gives the contents of a written instrument.

Defendant objects to question 5 and the answer thereto for the reason that the question calls for and the answer gives evidence which is not in any way material to the issues of the case; and (2) that the objections of the Patent Office, if material, should be shown by the records themselves.

Defendants objects to question 6 and the answer thereto for the reason that the question calls for and the answer gives the contents of certain patents and trade-marks; the best evidence would be the letters patent and trade-marks themselves.

90 Defendant objects to question 7 and the answer thereto for the reason that the question calls for and the answer gives the determination of the Patent Office; or the theory on which the Patent Office acted; it is immaterial to any issue in the case.

Defendant objects to questions 8, and the answer thereto because the question calls for and the answer gives simply hearsay testimony, and does not purport to state the witness' own knowledge regarding any matter; and so far as the said answer purports to give copies of said records it is incompetent evidence.

W. B. HOMER,
Attorney for Defendant.

Stipulation.

It is hereby stipulated and agreed between the parties to the above entitled cause that the certificate of the Secretary of State for the State of Connecticut, which is hereto attached, and the assignment of the trade mark, "Rubberoid," which is attached to an affidavit of Felix Jellenik heretofore filed in this cause, and which is marked Exhibit "A" to said affidavit, may be read in evidence at the trial with the same force, and effect as if they had been identified and attached to depositions taken in behalf of complainant.

JUDSON GREEN,
Solicitors for Complainant.
W. B. HOMER,
Solicitor for Defendant.

STATE OF CONNECTICUT,
Office of the Secretary, ss:

I, Theodore Bodenwein, Secretary of the said State of Connecticut, and keeper of the seal thereof, do hereby certify, that the corporate existence of The Rubberoid Company, located in Hartford and organized under the laws of said State, and which filed its

91 certificate of organization May 4, 1878, was annulled to take effect February 16, 1906, for failure to make the annual report required by law and pay the Secretary of the State a forfeiture

of twenty-five dollars on or before the fifteen day of February, 1906, as provided by Chapter 281 of the Public Acts of 1905.

In testimony whereof, I have hereunto set my hand, and affixed the seal of said State, at Hartford, this 26th day of April, 1906.

[SEAL.] THEODORE BODENWEIN, *Secretary.*

Stipulation.

It is hereby stipulated and agreed between the parties to the above entitled cause that the letter hereto attached, marked "Exhibit A" is a true copy of an original letter which was received by the defendant from Messrs. Judson & Green, solicitors for complainant, on the 17th day of February, 1905, and the letters hereto attached marked respectively, Exhibits "B" and "C" are the replies to the said letter which were received by Messrs. Judson & Green on the 19th days of February, 1905, and 6th day of April, 1905, respectively, and all said letters may be considered as offered in evidence in the above entitled cause, and attached as exhibits to complainant's depositions.

ST. LOUIS, Mo., *Feb'y* 17, 1905.

The Trinidad Asphalt Mfg. Co., 320 S. 21st St., City.

GENTLEMEN: The Standard Paint Company of New York has requested us to notify you that in using the name "RubberO" to designate your roofing product you are unlawfully infringing upon their trade-mark name of "Ruberoid," which has long been used
92 by them to designate a roofing product of a similar appearance manufactured by them. The trade mark and trade name of our clients are very valuable because the product manufactured and sold by them under the name "Ruberoid" has become generally and favorably known to the trade, and unless you cease your infringement at once, we shall proceed against you in the courts.

JUDSON & GREEN,
For Standard Paint Co.

ST. LOUIS, Mo., *Feb'y* 18, 1905.

Mess. Judson & Green, Rialto Bldg., City.

GENTLEMEN: Your letter of the 16th to Trinidad Asphalt Mfg. Co. relating to trade-mark Ruberoid has been handed to me. I would like to investigate the matter, and will see you regarding the same in a few days.

Yours truly,
(Signed) W. B. HOMER.

ST. LOUIS, Mo., *April* 5, 1905.

Mess. Judson & Green, Rialto Bldg., City.

GENTLEMEN: In regard to the claim of the Standard Paint Co. v. Trinidad Asphalt Mfg. Co. that the trade-mark "Rubbero" is an infringement of the trade-mark "Ruberoid," I have this to say: My

clients are not willing to abandon the use of "RubberO," but if there is anything about the labels which they use which could possibly interfere in any way with the trade of the Paint Co., they will be very glad to make assurance doubly sure that no customer could be deceived.

Yours truly,
(Signed) W. B. HOMER.

The various exhibits of both complainant and defendant will be shown to the Court at the hearing.

JUDSON & GREEN,
Solicitors for Complainant.
W. B. HOMER,
Solicitor for Defendant.

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94 The Exhibits referred to in said Stipulation are respectively in words and figures following, to-wit:

95 & 96 *Complainant's Certificate of Registration.*

United States Patent Office.

The Standard Paint Co., of New York, N. Y.

Trade-Mark for Certain Named Substances of the Nature of Rubber.

Statement and Declaration of Trade-Mark No. 36,485; Registered May 28, 1901; Application Filed November 22, 1900.

Statement.

To all whom it may concern:

Be it known that The Standard Paint Co., a corporation incorporated under the laws of the State of West Virginia, and located and doing business in the borough of Manhattan, city, county, and State of New York, has adopted for its use a Trade-Mark for a Solid Substance in the Nature of Soft Flexible Rubber, of which the following is a full, clear, and exact description.

The said trade-mark consists in the arbitrary word "Ruberoid." It is shown in the accompanying facsimile as printed in ordinary block capitals; but other forms of type may be employed and various characters and devices used in connection with the said trade-mark without materially altering the character thereof, the essential feature of which consists of the word "RUBEROID."

The said trade-mark was adopted by the said corporation on or about the 1st day of September, 1890, and has been used by it in its business continuously ever since.

The class of merchandise to which this trade-mark is appropriated is solid substances in the nature of soft flexible rubber in the form of flexible roofing, flooring, siding, sheathing, &c., and the particular class of goods upon which the said trade-mark is used is solid substances in the nature of soft flexible rubber.

The said trade-mark is used by being printed upon the goods themselves or labels applied to the said goods or to the packages containing the said goods and used in connection with any means whereby the said goods are advertised to the public.

[L. S.] THE STANDARD PAINT CO.
RALPH L. THANIWALD, *Pres't.*

Witnesses:
E. M. JOHNSON,
ALFRED GEORGI.

Declaration.

STATE OF NEW YORK,
County of New York, ss:

Ralph L. Thaniwald being duly sworn, deposes and says that he is president of The Standard Paint Company applicant named in

TRADE-MARK.

No. 36,485. Registered May 28, 1901.

THE STANDARD PAINT CO.

CERTAIN NAMED SUBSTANCES OF THE NATURE OF RUBBER.

(Application filed Nov. 28, 1900.)

RUBEROID

WITNESSES:

Alfred A. Hutchinson.

F. E. Clemens.

PROPRIETOR.

The Standard Paint Co.

BY Briesen & Knauth

ATTORNEYS

the foregoing statement; that he verily believes that the foregoing statement is true; that said corporation has at this time a right to the use of the trade-mark therein described; and that no other person, firm, or corporation has the right to such use, either in the identical form, or in any such near resemblance thereto, as might be calculated to deceive; and that the description and facsimiles herewith presented for record, truly represent the trade-mark sought to be registered, and that he is a citizen of New York, and that the said trade-mark is used by The Standard Paint Co. in commerce between the United States and foreign nations, and particularly with Germany.

RALPH L. THANIWALD.

Sworn to and subscribed before me this 19th day of November, 1900.

[L. S.] E. M. JOHNSON,
Notary Public, Kings Co.

Certificate filed in New York Co.

Correction in Certificate of Registration of Trade-Mark No. 36,485.

It is hereby certified that in Certificate of Registration of Trade-Mark No. 36,485, registered May 28, 1901, upon the application of The Standard Paint Co., of New York, N. Y., the name of the officer of the corporation signing the statement and making oath to the declaration was erroneously written and printed "Ralph L. Thaniwald," whereas said name should have been printed *Ralph L. Shainwald;* and that the said Certificate should be read with this correction therein that the same may conform to the record of the case in the Patent Office.

Signed and sealed this 11th day of June, A. D., 1901.

[SEAL.] F. I. ALLEN,
Commissioner of Patents.

(Here follows fac-simile marked page 97.)

99 DEFENDANT'S EXHIBIT.

Defendant's Trade Mark.

STATE OF MISSOURI:

Department (Seal) of State.

No. 1701.

To All To Whom These Presents Shall Come:

I, Samuel B. Cook, Secretary of State of the State of Missouri, hereby certify that the annexed document is an exact Counterpart of the Certificate describing the Trade Mark of The Trinidad Asphalt Manufacturing Company, filed this 22nd day of November, 1904, and that said Certificate is duly filed as the law directs in this office.

In testimony whereof, I hereunto set my hand and affixed the Great Seal of the State of Missouri. Done at office in the City of Jefferson, this 22nd day of November, A. D., 1904.

[SEAL.]

SAM B. COOK,
Secretary of State.

Know all men by these presents, that the undersigned, Trinidad Asphalt Manufacturing Company, a corporation duly incorporated under the laws of the State, of Missouri, and engaged as a manufacturer and dealer in Roofing in the City of St. Louis, and other parts of the State of Missouri, desiring to avail itself of the provisions of an Act regarding Trade Marks, known as Chapter 169, of the Revised Statutes of 1899, and the amendments thereto, especially of an Act of the General Assembly of the State of Missouri approved March 24, 1903, relating to Trade Marks, have adopted as their Trade Mark to designate, make known and distinguish as article of Roofing, Goods, Wares and Merchandise by them manufactured and prepared, and by them sold, and by them to be manufactured and sold in future, of which the following is an accurate description.

The Trade Mark consists of the word "RubberO." This word is used in connection with the word Roofing, and may be used in connection with any other words, or any designs, characters, or representations, without materially altering the character of the Trade Mark, the essential features of which is the word "RubberO."

The said Trade Mark is lithographed, written, or otherwise marked upon labels, attached to the packages of roofing, or to the roofing itself, and may be used by way of advertising upon letter heads, cards, advertisements, signs, bill heads, or in any other manner.

100 And they herewith file this application, together with a facsimile of the name, term, design, or device, for registration, in the office of the Secretary of State by leaving two copies, being

counterpart or fac-similes of the said Trade Mark, with the Secretary of State.

In witness whereof the said Trinidad Asphant Manufacturing Company has caused these presents to be signed and acknowledged by its President and its seal to be attached, this 18th day of November, 1904.

TRINIDAD ASPHALT MANUFACTURING COMPANY,
By JAMES B. JOHNSON, *President.*

STATE OF MISSOURI,
City of St. Louis, ss:

On this 19th day of November, 1904, before me appeared James B. Johnson, who being by me duly sworn did say that he is the President of the Trinidad Asphalt Manufacturing Company, and that the seal affixed to the foregoing instrument is the corporate seal of the said corporation, and that said instrument was signed and sealed in behalf of the said corporation by authority of its board of directors, and the said James B. Johnson acknowledged said instrument to be the free act and deed of said corporation.

Witness my hand and official seal on this the day and year last above in this certificate written. My commission expires September 3, 1906.

[SEAL.] M. A. HALDEMAN,
Notary Public.

Defendant's Exhibit Frary File Wrapper and Contents.

To the Commissioner of Patents:

The Undersigned presents herewith a fac-simile of its lawful Trade-Mark and requests that the same together with the accompanying statement and declaration may be registered in the United States Patent Office in accordance with the law in such case made and provided.

THE JAMES D. FRARY & SON CO.,
JAMES D. FRARY, *Pres.*

Be it known that the James D. Frary & Son Co., a Company organized under the Joint Stock Laws of the State of Connecticut and doing business in the City of Bridgeport, County of Fairfield, State of Connecticut, has adopted for its use a Trade-mark for a
101 composition as a substitute for hard rubber, of which the following is a full, clear, and exact specification.

The Trade-mark consists of the word "Rubberoid," [shown in the accompanying fac-simile.]*

[On side in ink:] Insert A, Dec. 7/83.

This Trade-mark has been used since the first of August last, and is now being used by The James D. Frary & Son Company in its

[* Words enclosed in brackets erased in copy.]

business as manufacturers of Cutlery, the material for which the Trade-mark is employed being in the manufacture of handles for cutlery.

The class of merchandise to which this Trade-mark is appropriated is a composition prepared in blocks or veneers, and the particular description of goods comprised in such class in which the Trade-mark is used is a composition as a substitute for hard rubber.

The mark is applied by stamping into the articles, or by placing thereon a label having the word "Rubberoid" thereon, or in case of its application to cutlery handles, or to other articles to which hard rubber or any substitute therefor is adapted, the label containing such articles has upon it the word "Rubberoid."

THE JAMES D. FRARY & SON CO.,
JAMES D. FRARY, *Pres.*

Witnesses:
JOS. C. EARLE,
J. H. SHUMWAY.

STATE OF CONNECTICUT:

James D. Frary, being duly sworn, deposes and says that he is the President of the James D. Frary & Son Company, applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said Company has at this time the right to the use of the Trade-mark therein described; that no other person, firm, or corporation has the right to such use either in duplicate form, or in any such near resemblance thereto as might be calculated to deceive; that it is used by it in commerce with foreign nations or Indian tribes, and particularly with England, France, and Germany; and that the description and fac-simile as presented for record duly represent the Trade-mark sought to be registered.

JAMES D. FRARY.

102 Subscribed and sworn to before me, this 8 day of Nov. A. D. 1883.

JOHN E. EARLE,
C'k of Sup. C'rt.

119

Appl'n 17182
The J. D. Frary & Son Co.

U. S. Patent.
Nov. 26, 1883.
Office.

Room 98.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *November 28th*, 1883.

The James D. Frary & Son Co., c/o John E. Earle, New Haven, Conn.

Please find below a copy of a communication from the Examiner

of Trade-marks regarding your Trade-mark application, filed November 26th, 1883.

Very respectfully,

BENJ. BUTTERWORTH,
Commissioner of Patents.

Case No. 17,182.

No description of the alleged Trade-mark is given in the Statement of this Application; the Law requires the same. The clause "has been adopted" line 10, page 1, should be changed to, "has been used."

No further objection is now known to the case.

F. A. SEELY, *Examiner.*

E. S. C.
4th.
1

119

Nov. 28/83 17182

Letter.

Room 98.

NEW HAVEN, CONN., *Dec. 5th*, 1883. 188

In the Matter of the Application for Trade-Mark by The James D. Frary & Son Co. for Improvement in ——. Filed Nov. 26th.

To the Hon. Commissioner of Patents:

SIR: In reply to office letter of Nov. 28th in above entitled application, *amend* the application *by erasing "shown in the accompanying fac-simile" lines* 8 *and* 9 *of page* 2.

103 Erase & Insert B, Dec. 15/83.

A. Insert immediately following this paragraph as follows: . . . The word which constitutes my invention is composed of the letters R-U-B-B-E-R-O-I-D, as shown in the accompanying illustration."

[Matter enclosed between rules erased in copy.]

Page 2, line 10 erase "adopted" and insert.....used

R-spectfully,

JOHN E. EARLE,
Att'y for The James D. Frary & Son Co.

119

17182

2 Dec. 7/83. Amdt. A.

Patent Office, Dec. 7, 1883. U. S. A.

Room No. 98.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *December 11th*, 1883.

The James D. Frary & Son Co., c/o John E. Earle, New Haven, Conn.:

Please find below a copy of a communication from the Examiner of Trade-Marks regarding your Trade-Mark application, filed Nov. 26th, 1883.

Very respectfully, BENJ. BUTTERWORTH,
Commissioner of Patents.

Case No. 17,182.

The amendment of Dec. 7, does not relieve the application from the first objection, made in former official letter. It is respectfully suggested that the amendment of Dec. 7, be canceled, and a paragraph to the following effect be substituted therefor (unless applicants desire to confine themselves to the exact form shown):

This has generally been arranged in a horizontal line, in large Roman capitals, printed in black on a white ground, as shown in the accompanying facsimile, but the position of the word and the character of the type, as well as the color in which it is printed
104 may be changed at pleasure without altering the character of our trade-mark the essential feature of which is the word Rubberoid.

The case can issue when amended.

F. A. SEELY, *Examiner.*

E. S. C. 4th.
3

119

Dec. 11/83 17182.

Letter.

Room 98.

NEW HAVEN, CONN, *Dec. 13th*, 1883. *188*

In the Matter of the Application *Letters Patent* for Trade-mark by *for Improvement in* The James D. Frary & Son Co. No. 17,182. Filed Nov. 26th.

To the Hon. Commissioner of Patents:

SIR: In reply to office letter of Dec. 11th, in above entitled appli-

TRADE-MARK.

THE JAMES D. FRARY & SON COMPANY.

A COMPOSITION AS A SUBSTITUTE FOR HARD RUBBER.

No. 10,842. Registered Jan. 8, 1884.

RUBBEROID

Witnesses
[illegible]
[illegible]

James D. Frary & Son Co.
Inventors
By Atty.
[illegible]

cation, *cancel the amendment filed Dec. 7th, and insert in lieu thereof as follows:*

B. . . . This has been arranged in a horizontal line in large Roman capitals printed in black on a white ground, as shown in the accompanying fac-simile, but the position of the word and the character of the type as well as the color in which it is printed may be changed at pleasure without altering the character of our trade-mark, the essential feature of which is the word "Rubberoid."

Respectfully,

JOHN E. EARL,
Att'y for The James D. Frary & Son Co.

4

119

17182

Dec. 15/83. Amdt. B.

Patent Office, Dec. 15, 1883. U. S. A.

2–186.

Issue Division.

All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Dec.* 20, 1883.

The James D. Frary & Son Co., c/o J. E. Earle, New Haven, Conn.

SIR: Your application for registration of trade-mark
105 & 106 for a composition as a substitute for hard-rubber has been examined and allowed.

The Certificate of Registration will be issue- and forwarded to you as soon as practicable, in due order of business.

Very respectfully,

F. I. ALLEN,
Commissioner of Patents.

(Here follows fac-simile marked page 107.)

108 United States Patent Office.

The James D. Frary & Son Co., of Bridgeport, Connecticut.

Trade-Mark for a Composition as a Substitute for Hard Rubber.

Statement and Declaration of Trade-Mark No. 10,842, Registered January 8, 1884.

Application Filed November 26, 1883.

Statement.

To all whom it may concern:

Be it known that The James D. Frary & Son Co., a company organized under the joint-stock laws of the State of Connecticut, and doing business in the city of Bridgeport, county of Fairfield, State of Connecticut, has adopted for its use a Trade-Mark for a Composition as a Substitute for Hard Rubber, of which the following is a full, clear, and exact specification.

The trade-mark consists of the word "Rubberoid." This has been arranged in a horizontal line in large Roman capitals printed, in black, on a white ground, as shown in the accompanying fac-simile; but the position of the word and the character of the type, as well as the color in which it is printed, may be changed at pleasure without altering the character of our trade-mark, the essential feature of which is the word "RUBBEROID."

This trade-mark has been used since the 1st of August last, and is now being used, by The James D. Frary & Son Company in its business as manufacturers of cutlery, the material for which the trade-mark is employed being in the manufacture of handles for cutlery.

The class of merchandise to which this trade-mark is appropriated is a composition prepared in blocks or veneers, and the particular description of goods comprised in such class in which the trade-mark is used is a composition as a substitute for hard rubber.

The mark is applied by stamping into the articles, or by placing thereon a label having the word "Rubberoid" thereon; or in case of its application to cutlery-handles or to other articles to which hard rubber or any substitute therefor is adapted, the label containing such articles has upon it the word "Rubberoid."

THE JAMES D. FRARY & SON CO.
JAMES D. FRARY, *President.*

Witnesses:

JOS. C. EARLE.
J. H. SHUMWAY.

Declaration.

STATE OF CONNECTICUT:

James D. Frary, being duly sworn, deposes and says that he is the president of The James D. Frary & Son Company, applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said company has at this time the right to the use of the trade-mark therein described; that no other person, firm, or corporation has the right to such use, either in duplicate form or in any such near resemblance thereto as might be calculated to deceive; that it is used by it in commerce with foreign nations or Indian tribes, and particularly with England, France, and Germany, and that the description and fac-simile as presented for record duly represent the trade-mark sought to be registered.

JAMES D. FRARY.

Subscribed and sworn to before me this 8th day of Nov., A. D. 1883.

JOHN E. EARLE,
C'k of Sup. C'rt.

109 Ex'r's Book No. 17,182.
Seely.

1883.
Trade-mark.
Act of March 3, 1881.

No. 10,842.
The James D. Frary & Son Co.,
Of Bridgeport,
County of Fairfield,
State of Connecticut.
Composition as a Substitute for Hard Rubber.

Parts of application filed.
- Petition, Nov. 26, 1883.
- Declaration, Nov. 26, 1883.
- Statement, Nov. 26, 1883.
- Fac-simile, Nov. 26, 1883.
- Copies, office.
- Fee cert.
- Fee, cash, $25, Nov. 26, 1883.
- Fee reg'd prior to act March 3, 1881, cert.
- No. —, dated —— —, 18—.

Examined Dec. 18, /83, F. A. Seely.
Countersigned: J. W. Babson, for Commissioner.
Dec. 19, '83.
Notice of allowance Dec. 20, 1883.
Registered Jan'y 8, 1884.
Att'y or P. O. address: John E. Earle, New Haven, Conn.

1883.

Trade-mark.
Rubber Goods.

Contents.

Application, — papers.
1. November 28, 1883, letter.
1. Dec. 7/83, am'd't A.
3. Dec. 11, " letter.
4. Dec. 15/83, am'd't B.
5.
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110

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Title: Trade-Mark for a Composition as a Substitute for Hard Rubber.

F. H.
A. S. M.

5174: Papers for Transcript, Standard Paint Co. vs. Trinidad Asphalt Manufacturing Co.
U. S. Patent Office, Copy made Apr. 27, 1907.

* * * * * * *

(Here follows "Defendant's Exhibit Frary Trade Mark", the same being a certified copy of Trade Mark No. 10,842, to The James D. Frary & Son Company, dated Jan. 8, 1884, which is omitted because a copy of said trade mark appears at page 107 of this printed record.)

TRADE-MARK.

THE RUBBEROID CO.

Gum Resembling India-Rubber.

No. 6,341. Registered July 9, 1878

RUBBEROID.

WITNESSES.

Geo. H. Earl.

Chas. J. Bell

INVENTOR.

The Rubberoid Co.

Pa. Brown Bros.

Attorneys.

111 DEFENDANT'S EXHIBIT TRADE MARK RUBBEROID COMPANY.

United States Patent Office.

The Rubberoid Company, of Bristol and Philadelphia, Pa.

Trade-Mark for a Gum Resembling India-Rubber.

Statement of Trade-Mark No. 6,341, Registered July 9, 1878; Application Filed June 10, 1878.

To all whom it may concern:

Be it known that The Rubberoid Company, domiciled in the United States, and duly organized under the laws of the State of Connecticut, and doing business in Bristol, in the county of Bucks, and Philadelphia, in the county of Philadelphia, both in the State of Pennsylvania, has adapted for its use a Trade-Mark for a Gum somewhat resembling India-Rubber, of which the following specification is a full, clear, and exact description.

This trade-mark consists of the fanciful word "RUBBEROID," formed by the addition of the suffix "oid" to the word "Rubber." It has just been adopted by said company for use as a trade-mark for a gum resembling india-rubber, produced by the process described in Letters Patent of the United States issued to Henry A. Clark, of Boston, in the State of Massachusetts, for treating linseed-oil, &c., dated November 14, 1876, and April 2, 1878, and numbered 184,341 and 201,992, respectively, said process consisting briefly of treating linseed or other vegetable oil with sulphur under heat, and then subjecting the compound first to benzine to extract the grease therefrom, and then to benzole to reduce it to a desired consistency.

This trade-mark is to be used by stamping, painting, printing, or stenciling it on each box, case, or package containing said gum, or upon labels to be attached to or pasted upon said boxes, cases, or packages, or printed, &c., upon circulars, bill-heads, &c.

THE RUBBEROID COMPANY,
By CHARLEMAGNE TOWER, *President.*

Witnesses:

E. B. GUMPERT.
ALFRED L. CAREY.

(Here follows fac-simile marked page 112.)

113 DEFENDANT'S EXHIBIT CLARK LETTERS PATENT No. 1.

LETTERS PATENT No. 184,341.

United States Patent Office.

Henry A. Clark, of Boston, Massachusetts.

Improvement in Treatment of Linseed-Oil.

Specification Forming Part of Letters Patent No. 184,341, Dated November 14, 1876; Application Filed October 28, 1876.

To all whom it may concern:

Be it known that I, Henry A. Clark, of Boston, in the county of Suffolk and State of Massachusetts, have invented a certain new and useful Improved Treatment of Linseed-Oil, &c., with Sulphur, of which the following is a specification:

This invention relates to the treatment of vegetable oils, more particularly linseed-oil, with sulphur, for the purpose of rendering the oil more suitable for use as a coating for cloths, which will be water-proof, flexible, and elastic, and unaffected by either heat or cold.

To this end the invention consists in subjecting the oil, either in its raw state or in a partially-cooked state, (preferably in its raw state,) to the action of sulphur heated to such a degree as to be vaporized or generated into a gas.

In carrying out my invention, I take one hundred (100) parts, by weight, of the vegetable oil which is to be treated—as, for instance, linseed-oil—and from five (5) to ten (10) parts, by weight, of sulphur, and place the two together in a kettle or other suitable vessel, and then subject the whole to a heat of five hundred and sixty degrees (560°) Fahrenheit, for from five (5) to six (6) hours, or until the oil has become reduced or changed to the consistency and character hereinafter described.

Subjecting oil and sulphur to heat, as above stated, not only cooks the oil as it would be cooked were it only simply boiled, as ordinarily, of itself, but, as the sulphur is raised to the degree of heat stated, and continued at such heat, it is vaporized or generated into a gas, which chemically unites with the component parts of the oil, and thus acts thereon, so as to wholly change and substantially to remove the oily, greasy, and rank nature or character of the oil, and otherwise to reduce it to a gummy and an elastic condition, which greatly resembles india-rubber, and this product, like india-rubber, is flexible and elastic, and so, as a coating to cloth, is water-proof, and practically unaccompanied in appearance, odor, or nature, with any of the rank, or oily, or greasy characteristics which belong to the oil, either when in its natural state, or when cooked by boiling, as heretofore.

In treating the oil with sulphur, as above described, the oil, as it is so cooked, thickens, becomes stringy and elastic, and, finally, if

cooked a sufficient length of time, so thickens that it cannot be stirred, strung, dipped, or poured, and at no time in such a cooking of the oil does the oil, or said product thereof, burn or char, as oil or its product, if cooked without sulphur to the extent described, would do, even with most careful watching; but the oil or said product thereof, from the presence of the sulphur, because of said chemical union of it with the oil, seems to be, and is, most perfectly protected against burning or charring.

In using my improved product from linseed-oil, &c., by treating it with sulphur, as described, to coat cloths, I prefer to add lamp-black, to give it a greater body and consistency for filling the interstices of the cloth, or to add other materials which will secure the same results—as, for instance, chalk, whiting, or pigments of any kind; and obviously the material to be so used will depend upon the color which it is desired the coating should have.

It is preferable before applying my said improved product to cloth, to reduce it with benzine or other solvents, benzine being preferable, because it evaporates most quickly, as it makes it easier and better to apply, and it may be applied in various ways—as, for instance, with a scraper or a brush, or with rolls substantially as practiced in the manufacture of india-rubber coated goods.

After coating the goods, as described, they are to be dried, and a simple exposure of the coating to the sun's rays is sufficient, although it may be dried with artificial heat in a room or chamber; but whether the coating be dried by the sun's rays or by artificial heat, it does not seem to be changed in any substantial or perceptible degree as to its characteristics hereinbefore described. If dried with the sun's rays the glossy look of the coating seems to be deadened or removed, whereas if dried by artificial heat the glossy look is heightened, and for this reason it is preferred to dry the coating by exposure to the sun's rays.

If desired, my improved product may be washed with an alkali,
such as sal-soda, either before or after mixing benzine with it,
114 and if so, it is brought to a still closer resemblance to india
rubber in its appearance and feeling, thus showing to a still greater degree the changes herein specified, which are brought about in the nature and character of the oil from its treatment with sulphur, as herein described.

The addition of the alkali also serves to impart a softer and more velvety feeling to the product, and to obliterate all traces, however slight, of an oily or greasy nature which may be left in the product.

This invention may be applied to vegetable oils other than linseed. The proportions of oil and sulphur may be varied from those given, as also the degree of heat and the time of cooking; but in all cases the sulphur must be vaporized, or otherwise there will be no chemical union of it with the component parts of the oil, and consequently such change in the oil as has been described.

The proportions of linseed-oil and sulphur, and the degree of heat and time of cooking herein specified, produce most satisfactory results.

Litharge, if added to the oil before it is treated with sulphur, as

described, increases the drying qualities; but, in lieu of litharge, other drying material may be used. Litharge, however, is not necessary, nor has it in any appreciable degree any connection or relation to the effect herein described of the sulphur on the oil.

In lieu of subjecting the oil to the vapors of sulphur, by placing the oil and sulphur together, in a kettle, as described, obviously it may be so subjected in other ways—as, for instance, by placing the oil and sulphur in separate vessels, and passing the vapors of the sulphur through and into the oil; but the method described is convenient and practicable, and unaccompanied with any complicated and extensive apparatus.

I am aware that heretofore sulphur and boiled linseed-oil have been mixed or combined. This invention is not in mixing sulphur and linseed-oil, whether boiled or raw, but in the manner of mixing through a vaporization of the sulphur, or the generation of it into a gas, whereby it is made to chemically unite and combine with the oil, with the results stated, and I am not aware that such results were ever before secured.

Having thus described my invention, what I claim, and desire to secure by Letters Patent, is—

The process herein described of sulphurizing vegetable oils, which consists in heating the oil in contact with sulphur to that degree at which the sulphur is vaporized, in which condition the sulphur reacts upon the oil to vulcanize it, substantially as described.

HENRY A. CLARK.

Witnesses:

GEO. H. EARL.
EDWIN W. BROWN.

115 DEFENDANT'S EXHIBIT CLARK LETTERS PATENT NUMBERED 2, LETTERS PATENT No. 201,992.

United States Patent Office.

Henry A. Clark, of Boston, Massachusetts.

Improvement in Treating Linseed-Oil.

Specification Forming Part of Letters Patent No. 201,992, Dated April 2, 1878; Application Filed January 14, 1878.

To all whom it may concern:

Be it known that I, Henry A. Clark, of Boston, county of Suffolk, State of Massachusetts, have invented a certain new and useful Improvement in Treatment of Linseed-Oil with Sulphur; and that the following is a full, clear, and exact description of the same.

This invention relates to an improved process of treating vegetable oils, particularly linseed-oil, which have, by previous treatment with sulphur, been brought to a gummy condition, and have a resemblance to india-rubber, and to be used as a coating for cloths, which coating shall be water-proof, flexible, elastic, and unsusceptible to either heat or cold.

Gum more or less resembling india-rubber has been reduced from such oils in various ways—as, for instance, with sulphur and heat, as described in the Letters Patent of the United States issued to me, dated October 28, 1876, No. 184,341—and in such gum reduced from vegetable oils more or less of their oily and greasy nature was removed or obliterated; but, so far as I am aware, and as experience under said Letters Patent shows, this removal or obliteration of the oily and greasy nature of the oils has never been secured to the extent desired and necessary to render the product practical for the use intended for it.

Therefore, the principal object of this invention is to practically and substantially remove and obliterate all traces of the oily and greasy character left in the oil after it has been reduced to a gum, as aforesaid, and, again, to then reduce the production thus obtained to a suitable consistency to be applied to cloth, and make a water-proof, elastic, and flexible coating thereto.

For these purposes the invention consists in treating vegetable oils, such as linseed-oil which has been reduced to a gum, as aforesaid, with benzine, otherwise known as "petroleum-naphtha," and then, after having allowed it to stand, removing the same, and adding benzole, also known as "coal-tar naphtha," or turpentine or camphene—benzole being preferable—all substantially as hereinafter described.

In carrying out this invention, I take six (6) gallons of the gummy product from linseed-oil, &c., produced by treating it with sulphur and heat, as described in my aforesaid patent, or otherwise, and to it I add one to six gallons, or thereabout, of benzine or petro-

leum naphtha—the greater the quantity of benzine or petroleum naphtha the quicker the work hereinafter described is accomplished—and, having thoroughly mixed the two together, I allow the mixture to stand some time—that is, at least two days—preferably applying a gentle heat to it while it so stands, and then, having poured off the benzine or petroleum naphtha, I add from two to five per cent., or thereabout, of benzole or coal-tar naphtha, and, having thoroughly mixed the two, the product produced is ready for use.

The benzine or petroleum naphtha at first assimilates with the gum; but after standing for a time—say, from two to ten days, according to the degree of heat to which it (the gum) is subjected—it separates the grease or oil left in the gummy product therefrom, which, with the benzine or petroleum naphtha, gathers upon the top, and when the benzine or petroleum naphtha is poured off, as described, the grease is poured off with it.

The benzole or coal-tar naphtha cuts the gummy product previously treated with the benzine or petroleum naphtha, and reduces its consistency, so that it is capable of being applied to cloth to coat the same.

The use of benzine or petroleum naphtha may be repeated as often as may be necessary; and, again, benzole or coal-tar naphtha is preferable to either turpentine or camphene, for the reason that the latter (more especially turpentine) is somewhat greasy or oily in its nature.

The benzine or petroleum naphtha and grease which are poured off, as aforesaid, I separate from each other by distillation, and thus both are economized, the benzine or petroleum naphtha to use again, as aforesaid, and the grease to use as a lubricator.

116 Having thus described my invention, what I claim, and desire to secure by Letters Patent, is—

The process of treating vegetable oils which have, by previous treatment with sulphur, been brought to a gummy condition, said process consisting, first, in mixing benzine or petroleum naphtha with said gummy oils, allowing the mixture to settle, and then pouring off the benzine; second, mixing with the residuum benzole or coal-tar naphtha in sufficient quantity to bring the same to a consistence for application, as desired, and as hereinbeore set forth.

HENRY A. CLARK.

Witnesses:

GEO. H. EARL.
EDWIN W. BROWN.

(Here follows fac-simile marked page 117.)

BULL DOG BRAND
RUBBERO ROOFING 2 PLY

THE BEST RUBBER ROOFING

ANY ONE CAN LAY IT QUICKLY

MANUFACTURED ONLY BY

TRINIDAD ASPHALT MFG. CO.

ST. LOUIS, MO., U. S. A.

DIRECTIONS FOR LAYING.

HOW TO PREPARE FOR LAYING.—When the roofing material is pliable, as in warm weather, it is ready for immediate use. In cold weather place roofing in a warm room (not hot) until it becomes pliable.

FIRST.—Roof boards or sheathing should be dry as possible and laid close together; sweep boards cleanly of all nails, etc., see that no nail-heads are sticking up.

SECOND.—First piece of roofing is laid parallel with guttering. Lap the lower edge over the roof boards and nail every two inches; then nail strip of wood one inch wide over the roofing on the edge of the roof boards. Strip should be painted with cement or paint. Treat the ends of the roof in the same manner. Be sure to get all wrinkles out of roofing by stretching before nailing.

THIRD.—Lap the second and succeeding pieces of roofing over the first piece at least two inches, cementing between with cement, nail through both using metal roofing strip. Cover nails and strip with cement. While the cement is liquid, embed in it coarse sand, pressing it in with foot pressure, which will protect the nails and strip, and cement together the roofing where it is lapped.

FOURTH.—End laps must be lapped four inches. The first piece of roofing to be covered with the cement and the second piece to be laid over same and press together; then nail through both using metal roofing strips every two inches, then cement over the nails and strips with cement, and embed in it coarse sand for protection of the nails and strips and press together with foot pressure. Cut roofing so that the end laps will not come one above the other. Be careful that nails have firm footing and are not driven in cracks.

FIFTH.—Openings, flashings, skylights and walls require care in close fitting and cutting. Turn the roofing four inches against the wall or skylight, and nail strip of wood one inch wide over the roofing into the wall or skylight, cover wood strip with cement, as well as the wall just above roofing. While the cement is liquid on the wood strip or wall, cover with coarse sand. Best results are obtained by having tin or copper flashings made in skylight or wall.

REPAIRS.—Any damage to roofing, caused by storms or otherwise, can be repaired at small expense by patching with our roofing, or, if the rent is not too great, by covering same with cement, and while liquid cover with coarse sand. Save all pieces of roofing and cement for repairs.

118 DEFENDANT'S EXHIBIT JELLENIK'S AFFIDAVIT.

In the Circuit Court of the United States for the Eastern Division of the Eastern Judicial District of Missouri. In Equity.

STANDARD PAINT CO., a Corporation, Complainant,
vs.
TRINIDAD ASPHALT MANUFACTURING CO., a Corporation, Defendant.

STATE OF NEW YORK,
County of ——, ss:

Felix Jellenik being duly sworn on his oath states that he is the Secretary of the Standard Paint Company, and that he has read the return to the order to show cause in the above entitled case filed by the defendant, the Trinidad Asphalt Mfg. Company. Affiant further says that it is not true that the word "Ruberoid" spelled "Ruberoid" or any similar word was in use or had ever been used anywhere by any person or corporation as a name for any kind of roofing material, prior to the use thereof by this complainant. But affiant says that the word "Rubberoid" was used by a firm in Connecticut for some years prior to its use by complainant, but was applied only to actual India rubber or products of India Rubber used in manufacturing handles for pocket knives and for other similar purposes, and said word "Rubberoid" was never used by any other firm or applied to any other products prior to its adoption by complainant as a trade name for its roofing—Affiant further says that said Connecticut firm made an assignment for the benefit of its creditors and went out of business and never resumed business thereafter, and that the complainant on or about the 20th day of April, 1901, purchased from the assignee of said firm all of its right title and interest in or to the word "rubberoid" as a trade name or trade mark for any product whatever, a copy of said contract of purchase being hereto attached marked Exhibit A. And further affiant says not.

FELIX JELLENIK.

Sworn to and subscribed before me this — day of June 1905.

—— ——.

DEFENDANT'S EXHIBIT COMPLAINANT'S ADVERTISEMENT NO. 2, "RUBEROID."

"When Ruberoid was first placed on the market in 1892 it attracted considerable attention, because it was the first, and it is now the only prepared roofing made, that could be used with equal efficiency on very light, temporary structures, or a large brick, stone or iron building."

119 COMPLAINANT'S EXHIBIT ADVERTISING MATTER No. 4.

"Analysis of Ruberoid Roofing.

"Ruberoid Roofing is made of the finest quality of selected wool felt obtainable. This individual feature of the roofing, however is the material with which every fiber of this wool is thoroughly saturated. I refer to Ruberoid Compound or "Gum," which is manufactured solely and exclusively by the Standard Paint Company, and which is not and cannot be used in any other prepared roofing. It is this fact which places Ruberoid Roofing in a class by itself, for none of the saturations commonly used equal it in efficiency and permanency. We venture to figuratively dissect a piece of the Ruberoid Roofing that we may make clear its peculiar characteristics. We will look at it with a section of Ruberoid Compound.

"In appearance this "gum" with which, in a liquid state the roofing is saturated, resembles rubber in its crude state. In fact it was this close resemblance to rubber which suggested the name "Ruberoid," now so universally and favorably known. Holding a piece of this Ruberoid Compound between the fingers one finds that it has all the elasticity of rubber as well as all its toughness. There the similarity ceases, however, for there is absolutely no rubber composition in Ruberoid, and it partakes of none of the corrosive or oxydizing nature of the former material."

During the September Term 1906 of said Court the following proceedings were had and appear of record in said cause to-wit:

FEBRUARY 19TH, 1907.

5174.

STANDARD PAINT COMPANY, a Corporation, Complainant,
vs.
TRINIDAD ASPHALT MANUFACTURING COMPANY, a Corporation, Defendant.

Now this day this cause having come on to be heard upon petition of complainants, the answer of Defendant, the replication thereto and the proofs adduced by Complainant and defendant respectively, and having been argued by counsel for the respective parties, and the Court having taken the same under advisement and duly considered the same, doth find the issues herein joined in favor of complainant.

And thereupon, the Court doth order, adjudge and decree that the defendant, its officers, agents, servants and employees, and each of them be and they are hereby perpetually enjoined from using the word "RubberO" or any similar word as a name for any
120 roofing product, and from advertising selling or causing to be advertised or sold any roofing product under the name of "RubberO" roofing, or under any similar name, and that this cause be referred to Byron F. Babbitt, Master in Chancery, to take and state an account of the damages suffered by Complainant by reason of defendant's said infringement of its rights, and of the profits and gains

made by defendant by means of said unlawful infringement, and to report the same to this Court and that all other matters be reserved until the report of said Master shall be made herein.

G. A. FINKELNBURG, *Judge.*

February 20th, 1907.

5174.

STANDARD PAINT CO., Complainant,
vs.
TRINIDAD ASPHALT MANUFACTURING CO., Defendant.

Now comes said defendant by its solicitor and files its petition for a [rehearing] in this cause.

(*Order Overruling Motion for Rehearing.*)

MARCH 1ST, 1907.

5174.

STANDARD PAINT COMPANY, Complainant,
vs.
TRINIDAD ASPHALT MANUFACTURING COMPANY, Defendant.

The Court having fully considered the motion of said defendant for a rehearing of this cause, doth Order that said motion be and the same is hereby denied.

G. A. FINKELNBURG, *Judge.*

March 1st, 1907.

Afterwards, during the March Term 1907 of said Court the following further proceedings were had and appear of record in said cause, to-wit:

(*Order Granting Appeal.*)

MARCH 18TH, 1907.

5174.

STANDARD PAINT COMPANY, Complainant,
vs.
TRINIDAD ASPHALT MANUFACTURING COMPANY, Defendant.

Now at this day comes said defendant by its solicitor and files and presents to the Court its Assignment of Errors and Petition for an Appeal from the interlocutory decree heretofore rendered herein to the United States Circuit Court of Appeals for the Eighth
121 Circuit, and for an order staying all proceedings under said decree until the determination of said appeal; upon due consideration whereof, the Court doth order that upon the said defendant giving a supersedeas bond in the penal sum of Five Thousand Dol-

lars said appeal be granted as prayed; thereupon said defendant presents such a bond conditioned as required by law, which is approved by the Court, and it is ordered that a supersedeas of said decree be and the same is hereby granted pending said appeal, and a citation citing and admonishing said complainant to be and appear at and before said Court of Appeals, within sixty days from this date is signed by the Judge.

G. A. FINKELNBURG, *Judge.*

Which said Assignment of Errors, Petition for Appeal and Bond are respectively in words and figures as follows, to-wit:

Assignment of Errors.

In the Circuit Court of the United States for the Eastern Division of the Eastern Judicial District of Missouri. In Equity.

No. 5174.

STANDARD PAINT COMPANY, Complainant,
vs.
TRINIDAD ASPHALT MANUFACTURING COMPANY, Defendant.

Assignment of Errors.

Now comes defendant in the above entitled cause by its solicitor in connection with the application for an appeal in the above entitled cause and makes the following assignment of errors, which it avers occurred upon the trial and during the pendency of this cause in said Court and are shown by the record of proceedings in said cause, and in the rendering of the interlocutory judgment entered in said cause.

1. The Court erred in finding that complainant manufactured and put a roofing material on the market in the year 1891 under the trade mark "Ruberoid Roofing" and that this product has been manufactured and sold by the complainant continuously under that name ever since that time.

2. The Court erred in finding that *while* the word "Rubberoid" spelled with two b's had been temporarily used by other parties prior to 1891 for certain compositions but had never been used in connection with or applied to roofing material."

3. The Court erred in finding that the word "Ruberoid" when applied to and used to designate the roofing product manufactured by complainant is a valid trade mark and that registration
122 thereof was duly and lawfully awarded by the Commissioner of Patents under the act of March 8, 1881.

4. The Court erred in finding that the words "Ruberoid" and "RubberO" when applied to packages of roofing material are sufficiently alike to deceive the unwary or ordinary purchaser.

5. The Court erred in finding that the complainant had used the word "Ruberoid" for a period of thirteen years.

6. The Court erred in finding that the defendant in adopting the name "RubberO" infringed on complainant's rights.

7. The Court erred in finding that the two names "Ruberoid" and "RubberO" are so similar as to confuse or deceive the public.

8. The Court erred in granting the injunction in favor of the complainant and against the defendant.

9. The Court erred in referring the case to a Master in Chancery to take and state an accounting of the damages suffered by complainant on account of the profits and gains made by defendant.

10. The court erred in rendering any decree in favor of the complainant.

11. The Court erred in failing to render judgment for the defendant and dismissing complainant's bill.

12. The Court erred in failing to find that at the time when the alleged trade mark "Ruberoid" was first used by complainant in 1892 the said word had become and was in common use and that the same was printed in the dictionaries of that date and that it was not a word subject to use as a trade mark.

13. The Court erred in failing to find that the said alleged trade mark "Ruberoid" had been used for many years prior to its adoption by complainant by the "Rubberoid" Company a Pennsylvania corporation, the said word having been spelled with two b's and having been filed as a trade mark in the Patent Office on the 9th of July, 1878, and that it had been used by James D. Frary & Son Company and had been by them filed in the Patent Office on the 8th day of January, 1884.

14. The Court erred in finding that said word "Ruberoid" was entitled to be appropriated by any one as a trade mark at the time it was adopted by complainant, for the reason that the same was simply a descriptive word, such as could not be used as a trade-mark,
123 and that the same as used upon complainant's goods was simply descriptive of the character and characteristics of the goods.

15. The Court erred in finding that the word "Ruberoid" spelled "Rubberoid" had not been used prior to the time it was used and adopted by complainant on fabrics such as complainant used for the manufacture of its roofing.

16. The Court erred in finding that the use of the word "Rubberoid" by other parties than complainant had been temporary whereas the fact is that there was no legal evidence that the parties who had commenced the use of it long prior to complainant's adoption of it upon manufactured products in the State of Pennsylvania, had ever ceased the use of the same, and no legal evidence that it was not being used at the time complainant adopted its trade mark.

17. The Court erred in not finding that the said word "Ruberoid" or "Rubberoid" was a word which had been used by other parties in various places and at different times long before its adoption by complainant, to describe a material which resembled India rubber, but which was not in fact India rubber.

18. The Court erred in finding that a dealer in roofing was misled by defendant's trade mark, as the evidence conclusively shows that

no person, dealer or otherwise, ever purchased a square of defendant's roofing believing that he was purchasing the roofing of complainant.

Wherefore defendant prays that an appeal be granted it to the United States Circuit Court of Appeals, Eighth Circuit and that the judgment of the Circuit Court of the United States for the Eastern Division of the Eastern District of Missouri be set aside and held for naught on account of the errors hereinbefore referred to, and other errors of the said Court, and that a judgment in said Court of Appeals be entered dismissing complainant's bill, or that the Court grant a new trial, or direct such further proceedings as the Court may determine upon consideration of the record to be proper in the premises.

W. B. HOMER,
Solicitor for Defendants.

Petition for Appeal.

In the Circuit Court of the United States for the Eastern Division of the Eastern Judicial District of Missouri. In Equity.

No. 5174.

STANDARD PAINT COMPANY, Complainant,
vs.
TRINIDAD ASPHALT MANUFACTURING COMPANY, Defendant.

Now comes Trinidad Asphalt Manufacturing Company, defendant, and prays an appeal from the interlocutory decree entered in
124 said cause Feb'y 19, 1907, to the Circuit Court of Appeals of the United States for the Eighth Circuit, and that the court grant a supersedeas and stay all proceedings pending said appeal.

TRINIDAD ASPHALT MANUFACTURING COMPANY,
By W. B. HOMER, *Solicitor.*

Bond.

Know all men by these presents, That we, Trinidad Manufacturing Company, as principal and James Brooks Johnson, August Heman, John C. Herman, Frank W. Terpening and E. M. Pirner as sureties are held and firmly bound unto Standard Paint Company in the full and just sum of five thousand dollars, to be paid to the said Standard Paint Company, its successors, or assigns, to which payment well and truly to be made, we bind ourselves, our heirs, executors and administrators jointly and severally by these presents. Sealed with our seals, and dated this — day of March in the year of our Lord one thousand nine hundred and seven.

Whereas, lately at the September Term 1906 *term* of the Circuit Court of the United States for the Eastern Division of the Eastern Judicial District of Missouri, in a suit depending in said court between said Standard Paint Company, as complainant, plaintiff, and

said Trinidad Asphalt Manufacturing Company, as defendant, an interlocutory decree was rendered against the said defendant and the said defendant has obtained an appeal of the said court to reverse the aforesaid decree in the aforesaid suit, and a citation directed to the said complainant, citing and admonishing it to be and appear in the United States Circuit Court of Appeals, for the Eighth Circuit, at the City of St. Louis, Missouri, sixty days from and after the date of said citation.

Now the condition of the above obligation is such that if the said defendant shall prosecute said appeal to effect, and answer all damages and costs if it fail to make good its plea, then the above obligation to be void, else to remain in full force and virtue.

Sealed and delivered in presence of

TRINIDAD ASPHALT MANUFACTURING COMPANY,
By J. B. JOHNSON, *President.* [SEAL.]
J. B. JOHNSON. [SEAL.]
AUGUST HEMAN. [SEAL.]
JOHN C. HEMAN. [SEAL.]
F. W. TERPENING. [SEAL.]
E. M. PIRNER. [SEAL.]

Attest:
—— ——, *Secretary.*

125 [SEAL.] F. W. TERPENING.

Approved by
G. A. FINKELNBURG, *Judge.*

O. K.,
JUDSON & GREEN.

On May 13th, 1907, a stipulation regarding use of Exhibits in U. S. Circuit Court of Appeals was filed in said cause, which is in words and figures as follows, to-wit:

(*Stipulation.*)

In the Circuit Court of the United States in and for the Eastern Division of the Eastern Judicial District of Missouri.

STANDARD PAINT COMPANY, Complainant,
v.
TRINIDAD ASPHALT MANUFACTURING COMPANY, Defendant.

It is hereby stipulated and agreed by and between complainant and defendant in the above entitled cause that the following exhibits, forming part of the evidence taken in the said cause, shall be placed in the custody of the marshal of the United States Circuit Court of Appeals for the Eighth Circuit, and may be used by the complain-

ant or defendant in such manner as either shall see fit, or the court shall order, on the hearing of said cause in said Appellate Court, to-wit:

Complainant's Exhibit Advertising Matter No. 1 to No. 19 inclusive.

Complainant's Exhibit Mailing Sample of Ruberoid Roofing and Complainant's Exhibit Architects' Sample of Ruberoid Roofing.

Complainant's Exhibit Defendant's Circular.

Complainant's Exhibit Defendant's Sample.

Defendant's Exhibit Complainant's Advertisement No. 2.

Defendant's Exhibit Defendant's Label and Roll.

Defendant's Exhibit Complainant's Roll and Wrapper.

Defendant's Exhibit Como Rubber Roofing Label and Roll.

Defendant's Exhibit Paroid Roofing.

Defendant's Exhibit Induroid Roofing.

Defendant's Exhibit Perfection Rubber Roofing.

Defendant's Exhibit Galvanized Rubber Roofing.

Defendant's Exhibit Flintkote Roofing.

126 Defendant's Exhibit Original Rubber Roofing.

Defendant's Exhibit Lasticite Rubber Roofing.

JUDSON & GREEN,
Solicitor for Complainant.
W. B. HOMER,
Solicitor for Defendant.

Memorandum of Opinion.

In the Circuit Court of the United States for the Eastern Division of the Eastern Judicial District of Missouri. In Equity.

No. 5174.

STANDARD PAINT COMPANY
vs.
TRINIDAD ASPHALT MFG. CO.

FINKELNBURG, *District Judge:*

Time will not permit me to write an opinion in full in this case, but I will briefly state some of the reasons which have led me to my final conclusions.

I find from the record that the complainant company manufactured and put a roofing material on the market in the year 1891 under the trade name "Ruberoid Roofing," and that this product has been manufactured and sold by the complainant company continuously under that name ever since that time, and that its sales have increased largely from year to year.

I further find that complainant company spent large sums of money in advertising its product under the name of "Ruberoid Roofing" and that it is generally known to the trade and the public under that name, and is sold under that name by complainant in every state of the Union as well as in foreign countries.

I further find that while the word "Rubberoid" (spelt with two b's) had been temporarily used by other parties prior to 1891 for certain compositions, it had never been used in connection with or applied to roofing material.

I further find that in May, 1901, complainant caused its said trade name of "Ruberoid" to be registered as a trade name for its roofing in the Patent Office at Washington. In the application for registration complainant states that: "The said trade mark consists in the arbitrary word 'Ruberoid.' *Is* is shown in the accompanying fac-simile as printed in ordinary block capitals; but other forms of type may be employed and various characters and devices
127 used in connection with the said trade mark without materially altering the character thereof, the essential feature which consists of the word 'Ruberoid.'" The certificate issued by the Commissioner of Patents recites that applicant has complied with the Act of Congress of March 8th, 1881; that the said trade mark has been duly registered May 20th, 1901, and that "protection therefor will remain in force for thirty years from said date unless sooner terminated in accordance with section 5 of said act."

I further find that in the year 1904 defendant began to advertise and sell roofing under the name of "RubberO". It appears that when defendant began using this name it was familiar with complainant's product and aware that complainant's product was extensively advertised and sold under the name of "Ruberoid", and also knew, or ought to have known, that complainant had registered the word "Ruberoid" as its trade-mark in the Patent Office at Washington.

The Court further finds that defendant's product is manufactured by a firm called Watson & Company at Erie, Penn., and shipped by them to defendant at St. Louis, Mo., where defendant puts the labels on.

I further find that the roofing material sold by defendant under the name of "RubberO Roofing" is put up in rolls of the same general character as complainant's product, and that this is the way most roofing material is put up, and these rolls contain about the same number of square feet, so that the general appearance of the packages or rolls is similar.

I am of opinion that the word "Ruberoid" when applied to and used to designate the roofing product manufactured by complainant is a valid trade-mark, and that registration thereof was duly and lawfully awarded by the Commissioner of Patents under the Act of March 8th, 1881.

I am further of opinion and find from the evidence that the words "Ruberoid" and "RubberO" when applied to packages of roofing material similar in general size and appearance are sufficiently alike to deceive the unwary or ordinary purchaser.

I am further of opinion that by adopting the name "RubberO" in 1904 after complainant had used the word "Ruberoid" for a period of thirteen years and built up an extensive trade under that name, and after that name had been registered in the Patent Office at Washington, defendant infringed on complainant's rights.

128 I do not think that the explanation given by the only officer of the defendant company who testified in this case is quite satisfactory as to the reason for choosing a trade name in 1904 so close to the name used and registered by complainant. The range of names or words to choose from in matters of this kind is very great, and there is no necessity or excuse for choosing one so nearly alike one already appropriated by a competitor, as to involve any uncertainty and confusion in the mind of the general public who do not analyze closely but act on general impressions. It is true that there is no imitation in the arrangement, color or general appearance of the labels, as such, aside from the similarity of the names, but I think the use of names so similar on rolls of similar size and shape both containing roofing material is calculated whether intentionally or unintentionally, to confuse and deceive the public.

"It is not necessary that the resemblance should be such as to deceive first or intelligent purchasers. It is sufficient if it be calculated to deceive the unwary, incautious, or the ignorant purchaser. Neither need the resemblance be so great that one would be deceived who should see the labels placed side by side. If an ordinary purchaser, looking at the articles offered to him, would naturally be led, from the labels attached to it, to suppose it to be the product of a rival manufacturer, and to purchase it in that belief, the court will enjoin the use of such article as fraudulent." Cauffman vs. Schuler, 123 Fed. 205, 206; and see Hesseltine on the Law of Trade Marks, p. 239, and cases there cited. It has been frequently held that courts do not consider whether a dealer will be confused, but whether a consumer will be. (National Biscuit Co. vs. Baker, 95 Fed. 135). But in this case complainant has shown that even a dealer in roofing was misled.

My decision is, that there should be an decree for a perpetual injunction and an accounting. Complainant's counsel may prepare a decree in accordance herewith and submit it to the Court.

UNITED STATES OF AMERICA,
Eastern Division of the Eastern
Judicial District of Missouri, ss:

I, James R. Gray, Clerk of the Circuit Court of the United States, in and for the Eastern Division of the Eastern Judicial District of Missouri, do hereby certify that the writing hereto attached is a full, true and complete transcript of the record and proceedings in Case No. —, of Standard Paint Company, Complainant, vs.
129 Trinidad Asphalt Manufacturing Company, Defendant, as fully as the same remains on file and of record in said case in my office, as restricted by the stipulation of parties, a copy of which stipulation is set forth on pages 1, 2 and 3 of the foregoing record, and that the original citation is hereto attached and herewith returned.

In witness whereof, I hereunto subscribe my name and affix the seal of said Court, at office, in the City of St. Louis, in the Eastern

Division of said District, this 15th day of May, in the year of our Lord, nineteen hundred and seven.

[Seal of the United States Circuit Court, Eastern Division of the Eastern Judicial District of Missouri.]

JAMES R. GRAY, *Clerk.*

Filed May 16, 1907. John D. Jordan, Clerk.

130 (*Appearance of Counsel for Appellant.*)

On the seventeenth day of May, A. D. 1907, the appearance of counsel for appellant was filed in said cause, in the words and figures following, to-wit:

United States Circuit Court of Appeals, Eighth Circuit.

No. 2621.

TRINIDAD ASPHALT MANUFACTURING COMPANY, Appellant,
vs.
STANDARD PAINT COMPANY.

The Clerk will enter my appearance as Counsel for the Appellant.

W. B. HOMER,
421 *Olive St., St. Louis, Mo.*

(Endorsed:) U. S. Circuit Court of Appeals, Eighth Circuit. No. 2621. Trinidad Asphalt Manufacturing Co., Appellant, vs. Standard Paint Company. Appearance. Filed May 17, 1907. John D. Jordan, Clerk. W. B. Homer, Counsel for Appellant.

(*Appearance of Counsel for Appellee.*)

And on the twenty-fifth day of October, A. D. 1907, the appearance of counsel for appellee was filed in said cause, in the words and figures following, to-wit:

United States Circuit Court of Appeals, Eighth Circuit.

No. 2621.

TRINIDAD ASPHALT MANUFACTURING COMPANY, Appellant,
vs.
STANDARD PAINT COMPANY.

The Clerk will enter my appearance as Counsel for the Appellee.

JUDSON & GREEN.
F. N. JUDSON.
JOHN F. GREEN.

(Endorsed:) U. S. Circuit Court of Appeals, Eighth Circuit. No. 2621. Trinidad Asphalt Manufacturing Company, Appel-
131 lant, vs. Standard Paint Company. Appearance. Filed Oct. 25, 1907. John D. Jordan, Clerk. F. N. Judson, John F. Green, Counsel for Appellee.

(*Order of Submission.*)

And on the thirteenth day of December, A. D. 1907, in the record of the proceedings of said Circuit Court of Appeals is an order of submission in said cause, in the words and figures following, to-wit:

United States Circuit Court of Appeals, Eighth Circuit, December Term, 1907. Friday, December 13, 1907.

No. 2621.

TRINIDAD ASPHALT MANUFACTURING COMPANY, a Corporation, Appellant,
vs.
STANDARD PAINT COMPANY, a Corporation.

Appeal from the Circuit Court of the United States for the Eastern District of Missouri.

This cause having been called for hearing in its regular order, argument was commenced by Mr. W. B. Homer in behalf of appellant, continued by Mr. John F. Green for Appellee and concluded by Mr. W. B. Homer for appellant.

Thereupon this cause was submitted to the Court upon the transcript of record from said Circuit Court and the briefs of counsel filed herein.

(*Opinion.*)

And on the eleventh day of August, A. D. 1908, the opinion of said United States Circuit Court of Appeals was filed in said cause, in the words and figures following, to-wit:

132 United States Circuit Court of Appeals, Eighth Circuit. May Term, A. D. 1908.

No. 2621.

TRINIDAD ASPHALT MANUFACTURING COMPANY, Appellant,
vs.
STANDARD PAINT COMPANY, Appellee.

Appeal from the Circuit Court of the United States for the Eastern District of Missouri.

Mr. W. B. Homer for the appellant.

Mr. John F. Green (Mr. F. N. Judson on the brief) for the appellee.

Before Sanborn, Hook and Adams, Circuit Judges.

Hook, Circuit Judge, delivered the opinion of the court.

About the year 1891 the Standard Paint Company, a West Virginia corporation, commenced to make and put upon the market a prepared roofing material of felt saturated with a gum composed of the residuum of animal fats. Because of the close resemblance of the gum to rubber and the durability and flexibility of the roofing it then adopted the word "Ruberoid" as a trade name, and in 1901 caused it to be registered in the patent office as a trade-mark. In the application for registration it was said the trade-mark was appropriated to solid substances in the nature of soft flexible rubber in the form of flexible roofing, etc. It extensively advertised, and built up a large business. In 1904 the Trinidad Asphalt Manufacturing Company, a Missouri corporation, put upon the market a roofing of similar appearance and of similar composition except that vegetable oils were used in treating the felt, and it applied thereto the name "RubberO." There were about forty other concerns engaged in that business, many of whose products resembled those of complainant and defendant, and because they possessed some of the characteristics of India rubber were called and known to the trade as rubber roofings though in none of them was rubber an ingredient. The Standard Company sued the Trinidad Company for an injunction and an accounting on two grounds: first, infringement of trade-mark; and, second, unfair competition in that the use by defendant of the word rubbero, its similarity to ruberoid, and the form and dress of defendant's roofing as put upon the market were calculated to and did deceive the public
133 when buying it into the belief they were buying the roofing of complainant. The trial court gave the complainant a decree and the defendant appealed.

First as to complainant's trade-mark. It is clear that by the adoption of the word ruberoid as a trade-mark it was sought to appropriate the exclusive use of the term rubberoid and complainant's rights are to be judged accordingly. If the latter cannot be appropriated as a trade-mark because it is a common descriptive word and its use therefore belongs to the public, complainant can-

not maintain its claim to the one it selected. A public right in rubberoid and a private monopoly of ruberoid cannot co-exist. They are inconsistent and trespass upon each other; and under the law of trade-mark the latter must give way. To the contention that ruberoid is fanciful or arbitrary it must be said that no one can restrict or destroy the public right by the coinage and monopoly of a word that is a near imitation of one the use of which is open to all for the truthful description of articles of trade and commerce. The act of Congress (21 Stats. 502, 3 U. S. Comp. Stats. 1901 p. 3401) prohibits the registration of a trade-mark so closely resembling that of another as to create mistake or confusion in the mind of the public, and certainly the public is entitled to like protection against encroachments upon a common descriptive term. To the visual perception there is a close resemblance between rubberoid and ruberoid, and the pronunciation is so nearly identical the difference would not ordinarily be noticed by the attentive ear. They are substantially alike in suggestion. Nothing can be gained by the mere dropping of a "b" from the appropriate word expressive of the advertised qualities of complainant's product. For similar reasons it was held that the word "Matzoon" could not be appropriated as a trade-mark for a medicinal beverage because of its similarity to "Madzoon," the latter being the transliteration of the ancient Armenian name of the preparation. (Dadirrian v. Yacubian, 39 C. C. A. 321, 98 Fed. 872.) In Goodyear Co. v. Rubber Co. (128 U. S. 598, 604) it was said: "The designation Goodyear Rubber Company not being subject to exclusive appropriation, any use of terms of similar import, or any abbreviation of them, must be alike free to all persons." Because of its very structure and meaning the word rubberoid is not a fanciful one, and it owes nothing to complainant for its existence or its descriptive relevance to the roofing productions in question. It was a part of our common vocabulary long before complainant began operations, the patent office discloses applications of it to compositions resembling but not containing rubber, and it had found its way into the lexicons. The suffix "oid" signifies likeness or resemblance to the thing indicated by the word to which it is attached. Thus granitoid means like granite, crystalloid like crystal and rubberoid like rubber. The latter is the common English term signifying a resemblance to rubber in appearance or characteristics. Indeed, it would appear that many of the rubber roofings so called that are common in the markets could more appropriately and truthfully be described as rubberoid.

134 It is the settled rule that no one can appropriate as a trade-mark a generic name or one descriptive of an article of trade, its qualities, ingredients or characteristics, or any sign, word or symbol which from the nature of the fact it is used to signify others may employ with equal truth. Canal Co. v. Clark, 13 Wall. 311, 323; Goodyear Co. v. Rubber Co., 128 U. S. 598; Brown Chemical Co. v. Meyer, 139 U. S. 540. A reference to a few of the many cases in which it has been applied may more clearly signify its purport than the bare statement of the rule itself. The following have been held to be descriptive terms and therefore not the subject of trade-mark:

"Nourishing stout" as applied to a malt liquor (Raggett v. Findlater L. R. 17 Eq. 29); "Gall cure" to a medicine (Bickmore, etc., Co. v. Mfg. Co., 67 C. C. A. 439, 134 Fed. 833); "Whirling spray" to a syringe (Marvel Co. v. Pearl, 66 C. C. A. 226, 133 Fed. 160; "Standard" and "Computing" to scales (Computing Scale Co. v. Standard Computing Scale Co., 55 C. C. A. 459, 118 Fed. 965); "Steel shod" to boots and shoes with soles studded with nails (Brennan v. Dry Goods Co., 47 C. C. A. 532, 108 Fed. 624, 99 Fed. 971); "Aluminum" to a manufactured article composed in part of that metal (American Washboard Co. v. Mfg. Co., 43 C. C. A. 233, 103 Fed. 281); and "Instantaneous" to a tapica ready for use (Bennett v. McKinley, 13 C. C. A. 25, 65 Fed. 505); "Iron Bitters" (Brown Chemical Co. v. Meyer, 31 Fed. 433, affirmed in 139 U. S. 540); "Acid Phosphate" (Rumford Chemical Works v. Muth, 35 Fed. 524); "Indurated Fiber" to wares made of wood pulp (Indurated Fiber Co. v. Amoskeag, etc. Co. 37 Fed. 695); "Cramp Cure" (Harris Drug Co. v. Stucky, 46 Fed. 624); "Hygienic" to underwear (Jaros, etc., Co. v. Fleece Co., 65 Fed. 424); "Valvoline" to lubricating or valve oil (Leonard v. Wells, 53 L. J. Ch. 233, 32 W. R. 532); "Croup Tincture" (Re Roach, 10 Pat. Off. Gaz. 333); "Crack-proof" to rubber goods (In re Goodyear Rubber Co., 11 Pat. Off. Gaz. 1062); "Crystalline" to artificial stones (Ex parte Pikling, 24 Pat. Off. Gaz. 899); "Fireproof Oil" (Scott v. Standard Oil Co., 106 Ala. 475); "Aromatic Schiedam Schnapps" to gin (Burke v. Cassin, 45 Cal. 467); "Snowflake" to crackers and biscuit (Larrabee v. Lewis, 67 Ga. 561); "Cough Remedy" (Gilman v. Hunnewell, 122 Mass. 139); "Selected Shore Mackarel" (Trask v. Wooster, 28 Mo. App. 408); "Rye and Rock" to a mixture of rock candy and rye whiskey (Van Beil v. Prescott, 82 N. Y. 630); "Dessicated Codfish" (Town v. Stetson, 3 Daly (N. Y.) 53); "Headache Wafers" (Gessler v. Grieb, 80 Wis. 21); "Microbe Killer" (Alff v. Radam, 77 Tex. 530). Rubberoid easily falls in the above class when applied to articles with no rubber in their composition but appearing to have and possessing its qualities and characteristics. There are cases in which words and phrases have been upheld as trade marks upon the ground that they were suggestive rather than descriptive, but they have no application here.

Even a proper name may in time become by common acceptation the generic designation of an article, and after the expiration of the monopoly arising from letters patent become publici juris
135 like an ordinary descriptive term, and therefore not appropriable as a trade mark. This was held to be so of "Rahtjen's Composition" and a preparation of paint (Holzapfel's Co. v. Rahtjen's Co., 183 U. S. 1); "Singer" and the sewing machine (Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169); "Goodyear rubber" and a class of goods made by the process known as Goodyear's invention (Goodyear Co. v. Rubber Co., 128 U. S. 598, 602); "Webster" and the dictionary (Merriam v. Pub. Co., 43 Fed. 456, Merriam v. Clothing Co., 47 Fed. 411); "Fairbanks" and a make of scales (Fairbanks v. Jacobus, 14 Blatchf. 337, 8 Fed. Cas. 951, Case No. 4608); "Harvey" and "Worcestershire" and the

table sauces of those names (Lazenby v. White, 41 L. J. 354; Lea v. Deakin, 11 Biss. 23, 15 Fed. Cas. 95, Case No. 8154). In the same way a fanciful word may become the very name of the thing to which in the beginning it was arbitrarily applied. Before this controversy arose complainant publicly declared it selected the word ruberoid for a trade mark because of the resemblance of its product of rubber. It advertised the fact to the world and pointed to the common characteristics. The truth of its statement is so obvious and the connection between the misspelled name and the thing so manifest we need not search for some remote likeness to other words found in the lexicons that have no possible application to the artificial roofing in question. That the roofing of complainant possesses characteristics of rubber in composition is plain to the most ordinary inspection, and it is also plain that the average person would take the word adopted as signifying that fact. It seems altogether clear that complainant's trade mark is invalid.

The rule as to unfair or fraudulent competition does not necessarily involve the right to the exclusive use of a word or symbol for though one's trade mark may be invalid the circumstances attending its use by another may be such as to constitute an invasion of his rights and a fraud upon the public. It proceeds upon ethical considerations and has its foundation in business honesty. The evil against which it is directed has a two-fold aspect, the deception of the purchasing public and the consequent piracy of the reputation and good will which a competitor has earned by fair conduct and the quality of his goods, and which constitutes a valuable asset in his business. Briefly stated the rule is that one should not be permitted to sell his goods as the goods of another. If he uses a generic name or descriptive term which a competitor has employed before him, he should not by other words, signs or symbols, or by the dress, appearance or form of package so imitate his competitor's course or way as to deceive the ordinary purchaser giving such attention as purchasers usually do. But all must submit to the competition which comes alone from the fair and truthful employment of generic names and terms descriptive of the qualities and characteristics of articles of trade and commerce unaccompanied by other acts designed to induce confusion and error in the mind of the public.

We discover nothing in defendant's conduct justifying the
136 charge of unfair competition. In the last analysis the charge rests solely on the use of the word rubbero and the similarity thereof to ruberoid or its equivalent, rubberoid. Complainant has no monopoly of the resemblance to rubber of roofing that has none in its composition, and obviously it cannot secure a monopoly of the appropriate term descriptive of that resemblance by invoking the doctrine of unfair competition. The word rubberoid is part of the common heritage, and all who can truthfully apply it to their products are entitled to do so, taking due care that they do not otherwise trespass upon the rights of competitors. The defendant being entitled to the proper use of the word rubberoid the complainant cannot justly complain of the use of rubbero. That complainant

marketed its roofing in rolls and defendant did the same is not significant. That was the usual, ordinary course of those engaged in the business. The form was not peculiar or fanciful but was one conveninence due to the physical characteristics of the material. It is as natural that such roofing should be in rolls as carpet, matting or paper, or as dress fabrics in bolts, thread on spools or matches in boxes. Similar considerations apply to the cutting of the roofiing into strips of convenient width and the designation of the weight or thickness thereof. There was no imitation of the arrangement, color, design or general appearance of the wrappers and markings on the packages. On the contrary those of defendant were in such marked contrast to complainant's as to repel all suggestion of design on the part of the former to misrepresent the origin or ownership of its product. Moreover its name and address were plainly printed on the labels. It would be a result unsustained by reason or authority if one, after vainly attempting through a trade mark to secure a monopoly of a generic or descriptive word, should nevertheless be granted one by decree of a court applying the doctrine of unfair competition to those who simply used the word in the appropriate naming or description of their goods but in other respects plainly distinguished them from the goods of their competitor. Yet that is practically what complainant is attempting in the second branch of its case for it has no other basis than the mere use by defen[illegible]t of the word rubbero. If at complainant's instance a court [illegible]d enjoin the use of rubbero then logically none of the large number of other manufacturers who make roofings resembling rubber can lawfully call their products rubber roofing or rubberoid roofing because of similarity to the term selected by complainant, and thus complainant would be allowed to fence off and appropriate to its exclusive use a part of our common vocabulary. As well might a manufacturer be decreed the exclusive right to call his sugar sweet or his vinegar sour. In Singer Mfg. Co. v. June Mfg. Co., supra, the Supreme Court held that the name "Singer" had become the generic designation of a certain class of sewing machines and therefore the Singer Company could not appropriate it as a trade-mark though it had exclusively used it many years. It also expressly recognized the right of any manufacturer of that type of machines to apply the name "Singer" thereto provided it was clearly and unmistakably specified in connec-
137 tion therewith that they were the product of the maker and not of the Singer Company (163 U. S. 207). The requirements of honest competition mentioned by the court in that case were fully met by the defendant here. In Centaur Co. v. Heinsfurter, 28 C. C. A. 581, 84 Fed. 955, an injunction was sought restraining the defendant from using the word "Castoria." It was held that the word had become the descriptive name of the medicine to which it was applied and therefore plaintiff could not appropriate it as a trade mark though it had long enjoyed the exclusive use of it. Mr. Justice Brewer speaking for this court said of the claim of unfair competition: "But, as we have heretofore observed, in the present case, outside of the use of the word 'Castoria' there is

nothing to mislead the public into the belief that the Castoria manufactured and sold by the defendants was in fact manufactured and sold by the plaintiff. On the contrary, the information was full and specific that the defendants were the manufacturers and vendors." This excerpt aptly fits the case at bar. True, in both these cases there were patents which had expired and the names "Singer" and "Castoria" had become the generic names of the articles during the existence of the monopoly. When the patents expired and the exclusive right to manufacture ceased, the right to use the names also became a public one through a species of dedication. But in respect of the question now being considered, those cases are indistinguishable in principle from the one before us. It is immaterial that names like "Singer" and "Castoria" became public property by acquiescence of those who first employed them instead of being naturally so by reason of structure and original meaning as is the case with an ordinary appellative like rubberoid. The important thing is the fact that they are public property, not how they became so. If they are, it follows from that quality alone that all may truthfully apply them to their products, that no one can lawfully monopolize them. Though the cases cited also involve other questions they recognize and enforce the established rule that unfair competition cannot arise from the mere use of words belonging to the public, accompanied by a fair and truthful statement of the ownership and source of manufacture.

In Brown Chemical Co. v. Meyer (139 U. S. 540) the rule was expressly applied. The complainant had for a long time made "Brown's Iron Bitters," when defendant put upon the market a medicine which he called "Brown's Iron Tonic." The court, after first observing that there could be no valid trade-mark in the words "Iron Bitters" addressed itself to the claim of unfair competition, and after considering the similarities of the form and dress of the packages found that they afforded no ground for complaint. So as in the case at bar, the question finally resolved itself into one of the mere use of complainant's words, or words similar thereto. The court said: "But if the words 'Iron Bitters' can not be lawfully appropriated as a trade-mark, it is difficult to see upon what theory a person making use of these or similar words can be enjoined. We understand it to be conceded that these words do not in themselves constitute a trade-mark; it follows then that another person has the right to use them, unless he uses them in such connection with other words or devices as to operate as a deception upon the public." And then the court disposed of the addition of the patronymic "Brown" by finding from the Acts in the case defendant had the right to use it also. The same rule was applied on the circuit in Brown Chemical Co. v .Meyer, 31 Fed. 453, by Judge Thayer, and in Gessler v. Grieb, 80 Wis. 21, and Alff v. Radam, 77 Tex. 530.

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In Reddaway v. Banham (L. R. App. Cas. 1896 p. 199) the decree directed by the House of Lords to be entered by the lower court recognized the right of defendants to use the name "camel hair belting" under restrictions similar to those imposed by the Supreme

Court in the Singer case. By long use the name had come to signify plaintiff's goods. The decree which was directed (p. 222) was "for an injunction restraining the defendants and each of them from using the words 'Camel hair' as descriptive of or in connexion with belting manufactured by them or either of them or belting (not being of the plaintiffs' manufacture) sold or offered for sale by them or either of them *without clearly distinguishing such belting from the belting of the plaintiffs.*" The italics are ours.

In respect to distinguishing, Lord Morris said: "That, to my mind, is obviously done when the respondents put prominently and in a conspicuous place on the article the statement that it was camel hair belting manufactured by themselves. Having done so, they would, as it appears to me, fully apprise purchasers that it was not Reddaway's make, by stating that it was their own." (pp. 221, 222.)

The decree is reversed and the cause remanded with directions to dismiss the bill.

Filed August 11, 1908.

SANBORN, *Circuit Judge*, dissenting:

In 1891 the complainant commenced to manufacture a roofing to which it applied the trade-name "ruberoid." Its officers and agents pronounce this word ru-ber-oid. Neither this word nor the word rubberoid had ever been used to designate or describe this or any other roofing at that time. In 1901 the complainant registered this word "ruberoid" as its trade-mark. It advertised and promoted the sale of its ruberoid until its sales in the year 1904 amounted to $950,000.00, its roofing was known, ordered and sold throughout the United States and foreign countries by the name "ruberoid" and that word had come to mean in the trade the complainant's product. That word indicated to the trade the origin and the ownership of the roofing. Thereupon the defendant in 1904 commenced to make and sell a similar roofing under the name of "rubbero" and the complainant's sales decreased $8,000.00 in the territory where the latter article was sold and nowhere else.

The Circuit Court was of the opinion that the word "ruber-
139 oid" was a valid trade-mark, that the defendant infringed upon it and was guilty of unfair competition, and it enjoined the use of the word "rubbero" in competition with the complainant's product. The findings and conclusion of the chancellor in cases of conflicting evidence prevail unless it clearly appears that he has fallen into an error of law or a plain mistake of fact, and I find myself unable to concur in the view of the majority that the court below was guilty of either.

The striking similarity between the words "rubbero" and "Ruberoid," the many dissimilar names open to the defendant, the long established reputation and extensive sales of complainant's "ruberoid," the evident probability and the evidence of confusion of the trade by the use of the word "rubbero" and the decrease of complainant's sales after the defendant commenced to use it,

leave no doubt in my mind that the court below was right in its conclusion that the purpose of the conception and use of the word "rubbero" by the defendant was to palm off its product as that of the complainant, and that it has been accomplishing its purpose. The arguments in support of the position that the defendant has the equitable right to palm off its roofing as the ruberoid roofing of the complainant by the use of the word "rubbero" as I understand them, are substantially these: (1) That the word "ruberoid" is substantially identical with the word "Rubberoid," that the word "rubberoid," is a public heritage incapable of monopolization as a trade-mark, hence that the word "ruberoid" is so and the defendant is entitled in equity to take the complainant's trade in its ruberoid roofing by the use of the word "rubbero"; (2) that the word "ruberoid" is descriptive, that it cannot become a trade-mark and hence the defendant may use the word "rubbero" to sell its goods as the ruberoid of the complainant; (3) that the word "ruberoid" is a generic term and hence the defendant may use the word "rubbero" to sell its goods as the ruberoid of the complainant; (4) that the complainant does not palm off its goods as the goods of the complainant by the simulation of the dress of complainant's goods or by any other means than the use of the word "rubbero," and hence it should be permitted to use the word "rubbero"; (5) that if the defendant is enjoined from using the word "rubbero" other manufacturers could not be logically permitted to call their products "rubber roofing" or "ruberoid roofing" and hence the defendant should be permitted to use the word "rubbero" to take from the complainant its trade in ruberoid roofing; (6) that where a manufacturer of a patented product has made his trade-name the generic name of his manufacture during the term of his patent, as in Singer Mfg. Co. v. June Mfg. Co., 163 U. S., 169, 178, 186, 189, 201, 204 and the "Castoria" case, Centaur Company v. Heinsfurter, 84 Fed., 956, other manufacturers of the same product may use this generic name on condition that they clearly make known to purchasers that it is not the manufacture of the original patentee, hence the defendant may use the word "rubbero" to sell its goods as the ruberoid of the complainant notwithstanding the fact
140 that the complainant's manufacture was never patented and the word "ruberoid" has always remained the designation of its particular product and never became the generic name rubber roofing. Some of the reasons why these contentions have not proved persuasive to me are these:

(1) When the complainant adopted the word "ruberoid" as its trade-mark in the year 1891, and before it taught the public and the trade by its advertisements and sales that this word meant its particular make of rubber roofing, this word "ruberoid" was not, in my opinion, substantially identical with but was distinctive from the word "rubberoid." It was not pronounced and did not sound the same. Ru-ber-oid sounds as different from rubberoid as ruble from rubble. It was not spelled in the same way, and when written or printed it had a strikingly different appearance. There is no more striking method of differentiating words than by

changing the spelling. Witness uneeda in contrast with youneeda. The absence of a single letter destroys the identity and the similarity of appearance and signification of many words. Tough is not trough; cow is not crow; rob is not robe; robin is not robbin; robing is not robbing; ruble is not rubble and ru-ber-oid is not rubberoid. The root of ruberoid is rubere, to be red, and some of its derivatives are rubify, rubific, rubescent, rubicund, rubidity. The root of rubberoid is rub, to apply pressure with motion. Caoutchouc acquired the name rubber because it was first used to erase pencil marks by rubbing. Ruberoid did not have, and never has had, the same meaning as rubberoid. The generic name of the product of the complainant, of that of the defendant and of those of more than thirty other manufacturers, is rubber roofing. Some of the trade-marks of the products of specific manufacturers of this rubber roofing are "Ruberoid," "Paroid," "Indruroid," "Lasticite," "Perfection," "Galvanized," "Original." The evidence in the record in hand is clear and uncontradicted that the word "ruberoid" signified nothing to those who first saw and heard it until the complainant taught the trade that it meant its specific manufacture of rubber roofing and that this word has never become the generic name of such roofing which has always continued to be rubber roofing, nor has it ever signified anything but the origin and ownership of the complainant's particular product. The evidence is also undisputed that the word "rubberoid" has never signified any kind of rubber roofing. Its definition in the Century dictionary is "a trade name for an imitation of hard rubber" and it has signified solid articles like the handles of knives and forks, but never felt saturated with the residuum of animal fats or any other soft or flexible roofing. The facts of this case therefore neither prove nor indicate to my mind that the complainant sought to appropriate the exclusive or any use of the word "rubberoid" by its adoption of the word "ruberoid" as its trade-mark, and they equally fail to show in my opinion that a public right in rubberoid and a private right in ruberoid may not lawfully co-exist. On the other hand they seem to me to show conclusively that if
141 the word "rubberoid" was a public heritage and incapable of monopolization the word "ruberoid" was not of that character, but was a fanciful term coined by the complainant, and its appropriation and use as a trade-mark in no way impinged upon the free use by the public of the word "rubberoid," and this because the former word never had the same sound, nor the same spelling, nor the same appearance, nor the same meaning, as the latter, but was a new and fanciful term coined and used to mark a particular product which has never yet fallen within the meaning of the word "rubberoid."

Moreover, the defendant does not use the word "rubberoid," and the question here is not whether it may avail itself of the common heritage in that word and its meaning but whether or not it has a right to coin and use the fanciful word "rubbero" to palm off its goods as those of the complainant, a right which is superior

in equity to the right of the complainant to enjoin and prevent the perpetration of such a wrong.

(2) Is the defendant entitled to the use of the word "rubbero" to sell its goods as the ruberoid of the complainant because the word "ruberoid" is descriptive and for that reason not subject to monopolization as a trade-mark? The question is not whether or not the word "ruberoid" described the complainant's roofing in 1904 when the defendant sought to appropriate its trade by the use of the word "rubbero," nor is it whether or not this word "ruberoid" describes the complainant's product now, but it is whether or not it so clearly described it, or its qualities, or its characteristics, at the time it was first adopted, that it would have been recognized at that time by men of ordinary experience in the trade upon seeing or hearing the word for the first time. Wellcome v. Thompson & Capper, 1 L. R. Chan. Div., 1904, pages 736, 742, 749, 750, 754; Keasbey v. Chemical Works, 142 N. Y., 467, 471, 474, 475, 476.

Again, words are disqualified for trade-marks only when they are so accurately descriptive of the qualities, ingredients and characteristics of the articles that the latter would be recognized by men of ordinary intelligence upon seeing or hearing the words when first applied. Keasbey v. Chemical Works, 142 N. Y., 467, supra. Of this nature are the words adjudicated in the cases cited by the majority, "Lackawanna" as a description of the valley of that name whence Lackawanna coal was derived; Canal Company v. Clark, 13 Wall., 311, 323; "Goodyear Rubber" used after, as the Supreme Court said, these words had become "terms descriptive of well-known classes of goods produced by the process known as Goodyear's invention," Goodyear Co. v. Goodyear Rubber Company, 128 U. S., 598, 602; "Iron Bitters," in a case in which the word iron was accurately descriptive of the distinctive ingredient of the bitters, Brown Chemical Company v. Meyer, 139 U. S., 540.

But words which are merely suggestive of the qualities, ingredients or characteristics of the articles to which they are applied but do not so accurately describe them that men of ordinary intel-
142 ligence would have recognized them upon seeing or hearing the words when first applied, constitute valid trade-marks.

Thus "tabloid" is a good trade-mark although it suggests a similarity to tablet and table and it was applied to a troche in the form of a tablet. Wellcome v. Thompson & Capper, 1 L. R. Chancery Division 1904, pp. 736, 744. The argument was urged in that case that when "tabloid" was first used the words "tabella," "table" and "tablet" were in common use, that the suffix "oid" meant "like" or "allied to" or "in the form of" and hence that "tabloid" described an article like a table or a tablet. But the test applied by the judges was did the word tabloid really intelligently describe the thing sold under that name when it was first applied to it in the year 1884. They held that it did not and sustained the trade-mark. Byrne, J., at page 744 said: "I come to the conclusion that in March, 1884, the word was not 'really intelligibly describing the thing sold,' which is the way in which Lindley, L. J., in 'Bovril' Case (1) (1896) 2 Ch 607 puts the form of direction to the jury. I agree that there is a

suggestion or atmosphere of description about the word as then used, but I do not think that it can be said to have been other than a 'fancy word' as applied to goods in the class to which it was registered."

"Bromo-Caffeine" applied to a medicinal preparation composed of caffeine, bromide of potassium and other ingredients, is a good trade-mark, although caffeine was a well-known article and bromo certainly suggested a bromide much more clearly than ruberoid suggested rubber. Keasbey v. Brooklyn Chemical Works, 142 N. Y. 467, 471, 474, 475, 476. The opinion in that case was written by Judge Peckham, now Mr. Justice Peckham of the Supreme Court, and he stated and applied the rule that a word though suggestive of form, character or quality, was not disqualified for a trade-mark unless it described the article when it was first applied to it so that its character, qualities or ingredients would be recognized by a man of ordinary intelligence at that time upon seeing or hearing the word. Caffeine was a well-known article and the decision turned on the word "Bromo." Judge Peckham said: "The word could only be said to inform one of the fact that bromine or some kind of bromide had entered into and formed part of the compound, but upon the question whether it was bromine or one of the many different kinds of bromides the word 'Bromo' would give no knowledge whatever. A name which furnishes no information on this point cannot be said to be so far descriptive in its nature as to prevent its adoption as a trade-mark so far as this question is concerned."

"Cottolene" applied to a substance composed of cotton-seed oil and the product of beef fat may be monopolized as a trade-mark. Why may not ruberoid which is not composed of any form or extract of rubber? The court said: "It seems clear that 'cottolene' is a proper and valid trade-mark. Although it may suggest cotton-seed oil it is not sufficiently descriptive to render it in-
143 valid as a trade-mark under the recent decisions." N. K. Fairbank Co. v. Central Lard Co., 64 Fed. 133, 134. Under this rule trade-marks have been sustained in "Cocoaine" (Burnett v. Phalon, 9 Bosw. 192); "Maizena" (Manufacturing Co. v. Ludeling, 22 Fed. 823); "Valvoline" (Leonard v. Lubricator, 38 Fed. 922); "Bromidia" (Battle v. Finlay, 45 Fed. 796); "Elastic" when applied to bookcases, Globe-Wernicke Co. v. Brown, 121 Fed. 185, 186); "German Sweet Chocolate" (Walter Baker & Co. v. Baker, 77 Fed. 181, 187, 188); "Anti-Washboard" (O'Rourke v. Central City Soap Co., 26 Fed. 576, 578); "No-To-Bac" (Sterling Remedy Co. v. Eureka Chemical & Mfg. Co., 80 Fed., 105); "Swan Down" applied to a complexion powder, (Tetlow v. Tappan, 85 Fed. 774); "Silicon" and "Electro-silicon" applied to an article one of whose component parts was "Silicon" (Electro-Silicon Co. v. Hazard, 29 Hun. 369); "Celery Compound" (Wells & Richardson Co. v. Siegel, Cooper & Co., 106 Fed. 77); "Cream" (Price Baking Powder Co. v. Fyfe, 45 Fed. 799); "Lightning" applied to hay-knives (Hiram Holt Co. v. Wadsworth, 41 Fed. 34); "Maryland Club" applied to whiskey (Cahn v. Gottschalk, 2 N. Y. Supp. 13); "Cough Cherries" (Stoughton v. Woodard, 39 Fed. 902); "Sliced Animals," "Sliced Birds,"

"Sliced Objects" applied to dissected puzzle pictures (Selchow v. Baker, 93 N. Y. 59); "Saponifier" (Pennsylvania Salt Mfg. Co. v. Myers, 79 Fed. 87); "Insurance Oil" (Ins. Oil Tank Co. v. Scott, 33 La. An. 946); "Congress Water" and "Congress Spring" (Congress & Empire Spring Co. v. High Rock Congress Spring Co., 45 N. Y. 291); "Magnetic Balm" applied to a medicine (Smith v. Sixbury, 25 Hun. 232) and in numberless suggestive words and terms which failed to accurately describe the articles.

We may argue now, seventeen years after the event, that ruber means rubber and oid means like, and hence ruberoid means like rubber, but there is no evidence in the record in this case that the word "ruberoid" or the word "rubberoid" had ever been applied to any kind of rubber roofing, or that either of them had ever meant felt saturated with the residuum of animal fats, before the complainant selected ruberoid as its trade-mark in 1891 and applied it to its product. There is uncontradicted evidence that neither of them had been so applied and that neither of them had any such meaning. Ruberoid was a word coined by the complainant. It had never existed until the complainant had made and applied it to its felt saturated with the residuum of animal fats and it has never had any other meaning than the complainant's particular product. This evidence and these facts have forced my mind to the conclusion that no one who first heard or saw this word "ruberoid" in 1891, before the complainant taught its meaning by advertisements and application to its product, could have recognized thereby the product of the complainant, or the ingredients or characteristics of its roofing, and hence that the word "ruberoid" was not descriptive but was a fanciful term which constituted a perfect trade-mark. From this conclusion it necessarily follows that the use of the word "rub-
144 bero" to sell a similar product is a clear infringement of the complainant's trade-mark and that the complainant is entitled to an injunction against that use.

Moreover, even if the word "ruberoid" had been so accurately descriptive that it could not have been a technical trade-mark the result ought not to be different. In Buzby v. Davis, 80 C. C. A. 163, 165, 150 Fed. 275, 277, this court held that the complainant was entitled to an injunction against the use of the word "Keystone" and affirmed the following statement of the law quoted from the opinion in Shaver v. Heller & Merz Co., 48 C. C. A. 48, 59, 108 Fed. 821, 832, in which an injunction against the use by the defendant of the word "American" to sell their goods as the manufacturers of the complainant was sustained.

"The use of a geographical or descriptive term confers no better right to perpetuate a fraud than the use of any other expression. The principle of law is general and without exception. It is that no one may so exercise his own rights as to inflict unnecessary injury upon his neighbor. It is that no one may lawfully palm off the goods of one manufacturer or dealer as those of another to the latter's injury. It prohibits the perpetration of such a fraud by the use of descriptive and geographical terms which are not susceptible of monopolization as trade-marks as effectually as it prohibits

its commission by the use of any other expressions." 48 C. C. A. 55, 108 Fed. 827.

And it is the duty and practice of courts of equity to enjoin the use of descriptive and geographical terms by one competitor for the purpose of filching the trade of another. Thompson v. Montgomery, 41 Ch. Div. 35, 38, 47, 51; Montgomery v. Thompson, Appeal Cases 217, 220; Lee v. Haley, 5 Chan. App. 155, 161; Wotherspoon v. Currie, L. R. 5 H. L. 508, 522, 523; Brewery Co. v. Powell, (1897) App. Cases 710, 716; American Waltham Watch Co. v. U. S. Watch Co., 173 Mass. 85, 53 N. E. 141; Flour Mills Co. v. Eagle, 86 Fed. 608, 628, 30 C. C. A. 386, 406; American Brewing Co. v. St. Louis Brewing Co., 47 Mo. App. 14, 20; Cady v. Schultz, 19 R. I. 193, 32 Atl. 915; Newman v. Alvord, 49 Barb., 588; McLean v. Fleming, 96 U. S. 245, at pages 254, 255; Elgin Nat. Watch Co. v. Illinois Watch Case Co., 179 U. S. 665, 674; Reddaway v. Banham, 1896 App. Cases, 199, 204, 211, 215; Buzby v. Davis, 80 C. C. A. 163, 165, 166, 150 Fed. 275, 277, 278; Shaver v. Heller & Merz Co., 48 C. C. A. 48, 59, 108 Fed. 821, 832, in which this court sustained an injunction issued by the circuit court which forbade the defendants from using the word "American" to sell their goods as the manufactures of the complainant.

The general rule is that one may not use his own name even to sell his goods as those of another, and defendants have been enjoined from using their names for that purpose in these cases: Croft v. Day, 7 Beav. 84, 89, 90; Meyer v. Medicine Co., 58 Fed. 884, 887, 7 C. C. A. 558, 565, 18 U. S. App. 373, 378; Garrett v. T. H. Garrett & Co., 78 Fed. 472, 477, 478, 24 C. C. A. 173, 178,
145 179; Walter Baker & Co. v. Sanders, 80 Fed. 889, 26 C. C. A. 220, 51 U. S. App. 421; Tarrant & Co. v. Hoff, 76 Fed. 959, 961, 22 C. C. A. 644, 646; R. W. Rogers Co. v. Wm. Rogers Mfg. Co., 70 Fed. 1017, 1019, 17 C. C. A. 576, 578, 35 U. S. App. 843, 847, 848; Thread Co. v. Armitage, 45 U. S. App. 62, 73, 21 C. C. A. 178, 186, 74 Fed. 936, 944.

(3) The argument that one who uses a generic or descriptive term is not entitled to an injunction against the use of simulative names or terms, and hence that the defendant has a superior equitable right to use the word "rubbero" to sell its goods as the ruberoid of the complainant, is not persuasive to my mind, because the generic name of the product in this case is rubber roofing and the word "ruberoid" has never become the generic name of the product but has always been a specific designation of complainant's particular manufacture of it, because in my opinion, for the reasons which have already been stated, ruberoid was not descriptive of that product when first applied and because the word "rubbero" is neither the generic name of the product nor any simulation of it, but is a coined fanciful word conceived and applied to simulate, not the generic name rubber roofing, but the specific designation of complainant's manufacture, the term "ruberoid" and to palm off the goods of the defendant as those of the complainant.

(4) It is said that the defendant should be permitted to use the word "rubbero" to sell its product as that of the complainant be-

cause it does not accomplish that end by the simulation of the name of the complainant or by the complainant's other peculiarities of the dress of its goods. But this product of the complainant is ordered and sold throughout the world by its name "ruberoid" and many of those who purchase it doubtless never see its dress until they have made their purchases. In my opinion the evidence is plenary that the defendant creates confusion in the trade and filches the complainant's business by the use of this word "rubbero." It is no defense for one who kills with a pistol that he did not kill with a sword, or for one who defrauds by mortgage that he did not defraud by a deed, and in my opinion it ought to be no defense for one who palms off his own goods as those of another by the use of a successful simulation of the name of the latter's manufacture that he does not accomplish that end by other means, or that he places his own name and address and the assertion of his manufacture and ownership upon the product. The chief effect of placing the defendant's unfamiliar name and marks upon an article so well known as appellee's ruberoid was to give the appellant the benefit of the established reputation of appellee's articles and thus to enable it to derive a greater benefit from its fraud. "That is an aggravation and not a justification, for it is openly trading in the name of another upon the reputation acquired by the device of the perpetrator." Menendez v. Holt, 128 U. S. 514, 521; Gillott v. Esterbrook, 48 N. Y. 374, 378.

(5) Nor does it appear to me to be the logical result of an injunction against the use of the word "rubbero" by the defendant
146 to filch the complainant's trade that none of the other manufacturers of rubber roofing could lawfully call their products ruberoid roofing or rubber roofing. Rubber roofing is the generic name of the product of all these manufacturers and they all have exercised an undoubted right to use that name. Ruberoid is the fanciful term by which the complainant designates its particular manufacture of this product. Rubbero is the fanciful word devised and used by the defendant to simulate, not the generic name rubber roofing, but, the fanciful name of defendant's product for the purpose of palming off the defendant's goods as the complainant's ruberoid. How can an injunction against the continuance of this fraud logically, or otherwise, deprive manufacturers of the right, whose exercise works no fraud, to call their products rubber roofing as they have called them without objection or interruption during the seventeen years that the complainant's manufacture has been made and sold as ruberoid?

(6) The cases of Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 178, 186, 189, 201, 204 and the "Castoria" case, Centaur Co. v. Heinsfurter, 84 Fed. 955, 956, upon which the majority seem to rely so confidently, illustrate an exception to the general rule of the law of unfair competition, under which the case at bar, in my opinion, does not fall. That exception is that where a patentee during the life of his patent confers an arbitrary or a generic name upon the patented article by which alone it comes to be known during the term of the patent, such as "Singer" in the former

case and "Castoria" in the latter, the right to the use of that name passes to the public upon the expiration of the patent. Pages 178, 183, 199 of 165 U. S. But if there had been no patent, or if there had been no conference of such name, or if there had been no expiration of the patent, the right to the use of the name would not have passed to the public. Those cases are inapplicable to the case at bar because the complainant's product was never protected by a patent, because ruberoid, the trade-name of its manufacture, was not conferred upon the product while the complainant had a patented monopoly of its manufacture and because that term never became the generic name of the product which was and is rubber roofing, but has always been, and still is, simply the distinguishing name of complainant's particular manufacture. This case falls under the general rule, and that is that no one may lawfully use any word or expression which has come to signify his competitor's product for the purpose of filching his trade and perpetrating a fraud upon the public.

In Reddaway v. Banham, the plaintiff had manufactured and sold for fourteen years belting made chiefly of camel's hair under the name "camel hair belting" until that term had come to signify Reddaway's belting to the trade. Then the defendant commenced to make belting of camel's hair and to sell it as "camel hair belting." The court below refused to sustain an injunction against him but the House of Lords reversed that decision and restrained the defendant from using the words "camel hair" so as to palm off its goods as those of the complainant. Lord Herschell said:

147 "In my opinion the doctrine on which the judgment of the Court of Appeal is based, that where a manufacturer has used as his trade-mark a descriptive word he is never entitled to relief against a person who so uses it as to induce in purchasers the belief that they are getting the goods of the manufacturer who has theretofore employed it as his trade-mark, is not supported by authority and cannot be defended on principle. I am unable to see why a man should be allowed in this way more than in any other to deceive purchasers into the belief that they are getting what they are not and thus to filch the business of his rival."

In Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S. 665, 674, a case determined by the Supreme Court long after Brown Chemical Co. v. Meyer, 139 U. S. 540, the Supreme Court held that the word "Elgin" was a geographical term not the subject of a trade-mark. But it also reviewed with approval Wotherspoon v. Currie and Reddaway v. Banham, and said: "But it is contended that the name Elgin had acquired a secondary signification in connection with its use by appellant and should not for that reason be considered or treated as a mere geographical name. It is undoubtedly true that where such a secondary signification has been acquired, its use in that sense will be protected by restraining the use of the word by others in such a way as to amount to a fraud on the public and on those to whose employment of it the special meaning has become attached."

The word "rubbero" is so similar to the word "ruberoid," so

different from the generic name rubber roofing that I am unable to bring my mind to believe or suppose that it was conceived or used for any other purpose than to palm off the defendant's goods as those of the plaintiff. Under the decision of the Supreme Court in Menendez v. Holt, 128 U. S. 514, 521, and other authorities of like character, the fact that the complainant added its name and address and asserted its manufacture of the product it sold under this name rubbero not only failed, in my opinion, to excuse, but had the effect to aggravate the offense, and the decree for an injunction against the continued perpetration of this fraud granted by the court below should, I think, be affirmed, both because complainant's "ruberoid" was not descriptive of its product, but was a fanciful word and a good technical trade-mark which was infringed by the defendant's use of the word "rubbero," and because the evidence has convinced me, as it did the court below, that the defendant was guilty of unfair competition by the use of this word "rubbero" to palm off its product as the ruberoid of the complainant.

Filed August 11, 1908.

148 (*Decree.*)

And on the eleventh day of August, A. D. 1908, in the record of the proceedings of said Circuit Court of Appeals is a decree in said cause, in the words and figures following, to-wit:

United States Circuit Court of Appeals, Eighth Circuit, May Term, 1908.

TUESDAY, *August* 11, 1908.

No. 2621.

TRINIDAD ASPHALT MANUFACTURING COMPANY, a Corporation, Appellant,
vs.
STANDARD PAINT COMPANY, a Corporation.

Appeal from the Circuit Court of the United States for the Eastern District of Missouri.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Eastern District of Missouri, and was argued by counsel.

On Consideration Whereof, it is now here ordered, adjudged and decreed by this Court, that the decree of the said Circuit Court, in this cause, be, and the same is hereby, reversed with costs; and that the Trinidad Asphalt Manufacturing Company, a corporation, have and recover against the Standard Paint Company, a corporation, the sum of One Hundred Twenty Six and 55/100 Dollars for its costs in this behalf expended and have execution therefor.

It is further ordered that this cause be, and the same is hereby, remanded to the said Circuit Court with directions to dismiss the bill.

AUGUST 11, 1908.

(Petition for Appeal to Supreme Court, U. S.)

And on the second day of November, A. D. 1908, a petition for appeal to the Supreme Court of the United States was filed in said cause, in the words and figures following, to-wit:

149 In the United States Circuit Court of Appeals, Eighth Judicial Circuit, October Term, 1908.

STANDARD PAINT COMPANY, a Corporation, Appellant,
vs.
TRINIDAD ASPHALT MANUFACTURING CO., a Corporation, Respondent.

Petition for Appeal.

The above named appellant, the Standard Paint Company, believing itself aggrieved by the final decree, order and judgment entered in the above entitled cause, on the 12th day of August, 1908, by the Circuit Court of Appeals for the Eighth Circuit, whereby said Circuit Court of Appeals did order that the decree of the Circuit Court in this cause be reversed and that the bill of complaint filed in this cause by the said appellant should be dismissed, and desiring to appeal to the Supreme Court of the United States from said order and judgment of said Circuit Court of Appeals, says that it appears from the bill of complaint herein that the jurisdiction of the United States Circuit Court in this cause was not dependent upon the complainant and defendant being aliens or citizens of different states, but that the said Circuit Court of the United States had jurisdiction of the cause because it appears from the bill of complaint that appellant herein is seeking to enforce and protect rights arising under the laws of the United States, in that it is alleged in said bill of complaint that appellant is, and for more than twelve years had been, the owner of a trade mark and trade name for prepared roofing, duly registered under the laws of the United States, at Washington, D. C., and that for twelve years prior to the date of the filing of said bill of complaint, it had been engaged in carrying on commerce in said roofing with foreign countries and Indian Tribes, using in such commerce the said trade mark, which trade mark is in said bill alleged to have been infringed by defendant, and appellant further says that the sum or value in controversy in said cause exceeds one thou-
150 sand dollars besides costs, and said complainant, the Standard Paint Company, appellant herein, prays that its appeal to the Supreme Court of the United States may be allowed and that a transcript of the record and proceedings and papers on which said final decree, judgment and order of said Circuit Court of Appeals for the Eighth Circuit, was made, duly authenticated, may be sent to said Supreme Court of the United States.

And now, at the time of filing this petition for appeal, the Stand-

ard Paint Company, files an assignment of errors setting up separately and particularly each error asserted and intended to be heard in the Supreme Court of the United States, and your petitioner will ever pray, etc.

STANDARD PAINT COMPANY,
By JUDSON & GREEN, *Its Solicitors.*

(Endorsed:) No. 2621. United States Circuit Court of Appeals, Eighth Circuit. Standard Paint Co., Appellant, vs. Trinidad Asphalt Manufacturing Co., Respondent. Petition for Appeal to Supreme Court, U. S. Filed Nov. 2, 1908, John D. Jordan, Clerk. Judson & Green, for Appellant.

(*Assignment of Errors on Appeal to Supreme Court, U. S.*)

And on the second day of November, A. D. 1908, an assignment of errors on appeal to the Supreme Court of the United States was filed in said cause, in the words and figures following, to-wit:

In the United States Circuit Court of Appeals, Eighth Circuit.

STANDARD PAINT COMPANY, a Corporation, Appellant,
vs.
TRINIDAD ASPHALT MANUFACTURING CO., a Corporation, Respondent.

Assignment of Errors.

(1) The Circuit Court of Appeals erred in finding and holding that the complainant did not have a valid trade mark in the word *"Ruberoid"*

151 (2) The Circuit Court of Appeals erred in finding and holding that the word *"Ruberoid"* was so descriptive of the roofing product to which it was applied by complainant that complainant could not have a valid trade mark therein.

(3) The Circuit Court of Appeals erred in holding and finding that complainant was not entitled to the relief prayed for in its bill of complaint upon the distinct ground of "unfair trade," independently of its trade mark.

(4) The Circuit Court of Appeals erred in reversing the decree of the lower court in dissolving the injunction and in ordering the bill dismissed.

STANDARD PAINT COMPANY,
By JUDSON & GREEN, *Solicitors.*

(Endorsed:) No. 2621. Trinidad Asphalt Manufacturing Company, Appellant, vs. Standard Paint Company. Assignment of Errors on appeal to the Supreme Court of the United States. Filed Nov. 2, 1908, John D. Jordan, Clerk.

(Bond on Appeal to Supreme Court, U. S.)

And on the second day of November, A. D. 1908, a bond on appeal to the Supreme Court of the United States was filed in said cause, in the words and figures following, to-wit:

Know all men by these presents, That we, the Standard Paint Company and Frederick N. Judson are held and firmly bound unto —— —— in the full and just sum of One thousand and 00/100 ($1000.00) Dollars, to be paid to the said Trinidad Asphalt Manufacturing Company its successors, executors, administrators, or assigns: to which payment well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally by these presents.

Sealed with our seals, and dated this — day of October in the year of our Lord one thousand nine hundred and eight (1908).

Whereas, lately at the — term, A. D. 1908, of the Circuit Court of Appeals of the United States for the Eighth Circuit in a suit depending in said Court between the Standard Paint Company as Complainant and Appellee and the Trinidad Asphalt M'f'g Co. as
152 defendant and Appellant a judgment or decree was rendered against the Standard Paint Company ordering that its bill of complaint be dismissed and the said Standard Paint Company has obtained an appeal to the Supreme Court of the United States to reverse the said judgment and decree in the aforesaid suit, and a citation directed to the said Trinidad Asphalt Manufacturing Company citing and admonishing it to be and appear in the Supreme Court of the United States at Washington, D. C., thirty days from and after the date of said Citation.

Now the condition of the above obligation is such, That if the said Standard Paint Company shall prosecute said appeal to effect, and answer all damages and costs if it fail to make good its plea, then the above obligation to be void, else to remain in full force and virtue.

STANDARD PAINT COMPANY. [SEAL.]
By F. N. JUDSON, *Att'y.*

Sealed and delivered in Presence of
FREDERICK N. JUDSON. [SEAL.]
November 2, 1908.

Approved by

ELMER B. ADAMS,
Judge U. S. Circuit Court of Appeals for the Eighth Circuit.

(Endorsed:) No. 2621. United States Circuit Court of Appeals for the Eighth Circuit. Trinidal Asphalt Manufacturing Company, Appellant, vs. Standard Paint Company. Bond on Appeal to Supreme Court of the United States. Filed Nov. 2, 1908, John D. Jordan, Clerk.

(*Order Allowing Appeal to Supreme Court of the United States.*)

And on the second day of November, A. D. 1908, an order allowing an appeal to the Supreme Court of the United States was filed in said cause, in the words and figures following, to-wit:

153 United States Circuit Court of Appeals, Eighth Circuit.

No. 2621.

TRINIDAD ASPHALT MANUFACTURING COMPANY, Appellant,
vs.
STANDARD PAINT COMPANY.

Appeal from the Circuit Court of the United States for the Eastern District of Missouri.

Upon consideration of the petition of the Standard Paint Company for an appeal and the assignment of errors accompanying the same, it is ordered that an appeal to the Supreme Court of the United States, in this cause, be, and the same is hereby, allowed.

Dated, November 2, 1908.

ELMER B. ADAMS,
Judge of the United States Circuit Court of Appeals for the Eighth Circuit.

(Endorsed:) U. S. Circuit Court of Appeals, Eighth Circuit. September Term, 1908. No. 2621. Trinidad Asphalt Manufacturing Co., Appellant, vs. Standard Paint Company. Order allowlowing appeal to the Supreme Court of the United States. Filed Nov. 2, 1908. John D. Jordan, Clerk.

(*Citation on Appeal to Supreme Court of the United States.*)

And on the fifth day of November, A. D. 1908, a citation on appeal to the Supreme Court of the United States was filed in said cause, the original of which, with acknowledgment of service endorsed thereon, is hereto attached and herewith returned:

154 THE UNITED STATES OF AMERICA:

To Trinidad Asphalt Manufacturing Co., St. Louis, Mo., Greeting:

You are hereby cited and admonished to be and appear in the Supreme Court of the United States, at the City of Washington, D. C., thirty days from and after the day this Citation bears date, pursuant to an appeal filed in the Clerk's office of the United States Circuit Court of Appeals for the Eighth Circuit, wherein the Standard Paint Company is appellant and you are appellee, to show cause, if any there be, why the decree rendered against the said appellant, as in said appeal mentioned, should not be corrected, and why speedy justice should not be done the parties in that behalf.

Witness, the Honorable Elmer B. Adams, Judge of the United States Circuit Court of Appeals for the Eighth Circuit, this 2nd day of November, in the year of our Lord one thousand nine hundred and eight.

ELMER B. ADAMS,
Judge of the United States Circuit Court of Appeals for the Eighth Circuit.

Received copy of the above citation this 5th day of November, 1908.

W. B. HOMER,
Att'y for Trinidad Asphalt Mfg. Co.

[Endorsed:] No. —. United States Supreme Court, October Term, 1908. Standard Paint Company, Appellant, vs. Trinidad Asphalt Manufacturing Company. Citation on Appeal. Filed Nov. 5, 1908. John D. Jordan, Clerk.

155 (*Clerk's Certificate.*)

United States Circuit Court of Appeals, Eighth Circuit.

I, John D. Jordan, Clerk of the United States Circuit Court of Appeals for the Eighth Circuit, do hereby certify that the foregoing transcript contains full, true and complete copies of all the pleadings, record entries and proceedings, including the opinion of said United States Circuit Court of Appeals, in a certain cause in said Court wherein the Trinidad Asphalt Manufacturing Company was Appellant, and the Standard Paint Company was Appellee, No. 2621, as full, true and complete as the same remain on file and of record in my office.

I do further certify that the original citation, with the acknowledgment of service endorsed thereon, is hereto attached and herewith returned.

I do further certify that on the thirteenth day of October, A. D. 1908, a mandate was issued out of said United States Circuit Court of Appeals in said cause directed to the Judges of the Circuit Court of the United States for the Eastern District of Missouri.

In Testimony Whereof, I hereunto subscribe my name and affix the seal of said United States Circuit Court of Appeals for the Eighth Circuit, at office in the City of St. Louis, Missouri, this twenty-first day of November, A. D. 1908.

[Seal United States Circuit Court of Appeals, Eighth Circuit.]

JOHN D. JORDAN,
Clerk of the United States Circuit Court of Appeals for the Eighth Circuit.

Endorsed on cover: File No. 21,425. U. S. Circuit Court Appeals, 8th Circuit. Term No. 106. Standard Paint Company, appellant, vs. Trinidad Asphalt Manufacturing Company. Filed November 27th, 1908. File No. 21,425.

Office Supreme Court, U. S.
FILED.
MAR 3 1911
JAMES H. McKENNEY,
CLERK.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1910.

STANDARD PAINT COMPANY,
Appellant,
vs.
TRINIDAD ASPHALT MFG. CO.,
Appellee.
No. 106.

APPEAL FROM THE UNITED STATES CIRCUIT COURT OF APPEALS, FOR THE EIGHTH CIRCUIT.

Statement, Brief and Argument for Appellant.

FREDERICK N. JUDSON and
JOHN F. GREEN,
Counsel for Appellant.

St. Louis Law Printing Co., Printers' Building, 9th & Walnut. Main 1818.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1910.

STANDARD PAINT COMPANY,
Appellant,
vs.
TRINIDAD ASPHALT MFG. CO.,
Appellee.
No. 106.

APPEAL FROM THE UNITED STATES CIRCUIT COURT OF APPEALS, FOR THE EIGHTH CIRCUIT.

Statement, Brief and Argument for Appellant.

STATEMENT.

This is a suit in equity, brought by the Standard Paint Company, a corporation organized under the laws of the State of West Virginia, and having its principal office at Bound Brook, in the State of New Jersey, against the Trinidad Asphalt Manufacturing Company, a corporation incorporated under the laws of the State of Missouri, doing business in the City of St. Louis.

The bill of complaint, except the prayer for relief, is in the following words:

"The Standard Paint Company, a corporation organized under the laws of the State of West Virginia, and a citizen of said State, and having its principal office and factory at Bound Brook, in the State of New Jersey, brings this bill of complaint against the Trinidad Asphalt Manufacturing Company, a corporation duly organized under the laws of the State of Missouri, with its principal office in the City of St. Louis, in said State, and thereupon your orator complains and says:

First. That your orator for more than twelve (12) years has been and is now engaged in the business of manufacturing, vending, exporting and otherwise dealing in a certain kind of roofing material for covering houses and other buildings, called by them 'Ruberoid' roofing, **but said roofing has no rubber whatsoever in its composition,** and complainants have advertised said roofing very extensively under the said name 'Ruberoid' roofing, and have built up a large and valuable trade therein in all parts of the United States and in foreign countries, and more than twelve years since complainant adopted as a trade-mark and trade-name for said roofing the word 'Ruberoid' and has ever since been using said word as a trade-mark and trade-name for said product.

Second. Said roofing is manufactured by this complainant in three different thicknesses called one (1), two (2) and three (3) ply roofing, according to the thickness thereof, is then cut and made up into rolls, the strips of roofing on each roll being about three feet in width and about seventy feet in length, and these rolls are then covered with paper wrappers, on which are printed in large type the words 'RUBEROID

ROOFING', and enclosed therein directions for handling and laying the same, and the name of the complainant company as manufacturers.

Third. Complainant further says that for more than twelve years past it has been and now is engaged in advertising said roofing by preparing samples thereof in the form hereto attached and made part hereof as Exhibit 'A', on the covers of which are printed in large type the word 'Ruberoid', followed by the words 'Trade-Mark Registered', 1, 2 and 3 ply Ruberoid Roofing in rolls 36 inches wide, containing 216 square feet, which are sold as 200 square feet, etc.

Fourth. Complainant's said trade-mark 'Ruberoid' was duly registered in the Patent Office at Washington, D. C., on the 28th day of May, 1901, under the provisions of the statutes of the United States in such cases made and provided, a copy of said certificate of registration being hereto attached as Exhibit 'C' and made part hereof. That by reason of the long experience and great care used by complainant in manufacturing said 'Ruberoid' roofing, and by reason of the good and durable quality thereof, distinguished as it has been by its trade-mark and trade-name 'Ruberoid' and the form and shape of the rolls into which it is made by complainant, and the samples thereof used by complainant in advertising the same, said roofing material has become widely and favorably known throughout all the United States and in many foreign countries, as a useful, durable, economical and valuable roofing material and has acquired a high reputation as such and has commanded and still commands an extensive sale throughout the United States and foreign countries, and its manufacture and sale has been and is a source of great profit

to complainant. That said trade-mark and trade-name are of a value of over two thousand dollars.

Fifth. Complainant states that notwithstanding the long and quiet use and enjoyment by it of said trade-mark and trade-name of 'Ruberoid' and of the form and descriptive matter of said packages, wrappers and labels and of the form of the sample packages above referred to, and the descriptive matter printed thereon, the defendant well knowing the premises and with the preconceived intention to injure the complainant, and with the purpose to defraud and with the purpose to deprive this complainant of the benefits and profits resulting from the great reputation acquired by complainant's said roofing, and the consequent demand therefor, and with the intent to acquire for themselves the benefits and profits of said reputation, and in wilful disregard of complainant's right in the premises, has been since the 18th day of January, 1900, and is now engaged in manufacturing, advertising for sale and selling to the general public in the City of St. Louis, Missouri, and elsewhere throughout the United States, a roofing material similar in appearance to that made by complainant, under the name of 'RubberO' roofing, which roofing is cut by defendant into widths and made into rolls similar in form to those made by complainant for its product, making similar thicknesses of said material and using the same terms, to-wit, '1, 2 and 3 ply' to describe these various thicknesses thereof, and which rolls are also wrapped in paper when completed, on which wrappers defendant places labels bearing in large type the words 'Rubbero Roofing', followed by the name of the manufacturer and directions for handling and using the same; and defendant also advertises its roofing product by sending out to prospective pur-

chasers samples thereof prepared in the form and bearing the printed matter thereon shown by Exhibit 'B', hereto attached and made part hereof, being very similar in form and printed matter thereon to the samples prepared and sent out by complainant as aforesaid. And complainant says that defendant uses said name 'Rubbero' to describe its roofing product because of its close resemblance and similarity to the name and trade-mark 'Ruberoid', adopted and used by complainant for its roofing material, in order to deceive the public and the buyers and consumers thereof, and in order to lead them to believe that said roofing manufactured by defendant is the 'Ruberoid' roofing made by complainant; and complainant says that the public has been thereby deceived, and a large amount of said roofing so manufactured and advertised by defendant has been purchased and used by consumers under the mistaken belief that it was the 'Ruberoid' roofing manufactured made by complainant.

Sixth. That by reason of the use of the said word **'Rubbero'** by defendant as a name for and to describe its said roofing material, and employment by it of the aforesaid methods of preparing and advertising the same, the business of complainants has been greatly damaged and injured and its profits have been largely reduced, and the excellent reputation of its rofing has been injured or destroyed." (Rec., pp. 1 to 6.)

The prayer for relief is for an injunction and an accounting for profits and damages, etc. (Rec., p. 6).

ANSWER.

The defendant's amended answer admits that it is a corporation organized under the laws of the State of Missouri, and that its principal office is in St. Louis, Missouri (Rec., p. 8); admits that it is engaged largely

in selling and advertising to the general public in the City of St. Louis and elsewhere a roofing under the trade-mark and trade-name of "RubberO" roofing; admits that the roofings of complainant and defendant are both cut into widths and made into rolls similar in form and appearance, and denies on information and belief the other allegations of complainant's bill.

The answer further alleges and sets up as defenses the following facts: That the trade-mark **"RubberO"**, used by it for its roofing, is so dissimilar from complainant's alleged trade-mark of **"Ruberoid"** that the public could not be, and never has been, deceived thereby; that many other manufacturers have for years made prepared roofings which are similar in appearance to those made by both complainant and defendant, and have sold them under such names as "Compo-Rubber Roofing", "Miko-Rubber Roofing", "Vulcanite Rubber Roofing", "Pioneer Rubber Roofing", "Paroid Rubber Roofing", "Indruoid Rubber Roofing", "Perfection Rubber Roofing", "Flintcote Rubber Roofing", "Original Rubber Roofing" and "Lasticite Roofing"; that none of said roofings are made from India rubber, but that they all have resemblance to and appearance of rubber; that the word **"Ruberoid"**, spelled **"Rubberoid"**, was in use long prior to the use thereof by complainant, and as early as 1878, by the Rubberoid Company of Bristol and Philadelphia, Pennsylvania, as a name for a gum which was manufactured and sold by that company under letters patent of the United States, issued to one Clark, and that said company had also registered in the Patent Office at Washington, in 1878, as a trade-mark and name for said product, the word "Rubberoid"; that there was also registered in the Patent Office

at Washington, in 1884, by the firm of James D. Frary & Son Company the word "**Rubberoid**", as a trade-mark or trade-name for a composition which was used as a substitute for hard rubber; that the word, "**Ruberoid**", is merely a misspelling of the word, "**Rubberoid**", which means like rubber, and that this word is descriptive of the qualities of complainant's product and was adopted by it as a name because of that fact; and defendant further alleged that it had caused its trade-mark, "**RubberO**", to be registered in 1904, in the office of the Secretary of State for the State of Missouri (Rec., pp. 8, 9, 10 and 11).

FACTS.

The essential facts of this case are few, and they were all established by uncontradicted evidence. They are as follows:

Complainant is a corporation organized under the laws of West Virginia, having its factory and principal offices at Bound Brook, New Jersey.

The defendant is a corporation organized under the laws of Missouri, having its office at St. Louis; and it and complainant are, therefore, citizens of different states.

The complainant company adopted the word "**Ruberoid**" as a trade-name for the roofing manufactured by it, in 1891 (Rec., p. 14).

This roofing is manufactured by complainant from high-grade felt, which is saturated with a composition that complainant calls "**Ruberoid**", which composition is in liquid form, and is composed of a residuum of animal fats. It has no rubber among its ingredients. The roofing is made into sheets, and these are then cut up in widths suitable for rolls. Each standard roll

of roofing is thirty-six feet long and thirty-six inches wide, and they are covered with paper wrappers on which the name "Ruberoid", in very large type, is printed or stamped, followed by the words "trade-mark", together with complainant's name as the manufacturer, and directions for placing the material on buildings. This roofing is used as a covering for buildings, and for cars, cabs, etc. (Rec., pp. 17 and 24).

Complainant had used said word **"Ruberoid"** as a trade-name for its roofing product continuously from 1891 up to the time of the trial (Rec., p. 14). It was very extensively advertised under the name **"Ruberoid"**, was sold to the trade under that name, and had become generally known to the trade and to consumers by the name "Ruberoid" (Rec., pp. 14 and 15). The word **"Ruberoid"** had come to be known in the trade, and by general public, as the name for the roofing manufactured by the complainant company, and it was usually ordered and asked for by purchasers by the name of **"Ruberoid"** (Rec., pp. 14 and 15).

On the 28th day of May, 1901, complainant caused the said word **"Ruberoid"** to be registered in the Patent Office at Washington, under the Trade-Mark Statute of March 3, 1881, as a trade-mark and trade-name for its roofing (Rec., p. 97).

From the time complainant first adopted the word **"Ruberoid"** as a trade name, in 1891, down to the trial, this word had been used exclusively as the name for its prepared roofing; and it had always refused to supply this roofing under any other name. Letters intended for the complainant company were often addressed to the "Ruberoid Company" (Rec., p. 14).

Complainant had advertised its said roofing under the name **"Ruberoid"** in all the states of the Union

and in foreign countries. In 1900 it spent $19,000.00 in such advertising; in 1901, $20,000; in 1902, $22,000; in 1903, $25,000; in 1904, $35,000 (Rec., p. 15).

Its trade in said roofing had continually increased except in the territory where defendant has been marketing its "**RubberO**" roofing. In 1900 complainant marketed 100,000 rolls and received therefor $450,000; in 1901, 140,000 rolls for $550,000; in 1902, 190,000 rolls for $750,000; in 1903, 250,000 rolls for $950,000; in 1904, 260,000 rolls for $950,000 (Rec., p. 15). Complainant owns and operates a factory at Hamburg, Germany, for the manufacture of "**Ruberoid**" roofing. It employs in its factory, at Boundbrook, New Jersey, 160 persons; and for selling purposes it employs about 500 sub-agents in the United States, and about 200 in Europe. Prior to 1891, when the word "Ruberoid" was adopted by complainant as a trade name for its roofing, no other person or company had ever used that word as a name for **any roofing product** (Rec., pp. 16 and 17 and 32).

The value of complainant's trade-mark was more than $5,000.

When complainant, in 1901, applied at Washington for registration of the word "**Ruberoid**" as a trade-mark, it learned that a firm in Connecticut, under the name of James D. Frary & Son Company, had, in 1884, registered the word "**Rubberoid**" (spelled with two b's) as a name for a product manufactured by it, which resembled hard rubber and was used in making knife handles, brushes, combs and such articles (Rec., p. 38).

Complainant caused its attorney to purchase and obtain from the owner and assignee of the said registered trade-mark "**Rubberoid**" an assignment to the

complainant of all the right, title and interest of the said "James D. Frary & Son Co.", and their assignee and trustee in and to said trade-mark (Rec., pp. 38 and 56).

The evidence established that the trade-mark registered in the Patent Office of the United States, in 1878, by the corporation known as the "Rubberoid Company", of Bristol and Philadelphia, Pa., for the word **"Rubberoid"**, to be used as a name for a gum resembling India rubber, had in fact never been used at any time and had been abandoned by that company soon after its adoption, and the company had gone into liquidation long prior to the time of this trial; and said company had never at any time in its history manufactured any goods under the patented Clark process, referred to in defendant's answer; and it had never sold any goods under the name of **"Rubberoid"**, or used said registered trade-mark in any way after its registration in 1878 (Rec., pp. 57 and 58).

Complainant first heard of the **"RubberO"** roofing, manufactured by the defendant corporation, some time in 1904 or 1905. For several months prior to the time of the trial there had been a falling off in the sales of complainant's **"Ruberoid"** roofing throughout the territory in which the **"RubberO"** roofing was being sold by the defendant, although the sales of **"Ruberoid"** roofing in all other territory of the United States had been increasing during the same time. There had been a decrease of $8,000 in sales of **"Ruberoid"** in the territory contiguous to St. Louis, Missouri, in the last few months prior to the time of the trial, as compared with the same months in previous years (Rec., pp. 34 and 35).

Defendant corporation registered the word **"Rub-**

berO'' as a trade-mark in the office of the Secretary of State for the State of Missouri in 1904 (Rec., p. 117). It has never manufactured any roofing itself, but the roofing which defendant sells under the name of **"RubberO"** it receives from a manufacturing firm at Erie, Pa., by the name of A. H. F. Watson & Co. That roofing is manufactured and put up in rolls by said Watson & Co., at Erie, Pa., and then shipped to the defendant in St. Louis, where it is labeled and sold by defendant as **"RubberO"** roofing (Rec., pp. 41 and 52).

"Ruberoid" roofing had the reputation among jobbers and dealers of being a better roofing than "RubberO", and it was sold for a higher price (Rec., pp. 42 and 21).

The defendant sold its **"RubberO"** roofing in St. Louis and the State of Missouri, and in the surrounding States of Illinois, Kansas, Iowa, Arkansas, Oklahoma and to the Indian tribes of the Indian Territory, and it came into competition with complainant's roofing throughout all the territory included in complainant's St. Louis agency, which was in charge of the Graham Paper Company, at St. Louis, Mo. (Rec., pp. 44, 45 and 54).

Complainant's experts testified that the similarity between the words **"Ruberoid"** and **"RubberO"** were sufficient to deceive and mislead the ordinary purchaser; and the cross-examination of one of complainant's witnesses by defendant developed one specific instance in which a purchaser had mistaken defendant's product for that of complainant's because of the resemblance between the words **"Ruberoid"** and **"RubberO"** (Rec., p. 43). The advertising samples sent out by defendant company are similar in form

and general appearance to those sent out by the complainant, the only difference being that one is stamped with the word **"RubberO"**, while the other has the word **"Ruberoid"**; and each of them bears the names of their respective manufacturers.

Defendant's secretary and treasurer testified that the word **"RubberO"** was adopted as a trade name for its roofing product because it carried less resemblance to the word **"Ruberoid"** than any other word he could think of (Rec., p. 54).

Before complainant instituted this suit it wrote defendant calling its attention to complainant's registered trade-mark **Ruberoid**, and claiming that the word **"RubberO"**, as used by defendant, was an infringement, and requesting the discontinuance thereof (Rec., p. 60). Defendant answered, declining to accede to complainant's request (Rec., p. 61).

At the conclusion of the trial in the Circuit Court, Judge Finkelnburg rendered a decree in favor of the complainant, enjoining the defendant from using the word **"RubberO"** as a name for its roofing product, and directing an accounting by the defendant as to profits and damages, and filed the following findings of fact and opinion (Rec., p. 86):

> "Time will not permit me to write an opinion in full in this case, but I will briefly state some of the reasons which have led me to my final conclusion.
>
> I find from the record that the complainant company manufactured and put a roofing material on the market, in the year 1891, under the trade name, 'Ruberoid Roofing', and that this product has been manufactured and sold by the complainant company continuously under that name ever since that time, and that its sales have increased largely from year to year.

I further find that complainant company spent large sums of money in advertising its product under the name of 'Ruberoid Roofing', and that it is generally known to the trade and the public under that name, and is sold under that name by complainant in every state of the Union, as well as in foreign countries. I further find that while the word 'Rubberoid' (spelt with two b's) had been temporarily used by other parties, prior to 1891, for certain compositions, it had never been used in connection with or applied to roofing material.

I further find that in May, 1901, complainant caused its said trade name of 'Ruberoid' to be registered as a trade name for its roofing in the Patent Office at Washington. In the application for registration complainant states that: 'The said trade-mark consists in the arbitrary word, "Ruberoid". It is shown in the accompanying facsimile as printed in ordinary block capitals; but other forms of type may be employed and various characters and devices used in connection with the said trade-mark, without materially altering the character thereof, the essential feature which consists of the word "Ruberoid" '. The certificate issued by the Commissioner of Patents recites that applicant has complied with the Act of Congress of March 8th, 1881; that the said trade-mark has been duly registered May 20th, 1901, and that protection therefor will remain in force for thirty years from said date, unless sooner terminating in accordance with Section 5 of said Act.

I further find that in the year 1904 defendant began to advertise and sell roofing under the name of 'RubberO'. It appears that when defendant began using this name it was familiar with complainant's product and aware that complainant's product was extensively advertised and sold under the name of 'Ruberoid', and also knew, or ought to have known, that complainant had registered the word 'Ruberoid' as its trade-mark in the Patent Office at Washington. The Court further finds

that defendant's product is manufactured by a firm called Watson & Company, at Erie, Penn., and shipped by them to defendant at St. Louis, Mo., where defendant puts the labels on.

I further find that the roofing material sold by defendant under the name of 'RubberO Roofing' is put up in rolls of the same general character as complainant's product, and that this is the way most roofing material is put up, and these rolls contain about the same number of square feet; so that the general appearance of the packages or rolls is similar.

I am of opinion that the word 'Ruberoid', when applied to and used to designate the roofing product manufactured by complainant, is a valid trade-mark, and that registration thereof was duly and lawfully awarded by the Commissioner of Patents under the Act of March 8th, 1881.

I am further of opinion and find from the evidence that the words 'Ruberoid' and 'RubberO', when applied to packages of roofing material, similar in general size and appearance, are sufficiently alike to deceive the unwary or ordinary purchaser.

I am further of opinion that by adopting the name 'RubberO' in 1904, after complainant had used the word 'Ruberoid' for a period of thirteen years and built up an extensive trade under that name, and after that name had been registered in the Patent Office at Washington, defendant infringed on complainant's rights.

I do not think that the explanation given by the only officer of the defendant company who testified in this case, as quite satisfactory as to the reason for choosing a trade name in 1904, so close to the name used and registered by complainant. The range of names or words to choose from in matters of this kind is very great, and there is no necessity or excuse for choosing one so nearly alike one already appropriated by a competitor, as to involve any uncertainty and confusion in the mind of the general public, who do not analyze closely but act on general impressions. It is true that there is no imitation in the arrangement, color

or general appearance of the labels, as such, aside from the similarity of the names; but, I think the use of names so similar on rolls of similar size and shape, both containing roofing material, is calculated, whether intentionally or unintentionally, to confuse and deceive the public.

It is not necessary that the resemblance should be such as to deceive first or intelligent purchasers. It is sufficient if it be calculated to deceive the unwary, incautious or the ignorant purchaser. Neither need the resemblance be so great that one would be deceived who should see the labels placed side by side. If an ordinary purchaser, looking at the articles offered to him, would naturally be led, from the labels attached to it, to suppose it to be the product of a rival manufacturer, and to purchase it in that belief, the Court will enjoin the use of such article as fraudulent.' Cauffman v. Schuler. 123 Fed. 205, 206; and see Hesseltine on the Law of Trade-Marks, p. 239, and cases there cited.

It has been frequently held that courts do not consider whether a dealer will be confused, but whether a consumer will be. (National Biscuit Co. v. Baker, 95 Fed. 135). **But in this case complainant has shown that even a dealer in roofing was misled.**

My decision is that there should be a decree for a perpetual injunction and an accounting. Complainant's counsel may prepare a decree in accordance herewith and submit it to the Court."

From this decree the defendant appealed to the Circuit Court of Appeals of the Eighth Circuit, where the decree of the lower Court was reversed in an opinion written by Judge Hook and concurred in by Judge Adams, but from which Judge Sanborn dissented and wrote a vigorous dissenting opinion.

Complainant then applied for and was allowed an appeal to this court.

ASSIGNMENT OF ERRORS.

(1) The Circuit Court of Appeals erred in finding and holding that the complainant did not have a valid trade-mark in the word **"Ruberoid"**.

(2) The Circuit Court of Appeals erred in finding and holding that the word **"Ruberoid"** was so descriptive of the roofing product to which it was applied by complainant, that complainant could not have a valid trade-mark therein.

(3) The Circuit Court of Appeals erred in holding and finding that complainant was not entitled to the relief prayed for in its bill of complaint upon the distinct ground of "unfair trade", independently of its trade-mark.

(4) The Circuit Court of Appeals erred in reversing the decree of the lower Court, and in dissolving the injunction and ordering the bill dismissed.

(5) The Court of Appeals erred in not holding that the word **"RubberO"** was sufficiently similar to the word "Ruberoid" to deceive the ordinary purchaser and induce him to purchase the defendant's product under the belief that he was obtaining complainant's product

POINTS AND AUTHORITIES.

I.

Under the Federal Statutes, in force when complainant's trade-mark was registered, and when this action was instituted, this Court, upon this appeal, has jurisdiction of the entire case and should decide all the questions arising upon the record, because the bill of complaint presents a claim arising under a Federal Statute, in addition to alleging the diverse citizenship of the litigants.

Henningsen v. Fidelity Company, 208 U. S. 404;
Northern Pacific Ry. Co. v. Soderberg, 188 U. S. 526;
Pennsylvania Mutual Life Ins. Co. v. Austin, 168 U. S. 685;
Northern Pacific Railroad v. Amato, 144 U. S. 465;
Warner v. Searl & Hereth Co., 191 U. S. 195;
Section 6 of the Judiciary Act of March 3d, 1891;
Elgin Watch Co. v. Illinois Watch Co., 179 U. S. 665.

This case is unlike that of Hutchinson, Pierce & Co. v. Loewey, 217 U. S. 457, decided by this Court last May, so far as the question of jurisdiction is concerned, because it arises under the trade-mark **statue of 1881**, and the Court of Appeals, Act of March 3d, 1891, while the Hutchinson case arose under the trade-mark **statute of February, 1905**, which specifically provides that the judgment of the Circuit Court of Appeals in trade-mark cases arising under that act shall be final.

II.

The jurisdiction of this court, on this appeal, extends not merely to the determination of the question of a valid trade-mark in the word "Ruberoid", but it extends also to the determination of the question of whether complainant is not entitled to relief on the distinct ground of unfair trade and competition, irrespective of any question of a valid trade-mark registered under the Federal Statutes. Therefore, even if this Court should hold that complainant has no valid trade-mark in the word "Ruberoid" it must also determine whether complainant is not entitled to the relief prayed for upon the ground of unfair trade.

(Authorities cited undere Point I, *supra.*)
William Holder v. Aultman, Miller & Co., 169 U. S. 81.

This case is also unlike those of A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 201 U. S. 166, and Elgin Watch Co. v. Illinois Watch Co., 179 U. S. 665, in that we have in the case at bar both a **claim arising under a Federal Statute,** and also **diverse citizenship,** as separate and distinct grounds of Federal jurisdiction, while in those cases an alleged claim arising under a Federal Statute was the **sole ground of Federal jurisdiction.** Therefore, in the Leschen & Sons Rope Co. and the Elgin Watch Co. cases, when this Court had held that there was no **valid trade-mark entitled to registration** under the Federal Statutes, it necessarily followed that the lower Court had been wholly without jurisdiction to try the case in the first instance, because the litigants in those cases were citizens of the same state, and as the lower Court had been without jurisdiction to try the issue of "**unfair trade**", it followed, of course, that this

Court, on appeal, could not decide that issue. But, in the case at bar, the lower Court had full jurisdiction to try **both issues**, and this Court, therefore, has jurisdiction to determine both.

III.

The word "Ruberoid", as used by complainant to designate its roofing product, is a valid and proper trade-mark and trade name.

Menendez v. Holt, 128 U. S. 514;
Keasley v. Brooklyn Chemical Works, 142 N. Y. 467 (opinion by Mr. Justice Peckham);
Eastman Co., *Re* 15, R. P. C. 476 ("**Solio**" case).

IV.

The word "Ruberoid" is not descriptive of any qualities or properties of complainant's roofing or of any materials used in its manufacture. Within the meaning of the law it is an arbitrary or a fanciful term.

Menendez v. Holt, 128 U. S. 514; *l. c.* 520;
Saxlehner v. Eisner & Mendelson Co., 179 U. S. 19;
Wellcome v. Thompson & Capper, 1 L. R. Chancery, 1904, 736-744;
Reddaway v. Bentham, 13 R. P. C. 218.

V.

The word "Ruberoid" is suggestive merely, and not descriptive, as those terms have been defined in the law of trade-marks. If we assume that it is derived from the word "rubber", as held in the majority opinion of the Circuit Court of Appeals, and that with the suffix "oid" added thereto, it means like rubber, still this derivation and meaning would not render it so descriptive as to be incapable of appropriation as a trade name, because there is in fact no rubber

used in its composition, and its only resemblance to rubber is in respect of its flexibility and its being waterproof. It has not any of the most distinctive properties of rubber, such as elasticity or resiliency. Therefore, it is suggestive and not descriptive, in any view which may be taken of its origin and derivation.

Menendez v. Holt, 128 U. S. 514;
Dissenting Opinion of Justice Sanborn, Rec., pp. 97 to 108;
Keasby v. Brooklyn Chemical Works, 142 N. Y. 467; opinion of Judge Peckham;
Wellcome v. Thompson & Capper, 1 L. R. Chancery Divisions, 1904, pp. 736, 744.

See also:

"Pepto-Mangan" case, 131 Fed. 160, 2d Circuit;
"Elastic" book case, 121 Fed. 185, 3d Circuit;
"Eureka" rubber case, 60 Atl. Rep. 561;
"Club" whiskey case, 125 Fed. 782, 1st Circuit;
"Uneeda" biscuit case, 95 Fed. Rep. 135, 2d Circuit;
"Anti-Washboard" soap case, 26 Fed. 576, 6th Circuit;
"Swan-Down" complexion powder case, 85 Fed. 774;
"Bovril" beef extract case, 2 L. R. Chancery Div., 1898, 600;
"Camel's Hair" belting case, 13 R. P. C. 218.

If the nine words last above referred to were not so descriptive of the properties of the articles to which they were applied as to prevent their appropriation as trade names, then, *a fortiori*, is "Ruberoid" not so descriptive of complainant's roofing as to prevent its being appropriated as a trade name.

A.

Illustrations of Particular Cases.

The following is a list of some additional words which have been held to be valid trade-marks, and also held to have been infringed by the use of certain similar words, the said words and their infringements being arranged in parallel columns:

Trade-mark:	Held to be infringed by:
"Cottolene"	"Cottoleo"
See 64 Fed. Rep. 133.	
"Dyspepticure"	"Dyspepticide"
See 87 Offi. Gazette 541.	
"German"	"Germania"
See 77 Fed. Rep. 181.	
"Gold Dust"	"Gold Drop"
See 102 Fed. Rep. 372.	
"Momaja"	"Mojava"
See 68 Fed. Rep. 539.	
"Moxie Nerve Food"	"Standard Nerve Food"
See 32 Fed. 205.	
"Stark"	"Star"
See Fed. Case No. 5221.	
"Uneeda"	"Iwanta"
See 98 Fed. Rep. 135.	

VI.

But, wholly irrespective of the question of complainant's right to appropriate this word as a trade name in the first instance, it is entitled to the relief prayed for, on the distinct ground of unfair trade and competition.

Coates v. Merrick Thread Co., 149 U. S. 562;
Florence Mfg. Co. v. J. C. Dowd & Co., 178 Fed. 73;
Elgin Nat'l Watch Co. v. Illinois Watch Case Co., 179 U. S. 665, and English cases cited with approval by Chief Justice Fuller;

Wolff Bros. v. Hamilton Brown Shoe Co., 165 Fed. 413 (concurred in by Judge Vandevanter);
Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537;
Cleveland Stone Co. v. Wallace, 52 Fed. 431;
Pillsbury Mills Co. v. Eagle, 86 Fed. 608.

VII.

The evidence clearly indicates that defendant adopted and has used the word "RubberO" only because of its similarity to the word "Ruberoid", in order to enable it to obtain the benefit of the advertising done by complainant in its territory and to sell its product to purchasers under the belief on their part that they are purchasing the product of complainant.

Opinion of Judge Finkelnburg, Rec., p. 86.

Such conduct is unfair and fraudulent and should be enjoined.

Bates Manufacturing Co. v. Bates Numbering Machine Co., 172 Fed. 892;
American Lead Pencil Co. v. Gottlieb & Sons, 181 Fed. 178.

VIII

Even if the evidence did not indicate such fraudulent purpose on the part of the defendant in adopting the trade name of "RubberO", complainant would still be entitled to the relief prayed for, irrespective of any fraudulent intention on the part of the defendant, because there is sufficient similarity between the words "Ruberoid" and "RubberO" to mislead the ordinary purchaser.

Soxlehner v. Eisner & Mendelson, 179 U. S. 19;
Eagle White Lead Co. v. Pfleugh, 180 Fed. 579;

Soxlehner v. Siegel, Cooper & Co., 179 U. S. 41;
Elgin Co. v. Illinois Co., 179 U. S. 665;
Reddaway v. Benthan, 9 R. P. C. 503.

IX.

The word "Ruberoid" had been so long used, and so exclusively appropriated, by complainant as a name for its roofing material that it had come to signify to the roofing trade the product of complainant exclusively; that is, the word "Ruberoid" had acquired a "secondary" meaning, and therefore, on this ground also, complainant was entitled to the relief prayed for.

Elgin Nat'l Watch Co. v. Elgin Watch Case Co., 179 U. S. 665;
Lowe Bros. Co. v. Toledo Varnish Co., 168 Fed. 627 (opinion by Judge Lurton);
American Lead Pencil Co. v. Gottlieb, 181 Fed. 178;
Gustaviano Co. v. Comerma, 180 Fed. 920.

ARGUMENT.

I.

The bill distinctly alleges that complainant is the owner of a valid trade-mark in the word "**Ruberoid**", as a name for prepared roofing, under the Act of Congress respecting trade-marks, of March 3d, 1881, and avers its registration in the Patent Office at Washington, in accordance with the provisions of that act, and that the trade-mark so registered was used by complainant both in interstate and foreign commerce. It also avers that the defendant has infringed complainant's rights in said registered trade-mark, by the use of the word "**RubberO**", as a trade-mark and trade name for a similar roofing product, which it sells at St. Louis, Missouri, and in the adjoining states and territories.

The evidence fully established all of these allegations and showed a large decrease in the sales of complainant's product, through the sale of defendant's competing product, under the name of "**RubberO**", at St. Louis, Missouri, and in the adjoining States of Illinois, Kentucky, Tennessee, Kansas, Arkansas, and in Oklahoma and Indian Territories.

The Judiciary Act of March 3d, 1891 (Section 6), specifies in what cases the decisions of the Circuits of Appeal shall be final, and provides that their decisions shall be final in cases where the **jurisdiction is dependent entirely upon** the parties being aliens or citizens of different states, and in cases arising under the **patent laws,** under the revenue laws, the criminal laws and in admiralty cases. Said section then provides that in **all other cases there shall be a right of appeal,**

or **writ of error to have the case reviewed by the Supreme Court of the United States**, where the amount in controversy shall exceed one thousand dollars, as it does in this case.

Clearly, therefore, the complainant, under the allegations of its bill and the evidence in the record, had the right of appeal to this court from the judgment and decree of the Circuit Court of Appeals.

The recent decision of this Court in the case of Hutchinson, Pierce & Co. v. Loewey, 217 U. S. 457, does not militate against this contention, because the trade-mark in issue in that case had been registered under the trade-mark statute, of February, 1905, which statute specifically provides that the judgments of the Circuit Courts of Appeal in trade-mark cases, arising under that act, shall be final.

Complainant's rights or claims, as alleged in its bill of complaint and established by the evidence, arose under an entirely different statute with different provisions.

The jurisdiction of this court, on this appeal, also extends to the entire case and to every question raised by the record. This is so because the lower courts had jurisdiction of the case on the double ground of rights arising under Federal Statutes, and of diverse citizenship. This Court must decide the question of fraud and unfair competition by defendant, even though it should be of the opinion that complainant did not have a valid trade-mark in the word "**Ruberoid**", which was entitled to registration under the Federal Statute, because the jurisdiction of the trial Court would not have been terminated upon its reaching that conclusion; but the allegations as to diverse citizenship gave complainant the right to have the Federal Courts try

its allegations of fraud and unfair competition, even though it had failed to prove any valid claim under a Federal Statute.

This court, having jurisdiction of the appeal, has the same power and duty to pass upon every question in the case which the Circuit Court of Appeals had when the appeal was pending in that court.

See cases cited under Points I and II of brief.

In the cases of Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 201 U. S. 166, and Elgin Watch Co. v. Ills. Watch Co., 179 U. S. 665, the jurisdiction of the lower courts had been dependent solely upon the claim of a trade-mark under the Federal Statutes. There was no **diverse citizenship in those cases.** Consequently in those cases the **Court of Appeals** lost its jurisdiction to proceed further just as soon as it decided that complainant had no valid claim under a Federal Statute. The **Court of Appeals,** in those cases, could not pass upon the claim of unfair trade and competition because there was no diverse citizenship; and therefore this court, on appeal to it, had no more extended jurisdiction and could pass upon no more questions, than could the Circuit Court of Appeals.

II.

But we do not believe it will be necessary for this Court to determine this last question of the **extent** of its jurisdiction, because we think it is clear that complainant, under the evidence, has a valid trade-mark in the word **"Ruberoid"**.

In support of the claim to a valid trade-mark, we quote here in full the able argument and dissenting opinion of Judge Sanborn, because it is more convinc-

ing than any we might write. Upon the question of trade-mark it is as follows:

> "In 1891, the complainant commenced to manufacture a roofing to which it applied the trade name 'Ruberoid'. Its officers and agents pronounce this word ru-ber-oid. Neither this word nor the word rubberoid had ever been used to designate or describe this or any other roofing, at that time. In 1901 the complainant registered this word 'Ruberoid' as its trade-mark. It advertised and promoted the sale of its ruberoid until its sales in the year 1904 amounted to $950,000; its roofing was known, ordered and sold throughout the United States and foreign countries by the name, 'Ruberoid', and that word had come to mean in the trade the origin and the ownership of the roofing. Thereupon, the defendant, in 1904, commenced to make and sell a similar roofing under the name of 'RubberO', and the complainant's sales decreased $8,000 in the territory where the later article was sold, and nowhere else.
>
> The Circuit Court was of the opinion that the word 'Ruberoid' was a valid trade-mark; that the defendant infringed upon it and was guilty of unfair competition, and it enjoined the use of the word 'RubberO' in competition with the complainant's product. The findings and conclusion of the Chancellor, in cases of conflicting evidence, prevail unless it clearly appears that he has fallen into an error of law or a plain mistake of fact, and I find myself unable to concur in the view of the majority that the Court below was guilty of either.
>
> The striking similarity between the words 'RubberO' and 'Ruberoid', the many dissimilar names open to the defendant, the long and established reputation and extensive sales of complainant's 'Ruberoid', the evident probability and the evidence of confusion of the trade by the use of the word 'RubberO' and the decrease of complainant's sales after the defendant commenced to use it, leave no doubt in my mind that the Court below was right in its conclusion that the purposes of

the conception and use of the word 'RubberO' by the defendant was to palm off its product as that of the complainant, and that it has been accomplishing its purpose.

The arguments in support of the position that the defendant has the equitable right to palm off its roofing as the ruberoid roofing of the complainant, by the use of the word 'RubberO', as I understand them, are substantially these: (1) That the word 'Ruberoid' is substantially identical with the word 'Rubberoid'; that the word 'Rubberoid' is a public hertiage, incapable of monopolization as a trade-mark, hence that the word 'Ruberoid' is so, and the defendant is entitled in equity to take the complainant's trade in its ruberoid roofing by the use of the word 'RubberO'; (2) that the word 'Ruberoid' is descriptive; that it cannot become a trade-mark, and hence the defendant may use the word 'RubberO' to sell its goods as the rubberoid of the complainant; (3) that the word 'Ruberoid' is a generic term and hence the defendant may use the word 'RubberO' to sell its goods as the ruberoid of the complainant; (4) that the complainant does not palm off its goods as the goods of the complainant by the simulation of the dress of complainant's goods or by any other means than the use of the word 'RubberO', and hence it should be permitted to use the word 'RubberO'; (5) that if the defendant is enjoined from using the word 'RubberO' other manufacturers could not be logically permitted to call their products 'Rubber Roofing' or 'Ruberoid Roofing', and hence the defendant should be permitted to use the word 'RubberO' to take from the complainant its trade in ruberoid roofing; (6) that where a manufacturer of a patented product has made his trade name the generic name of his manufacture, during the term of his patent, as in Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 178, 186, 189, 201, 204, and the Castoria case, Centaur Co. v. Heinsfurter, 84 Fed. 995, other manufacturers of the same product may use this generic name on condition that they clearly make known

to purchasers that it is not the manufacturer of the original patentee, hence the defendant may use the word 'RubberO' to sell its goods as the 'Ruberoid' of the complainant, notwithstanding the fact that the complainant's manufacture was never patented and the word 'Ruberoid' has always remained the designation of its particular product and never became the generic name of rubber roofing. Some of the reasons why these contentions have not proved persuasive to me, are these:

(1) When the complainant adopted the word 'Ruberoid' as its trade-mark in the year 1891, and before it taught the public and the trade, by its advertisements and sales, that this word meant its particular make of rubber roofing, this word 'Ruberoid' was not, in my opinion, substantially identical with, but was distinctive from, the word 'Rubberoid'. It was not pronounced and did not sound the same. 'Ru-ber-oid' sounds as different from **'Rubberoid'** as ruble from rubble. It was not spelled in the same way, and when written or printed it had a strikingly different appearance. There is no more striking method of differentiating words than by changing the spelling. Witness uneeda in contrast with youneeda. The absence of a single letter destroys the identity and the similarity of appearance and signification of many words. Tough is not trough; cow is not crow; rob is not robe; robin is not robbin; robing is not robbing, ruble is not rubble, and ru-ber-oid is not rubberoid. The root of ruberoid is ~~rubber,~~ to be red, and some of its derivatives are rubify, rubific, rubescent, rubicund, rubidity. The root of rubberoid is rub, to apply pressure with motion. Caoutchouc acquired the name rubber because it was first used to erase pencil marks by rubbing. 'Ruberoid' did not have and never has had the same meaning as rubberoid. The generic name of the product of the complainant, of that of the defendant and of those of more than thirty other manufacturers, is rubber roofing. Some of the trade-marks of the products of specific manu-

facturers of this rubber roofing are 'Ruberoid', 'Paroid', 'Indruroid', 'Lasticite', 'Perfection', 'Galvanized', 'Original'. The evidence in the record in hand is clear and uncontradicted that the word 'Ruberoid' signified nothing to those who first saw and heard it until the complainant taught the trade that it meant its specific manufacture of rubber roofing, and that this word has never become the generic name of such roofing, which has always continued to be rubber roofing, nor has it ever signified anything but the origin and ownership of the complainant's particular product. The evidence is also undisputed that the word 'Rubberoid' has never signified any kind of rubber roofing. Its definition in the Century dictionary is 'a trade name for an imitation of hard rubber', and it has signified solid articles like the handles of knives and forks, but never felt saturated with the residuum of animal fats or any other soft or flexible roofing. The facts of this case, therefore, neither prove nor indicate to my mind that the complainant sought to appropriate the exclusive, or any, use of the word 'Rubberoid' by its adoption of the word 'Ruberoid' as its trade-mark, and they equally fail to show in my opinion that a public right in 'Rubberoid' and a private right in 'Ruberoid' may not lawfully co-exist. On the other hand, they seem to me to show conclusively that if the word 'Rubberoid' was a public heritage and incapable of monopolization, the word 'Ruberoid' was not of that character, but was a fanciful term coined by the complainant, and its appropriation and use as a trade-mark in no way inpinged upon the free use by the public of the word 'Rubberoid', and this because the former word never had the same sound, nor the same spelling, nor the same appearance, nor the same meaning as the latter, but was a new and fanciful term coined and used to mark a particular product, which has never yet fallen within the meaning of the word 'Rubberoid'.

Moreover, the defendant does not use the word 'Rubberoid', and the question here is not whether

it may avail itself of the common heritage in that word and its meaning but whether or not it has a right to coin and use the fanciful word 'RubberO', to palm off its goods as those of the complainant, a right which is superior in equity to the right of the complainant to enjoin and prevent the perpetration of such a wrong.

(2) Is the defendant entitled to the use of the word 'RubberO' to sell its goods as the ruberoid of the complainant, because the word 'Ruberoid' is descriptive and for that reason not subject to monopolization as a trade-mark? The question is not whether or not the word 'Ruberoid', described the complainant's roofing in 1904, when the defendant sought to appropriate its trade by the use of the word 'RubberO', nor is it whether or not this word 'Ruberoid' describes the complainant's product now, but it is whether or not it so clearly described it, or its qualities, or its characteristics, at the time it was first adopted, that it would have been recognized at that time by men of ordinary experience in the trade upon seeing or hearing the word for the first time. Wellcome v. Thompson Capper, 1 L. R. Chan. Div., 1904, pages 736, 742, 749, 750, 754; Keasbey v. Chemical Works, 142 N. Y., 467, 471, 474, 475, 476.

Again, words are disqualified for trade-marks only when they are so accurately descriptive of the qualities, ingredients and characteristics of the articles that the latter would be recognized by men of ordinary intelligence upon seeing or hearing the words when first applied. Keasbey v. Chemical Works, 142 N. Y. 467, *supra*. Of this nature are the words adjudicated in the cases cited by the majority, 'Lackawanna' as a description of the valley of that name, whence Lackawanna coal was derived; Canal Company v. Clark, 13 Wall. 311, 323; 'Goodyear Rubber', used after, as the Supreme Court said, these words had become 'terms descriptive of well-known classes of goods produced by the process known as "Goodyear's Invention" ', Goodyear Company v. Goodyear Rubber Company, 128 U. S. 598, 602; 'Iron Bitters', in

a case in which the word iron was accurately descriptive of the distinctive ingredient of the bitters, Brown Chemical Company v. Meyer, 139 U. S. 540. But words which are merely suggestive of the qualities, ingredients or characteristics of the articles to which they are applied, but do not so accurately describe them that men of ordinary intelligence would have recognized them upon seeing or hearing the words when first applied, constitute valid trade-marks. Thus, 'Tabloid' is a good trade-mark although it suggests a similarity to tablet and table, and it was applied to a troche in the form of a tablet. Wellcome v. Thompson & Capper, 1 L. R. Chancery Division, 1904, pp. 736, 744. The argument was urged in that case that when 'Tabloid' was first used, the words 'Tabella', 'Table' and 'Tablet' were in common use, that the suffix 'oid' meant 'like' or 'allied to' or 'in form of', and hence that 'Tabloid' described an article like a table or a tablet. But the test applied by the judges was, did the word 'tabloid' really intelligently describe the thing sold under that name when it was first applied to it in the year 1884? They held that it did not, and sustained the trade-mark.

Byrne, J., at page 744, said: 'I come to the conclusion that in March, 1884, the word was not really intelligibly describing the thing sold' which is the way in which Lindley, L. J., in 'Bovril's' case (1) (1886) 2 Ch. 607, puts the form of direction to the jury. I agree that there is a suggestion or atmosphere of description about the word as then used, but I do not think that it can be said to have been other than a fancy word, as applied to goods in the class to which it was registered".

'Bromo-Caffeine' applied to a medicinal preparation composed of caffeine, bromide of potassium and other ingredients, is a good trade-mark, although caffeine was a well-known article and bromo certainly suggested a bromide much more clearly than ruberoid suggested rubber. Keasbey v. Brooklyn Chemical Works, 142 N. Y. 467, 471, 474, 475, 476. The opinion in that case was

written by Judge Peckham, now Mr. Justice Peckham of the Supreme Court, and he stated and applied the rule that a word, though suggestive of form, character or quality, was not disqualified for a trade-mark unless it described the article when it was first applied to it, so that its character, qualities or ingredients would be recognized by a man of ordinary intelligence at that time upon seeing or hearing the word. Caffeine was a well-known article, and the decision turned on the word 'Bromo'. Judge Peckham said: 'The word could only be said to inform one of the fact that bromine or some kind of bromide had entered into and formed part of the compound, but upon the question whether it was bromine or one of the many different kinds of bromides, the word "Bromo" would give no knowledge whatever. A name which furnishes no information on this point cannot be said to be so far descriptive in its nature as to prevent its adoption as a trade-mark so far as this question is concerned.'

'Cottolene' applied to a substance composed of cotton-seed oil and the product of beef fat may be monopolized as a trade-mark. Why may not ruberoid, which is not composed of any form or extract of rubber? The Court said: 'It seems clear that "cottolene" is a proper and valid trade-mark. Although it may suggest cotton-seed oil, it is not sufficiently descriptive to render it invalid as a trade-mark, under the recent decisions' N. K. Fairbank Co. v. Central Lard Co., 64 Fed. 133, 134. Under this rule, trade-marks have been sustained in 'Cocoaine' (Burnett v. Phalon, 9 Bosw. 192); 'Maizena' (Manufacturing Co. v. Ludeling, 22 Fed. 823); 'Valvoline' (Leonard v. Lubricator, 38 Fed. 922); 'Bromidia' (Battle v. Finlay, 45 Fed. 796); 'Elastic', when applied to bookcases (Globe-Wernicke Co. v. Brown, 121 Fed. 185, 186); 'German Sweet Chocolate' (Walter Baker & Co. v. Baker, 77 Fed. 181, 187, 188); 'Anti-Washboard' (O'Rourke v. Central City Soap Co., 26 Fed. 576, 578); 'No-to-bac' (Sterling Remedy Co. v. Eureka Chemical & Mfg. Co., 80 Fed. 105);

'Swan-Down', applied to a complexion powder (Tetlow v. Tappan, 85 Fed. 774); 'Silicon' and 'Electro-silicon', applied to an article one of whose component parts was 'Silicon' (Electro-Silicon Co. v. Hazard, 29 Hun. 369); 'Celery Compound' (Wells & Richardson Co. v. Siegel, Cooper & Co., 106 Fed. 77); 'Cream' (Price Baking Powder Co. v. Fyfe, 45 Fed. 799); 'Lightning', applied to hay-knives (Hiram Holt Co. v. Wadsworth, 41 Fed. 34); 'Maryland Club', applied to whiskey (Cahn v. Gottschalk, 2 N. Y. Supp. 13); 'Cough Cherries' (Stoughton v. Woodward, 39 Fed. 902); 'Sliced Animals', 'Sliced Birds', 'Sliced Objects', applied to dissected puzzle pictures (Selchow v. Baker, 93 N. Y. 59); 'Saponifier' (Pennsylvania Salt Mfg. Co. v. Meyers, 79 Fed. 87); 'Insurance Oil' (Ins. Oil Tank Co. v. Scott, 33 La. An. 946); 'Congress Water' and 'Congres Spring' (Congress and Empire Spring Co. v. High Rock Congress Spring Co., 45 N. Y. 291); 'Magnetic Balm', applied to a medicine (Smith v. Sixbury, 25 Hun. 232), and in numberless suggestive words and terms which failed to accurately describe the articles.

We may argue, now, seventeen years after the event, that ruber means rubber and oid means like, and hence 'Ruberoid' means like rubber; but there is no evidence in the record in this case that the word 'Ruberoid' or the word 'Rubberoid' had ever been applied to any kind of rubber roofing, or that either of them had ever meant felt saturated with the residuum of animal fats, before the complainant selected 'Ruberoid' as its trade-mark in 1891, and applied it to its product.

There is uncontradicted evidence that neither of them had been so applied and that neither of them had any such meaning. 'Ruberoid' was a word coined by the complainant. It had never existed until the complainant had made and applied it to its felt saturated with the residuum of animal fats and it has never had any other meaning than the complainant's particular product. This evidence and these facts have forced my mind to the conclu-

sion that no one who first heard or saw this word 'ruberoid' in 1891, before the complainant taught its meaning by advertisements and application to its product, could have recognized thereby the product of the complainant, or the ingredients or characteristics of its roofing, and hence that the word 'ruberoid' was not descriptive, but was a fanciful term which constituted a perfect trade-mark. From this conclusion it necessarily follows that the use of the word 'rubero' to sell a similar product is a clear infringement of the complainant's trade-mark and that the complainant is entitled to an injunction against that use."

It is noteworthy that the earlier decisions of the English Chancery Courts under the English trade-mark Act of 1883, were very strict and narrow in denying the right to appropriate a word that was in any way, even remotely, descriptive of the article to which it was applied, but that the House of Lords finally in effect reversed these strict decisions in the celebrated **"Solio"** case (Eastman Co., 15 R. P. C. 476), and that the later decisions of the English courts are to the effect that words which may be in some sense or to some extent descriptive may yet be appropriated as trade names.

(See Camel's Hair Belting Case, 19 R. P. C. 505; and "Tabloid" case, 1 Chancery L. R. 1904, p. 736.)

III.

But even if this Court should hold complainant has not a valid trade-mark in the word **"Ruberoid"**, we still respectfully insist that it is entitled to the relief prayed for in its bill on the separate and distinct ground of unfair trade and competition. The facts bearing upon this issue are succinctly set out by Judge

Finkelnburg in his written findings of fact and opinion, which are found at record pages 86 to 88.

As these findings were all supported by substantial evidence and in most cases the evidence was wholly uncontradicted this Court will defer to and accept those findings of fact. These findings fully support complainant's claim of fraud and unfair competition.

In cases of this character, it is never necessary to prove that the public has **actually been deceived** by the resemblance or imitation. It is sufficient that the Court be satisfied that the resemblance is such **as would be likely to cause one product to be mistaken for the other.**

Edelsten v. Edelsten, 9 Jur. (U. S.) 479;
Monro v. Smith, 13 N. Y. Sup. 708;
Pillsbury v. Washburn Co., 64 Fed. Rep. 841.

Mr. Justice Clifford in the case of McLean v. Fleming, 96 U. S. 245, 251, said that it was sufficient to entitle the plaintiff to an injunction that the defendant's package is well calculated to **mislead and deceive the unwary.**

Judge Sanborn in the case of Kann v. Diamond Steel Co., 89 Fed. Rep. 706, said that every suit of this character is founded on the fact that the action of the defendant has received or is calculated to deceive ordinary purchasers, buying with usual care so that they have purchased or will probably purchase the goods of defendant under the mistaken impression that they are those made by complainant. But in this case, although it was unnecessary to do so, complainant has proven by testimony of Mr. Porter, an experienced dealer in roofing, not only that the imitation was sufficiently close to mislead, but also that it had in a specific instance actually misled and deceived a prospective purchaser.

Neither is it necessary to prove intentional fraud on the part of the defendant.

Caffeen v. Bunton, 4 McLean 519;
Manufacturing Co. v. Trainer, 101 U. S. 51-64;
Liggett-Meyer Tob. Co. v. Hynes, 20 Fed. Rep. 883.

In the case of Delong Hook & Eye Co. v. Francis Hook and Eye Co., 139 Fed. Rep. 146, the Court cites with approval the following language:

> "The law is well settled that in suits of this character the intention of the defendant in adopting the style of package or choosing a name for a similar product, is to a certain extent immaterial. It is not essential to the right of complainant to an injunction to show absolute fraud or wilful intent on the part of the defendant. Upon familiar principles it will be presumed that the defendant contemplated the natural consequences of its acts. The court must determine the intent from defendant's acts and the results produced thereby."

So far as fraudulent intent is concerned, the authorities all agree that it may be inferred and need not be shown by direct evidence or admission. But in this case, if the Court will read the cross-examination of defendant's Secretary, Mr. Turpenning, we think it will be made plain that defendant's sole purpose, in adopting the word, "Rubbero", as a name for its roofing product, was to deceive the public and enable it to get the benefit of the advertising done by complainant, and of the reputation for excellence which complainant's product enjoyed in the roofing trade. If defendant was so anxious to use the word, rubber, in naming its product, there are a thousand ways and combinations in which it could have adopted that word without injuring complainant, as is illustrated in the names of

similar products exhibited at the trial, to-wit: "Compo-Rubber Roofing," "Galvanized Rubber Roofing," "Perfection Rubber Roofing," "Original Rubber Roofing," etc., etc.

In further support of this proposition we use again part of the argument of Judge Sanborn in his dissenting opinion, as follows:

> "Moreover, even if the word **'ruberoid'** had been so accurately descriptive that it could not have been a technical trade-mark, the result ought not to be different. In Ruzby v. Davis, 80 C. C. A. 163, 165, 150 Fed. 275, 277, this Court held that the complainant was entitled to an injunction against the use of the word 'Keystone', and affirming the following statement of the law quoted from the opinion in Shaver v. Heller & Merz Co., 48 C. C. A. 48, 59, 108 Fed. 821, 832, in which an injunction against the use by the defendant of the word 'American' to sell their goods as the manufacturers of the complainant was sustained.
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> "The use of a geographical or descriptive term confers no better right to perpetuate a fraud than the use of any other expression. The principle of law is general and without exception. It is that no one may so exercise his own rights as to inflict unnecessary injury upon his neighbor.
>
> "It is that no one may lawfully palm off the goods of one manufacturer or dealer as those of another to the latter's injury. It prohibits the perpetration of such a fraud by the use of descriptive and geographical terms which are not susceptible of monopolization as trade-marks as effectually as it prohibits its commission by the use of any other expressions." 48 C. C. A. 55, 108 Fed. 827.
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> "And it is the duty and practice of courts of equity to enjoin the use of descriptive and geographical terms by one competitor for the purpose of filching the trade of another. Thompson v. Montgomery, 41 Ch. Div. 35, 38, 47, 51; Montgomery v. Thompson, Appeal cases 217, 220; Lee v.

Haley, 5 Chan. App. 155, 161; Witherspoon v. Currie, L. R. 5 H. L. 508, 522, 523; Brewery Co. v. Powell (1897), App. Cases 710, 716; American Waltham Watch Co. v. U. S. Watch Co., 173 Mass. 85, 53 N. E. 141; Flour Mills Co. v. Eagle, 86 Fed. 608, 628, 30 C. C. A. 386, 406; American Brewing Co. v. St. Louis Brewing Co., 47 Mo. App. 14, 20; Cady v. Schultz, 19 R. I. 193, 32 Atl. 915; Newman v. Alvord, 49 Barb. 588; McLean v. Fleming, 96 U. S. 245, at pages 254, 255; Elgin Nat. Watch Co. v. Illinois Watch Case Co., 179 U. S. 665, 674; Reddaway v. Banham, 1896 App. Cases, 199, 204, 211, 215; Buzby v. Davis, 80 C. C. A. 163, 165, 166, 150 Fed. 275, 277, 278; Shaver v. Heller & Merz Co., 48 C. C. A. 48, 59, 108 Fed. 821, 832, in which this Court sustained an injunction issued by the Circuit Court, which forbade the defendants from using the word 'American' to sell their goods as the manufacturers of the complainant.

"The general rule is that one may not use his own name even to sell his goods as those of another, and defendants have been enjoined from using their names for that purpose in these cases: Croft v. Day, 7 Beav. 84, 89, 90; Meyer v. Medicine Co., 58 Fed. 884, 887, 7 C. C. A. 558, 565, 18 U. S. App. 373, 378; Garrett v. T. H. Garrett & Co., 78 Fed. 472, 477, 478, 24 C. C. A. 173, 178, 179; Walter Baker & Co. v. Sanders, 80 Fed. 889, 26 C. C. A. 220, 51 U. S. App. 421; Tarrant & Co. v. Hoff, 76 Fed. 959, 961, 22 C. C. A. 644, 646; R. W. Rogers & Co. v. Wm. Rogers Mfg. Co., 70 Fed. 1017, 1019, 17 C. C. A. 576, 578, 35 U. S. App. 843, 847, 848; Thread Co. v. Armitage, 45 U. S. App. 62, 73, 21, C. C. A. 178, 186, 74 Fed. 936, 944.

(3) The argument that one who uses a generic or descriptive term is not entitled to an injunction against the use of simulative names or terms, and hence that the defendant has a superior equitable right to use the word 'rubbero' to sell its goods as the ruberoid of the complainant, is not persuasive to my mind, because the generic name of the product in this case is rubber roofing, and the word 'ruberoid' has never become the generic name of

the product, but has always been a specific designation of complainant's particular manufacture of it, because, in my opinion, for the reasons which have already been stated, ruberoid was not descriptive of that product when first applied, and because the word 'rubbero' is neither the generic name of the product nor any simulation of it, but is a coined, fanciful word, conceived and applied to simulate, not the generic name rubber roofing, but the specific designation of complainant's manufacture, the term 'ruberoid', and to palm off the goods of the defendant as those of the complainant.

(4) It is said that the defendant should be permitted to use the word 'rubbero' to sell its product as that of the complainant because it does not accomplish that end by the simulation of the name of the complainant or by the complainant's other peculiarities of the dress of its goods. But this product of the complainant is ordered and sold throughout the world by its name 'ruberoid', and many of those who purchase it doubtless never see its dress until they have made their purchase. In my opinion the evidence is plenary that the defendant creates confusion in the trade and filches the complainant's business by the use of this word 'rubbero'. It is no defense for one who kills with a pistol that he did not kill with a sword, or for one who defrauds by mortgage that he did not defraud by a deed, and in my opinion it ought to be no defense for one who palms off his own goods as those of another by the use of a successful simulation of the name of the latter's manufacture that he does not accomplish that end by other means, or that he places his own name and address and the assertion of his manufacture and ownership upon the product. The chief effect of placing the defendant's unfamiliar name and marks upon an article so well known as appellee's ruberoid was to give the appellant the benefit of the established reputation of appellee's articles and thus to enable it to derive a greater benefit from its fraud. 'That is an aggravation, and not a justification, for it is openly trading in the name of another,

upon the reputation acquired by the device of the perpetrator.' Menendez v. Holt, 128 U. S. 514, 521; Gillott v. Esterbrook, 48 N. Y. 374, 378.

(5) Nor does it appear to me to be the logical result of an injunction against the use of the word 'rubbero' by the defendant to filch the complainant's trade that none of the other manufacturers of rubber roofing could lawfully call their products ruberoid roofing or rubber roofing. Rubber roofing is the generic name of the product of all these manufacturers, and they all have exercised an undoubted right to use that name. Ruberoid is the fanciful term by which the complainant designates its particular manufacture of this product. Rubbero is the fanciful word devised and used by the defendant to simulate, not the generic name rubber roofing, but, the fanciful name of defendant's product for the purpose of palming off the defendant's goods as the complainant's ruberoid. How can an injunction against the continuance of this fraud logically, or otherwise, deprive manufacturers of the right, whose exercise works no fraud, to call their products rubber roofing as they have called them without objection or interruption during the seventeen years that the complainant's manufacture has been made and sold as ruberoid?

(6) The cases of Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 178, 186, 189, 201, 204 and the 'Castoria' case, Centaur Co. v. Heinsfurter, 84 Fed. 955, 956, upon which the majority seem to rely so confidently, illustrate an exception to the general rule of the law of unfair competition, under which the case at bar, in my opinion, does not fall. That exception is that where a patentee during the life of his patent confers an arbitrary or a generic name upon the patented article by which alone it comes to be known during the term of the patent such as 'Singer' in the former case and 'Castoria' in the latter, the right to the use of that name passes to the public upon the expiration of the patent. Pages 178, 183, 199 of 165 U. S. But if there had been no patent, or if there had been no conference of such name, or if there had been no

expiration of the patent, the right to the use of the name would not have passed to the public. Those cases are inapplicable to the case at bar, because the complainant's product was never protected by a patent, because ruberoid, the trade name of its manufacture, was not conferred upon the product while the complainant had a patented monopoly of its manufacture, and because that term never became the generic name of the product which was and is rubber roofing, but has always been, and still is, simply the distinguishing name of complainant's particular manufacture. This case falls under the general rule, and that is that no one may lawfully use any word or expression which has come to signify his competitor's product for the purpose of filching his trade and perpetrating a fraud upon the public.

In Reddaway v. Banham, the plaintiff had manufactured and sold for fourteen years belting made chiefly of camel's hair under the name 'camel hair belting' until that term had come to signify Reddaway's belting to the trade. Then the defendant commenced to make belting of camel's hair and to sell it as 'camel hair belting'. The Court below refused to sustain an injunction against him but the House of Lords reversed that decision and restrained the defendant from using the words 'camel hair' so as to palm off its goods as those of the complainant.

Lord Herschell said: 'In my opinion the doctrine on which the judgment of the Court of Appeal is based, that where a manufacturer has used as a trade-mark a descriptive word he is never entitled to relief against a person who so uses it as to induce in purchases the belief that they are getting the goods of the manufacturer who has theretofore employed it as his trade-mark, is not supported by authority and cannot be defended on principle. I am unable to see why a man should be allowed in this way more than in any other to deceive purchasers into the belief that they are getting what they are not, and thus to filch the business of his rival.'

In Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S. 665, 674, a case determined by the Supreme Court long after Brown Chemical Co. v. Meyer, 139 U. S. 540, the Supreme Court held that the word 'Elgin' was a geographical term not the subject of a trade-mark. But it also reviewed with approval Witherspoon v. Currie and Reddaway v. Banham, and said: 'But it is contended that the name Elgin had acquired a secondary signification in connection with its use by appellant and should not for that reason be considered or treated as a mere geographical name. It is undoubtedly true that where such a secondary signification has been acquired, its use in that sense will be protected by restraining the use of the word by others in such a way as to amount to a fraud on the public and on those to whose employment of it the special meaning has become attached.'

The word 'rubbero' is so similar to the word 'ruberoid' so different from the generic name rubber roofing that I am unable to bring my mind to believe or suppose that it was conceived or used for any other purpose than to palm off the defendant's goods as those of the plaintiff. Under the decision of the Supreme Court in Menendez v. Holt, 128 U. S. 514, 521, and other authorities of like character, the fact that the complainant added its name and address and asserted its manufacture of the product it sold under this name rubbero not only failed, in my opinion, to excuse, but had the effect to aggravate the offense, and the decree for an injunction against the continued perpetration of this fraud granted by the Court below should, I think, be affirmed, both because complainant's 'ruberoid' was not descriptive of its product, but was a fanciful word and a good technical trademark which was infringed by the defendant's use of the word 'rubbero', and because the evidence has convinced me, as it did the Court below, that the defendant was guilty of unfair competition by the use of this word 'rubbero' to palm off its product as the ruberoid of the complainant."

This argument of Judge Sanborn has been reinforced by opinions in other circuits in several cases which have been decided since the opinion in this case was handed down, as follows:

In the case of Florence Mfg. Co. v. J. C. Dowd & Co., 178 Fed. 73, it was held that the word "Keep-clean" as applied to tooth brushes, was descriptive and not the proper subject of a trade-mark. In that case the Patent Office had refused the registration of the name "Keep-clean" as a trade-mark. Defendant, after the complainant had established a trade in its tooth brushes under the name of "Keep-clean", began the sale of tooth brushes under the name of "Sta-Kleen"; and registration of this name as a trade-mark was also denied by the Patent Office.

The Court (the Circuit Court of Appeals for the Second Circuit) also held that it was not necessary in order to entitle the complainant to its injunction that it should show either that it had a valid trade-mark or that the public had been deceived by the defendant's use of the name "Sta-Kleen". The Court said:

> "It is so easy for the honest business man who wishes to sell his goods upon their merits to select from the entire material universe which is before him symbols, marks and coverings which by no possibility can cause confusion between his goods and those of his competitors that the courts look with suspicion upon one who, in dressing his goods for the market, approaches so near to his rival that the public may fail to distinguish between them. The law is not made for the protection of experts, but for the public—that vast multitude which includes the ignorant, the unthinking, and the credulous who, in making purchases, do not stop to analyze, but are governed by appearances and general impressions. We agree with the Judge of the Circuit Court in thinking that if 'Keep-Clean' were

a valid trade-mark 'Sta-Kleen' would infringe it, and we may therefore consider the question of unfair competition as if the former word had been appropriated."

The judgment of the lower court was reversed and decree entered for plaintiff, enjoining the defendant from the use of the word "Sta-Kleen".

In the case of Bates Manufacturing Company v. Bates Numbering Machine Company, 172 Fed. 892, it was held that in a suit to restrain unlawful competition equity does not concern itself with the means. If the result is fraudulent and the public are induced thereby to purchase the goods under the belief that they are those of another, the means will be enjoined.

Also that unfair competition does not necessarily involve the violation of any exclusive right to the use of a word, mark, or symbol as it may arise from the use of words which everybody may use, the test being whether what has been done tends to pass off the goods of one for those of another or to deprive such other of his rights. In this case complainant sold a machine under the name of "Bates Automatic Hand Numbering Machine", the machine having been invented by a man named Bates. The defendant sold machines under the name of "The Bates Numbering Machine" or "The Bates Numbering Machine Company", Bates, the inventor of the original machine, having severed his connection with the complainant company and became connected with the defendant company. The use of that name by the defendant company was enjoined.

In the case of Wolff Bros. v. Hamilton Brown Shoe Co., 165 Fed. 413, decided by the Circuit Court of Appeals of the Eighth Circuit **at the same term at which this case was decided, but after a change in the Judges**

composing the court, it was held that the words **"American Girl"** cannot be appropriated by anyone as a valid trade-mark, but that, although complainant was not entitled to protection in the use of those words as a name for shoes, **as a valid trade-mark,** yet it was nevertheless entitled to protection in their use upon the **distinct ground of unfair trade,** against a competitor who used the words "American Lady" as a name for shoes, and it awarded injunctive relief upon that ground. The Judges who sat in this last case were Vandevanter, Munger and Sanborn, and, while Judge Sanborn dissented upon the question of trade-mark, they all concurred in the holding that complainant was entitled to the relief prayed upon the distinct ground of unfair trade.

We submit, therefore, that upon this question of relief on the ground of unfair trade, irrespective of a valid trade-mark in the word "Ruberoid", the majority opinion of the Circuit Court of Appeals of the Eighth Circuit is in conflict with the decisions of the courts of all the other circuits, and in conflict with its own decisions in similar cases.

Under the evidence found at pages 53, 54 and 43 of the record the proof of fraud, as stated by Judge Sanborn in his opinion, is "plenary", and the majority opinion of the Circuit Court of Appeals is not only contrary to all reason and authority, but is opposed to equity and good conscience, and should be reversed and set aside, and the decree of Judge Finkelnburg in the lower court should be affirmed.

Respectfully,

FREDERICK N. JUDSON, and
JOHN F. GREEN,
Counsel for Appellant.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1910.

STANDARD PAINT COMPANY,
Appellant,
vs.
TRINIDAD ASPHALT MANUFACTURING COMPANY,
Appellee.

No. 106.

APPEAL FROM THE UNITED STATES CIRCUIT COURT OF APPEALS, FOR THE EIGHTH CIRCUIT.

Reply to Brief and Argument for Appellee.

Counsel for appellee have suggested in this court for the first time that the allegations of the bill of complaint and the evidence adduced by complainant in support thereof are not sufficient to give this court jurisdiction of the appeal. They call attention to the fact that the bill of complaint does not **specifically** allege that the roofing product of the defendant company, to which it had applied the name "RubberO",

was sold either in foreign commerce or commerce with Indian tribes.

Counsel also claim that there is no evidence in the record tending to show that the defendant company had used its trade-mark upon goods sold in foreign commerce or commerce with Indian tribes; and they now contend that this court is without jurisdiction because of this alleged failure of allegation and proof.

Let us consider these two contentions:

I.

THE ALLEGATIONS IN THE BILL OF COMPLAINT.

It is true that the bill of complaint, after alleging that complainant's product, in connection with which it used the name "Ruberoid", was sold in foreign commerce, alleges only that the defendant company was engaged in manufacturing, advertising and selling its roofing product **" to the general public in the City of St. Louis, Missouri, and elsewhere throughout the United States"**; and the defendant in its answer admits only that it is engaged in selling and advertising **"to the general public in the City of St. Louis and elsewhere"** a roofing product under the name of "RubberO".

In the first place, we say that these allegations in this bill, and this admission in defendant's answer, are a great deal stronger in this respect than are those found in the case of Warner v. Searle & Hereth & Co., 191 U. S. 195, and yet this Court, in the Warner case, unhesitatingly held that such allegations were sufficient to give it jurisdiction of an appeal from the Circuit Court of Appeals (see *l. c.* 197 and 206).

Furthermore, defendant did not, in the lower court,

make any issue on the pleadings as to whether this allegation in complainant's bill was sufficient to give the Federal Court jurisdiction on the distinct ground that under these allegations complainant was the owner of a trade-mark entitled to registration under the Federal statutes, and that defendant was infringing rights given complainant by the Federal trade-mark statute; but by joining issue, as it did in the answer, defendant admitted the sufficiency of this allegation in the bill of complaint in that respect. Even though that claim of infringement under the Federal statute may have been imperfectly pleaded, yet by answering over, as it has, defendant must be held to have waived its right to object to that imperfection, as the charge that defendant was engaged in selling its product **"to the general public in the City of St. Louis, Missouri**, and elsewhere throughout the United States" is sufficient to cover and include commerce with Indian tribes. By answering and delaying until this time to raise this question defendant waived the right to object to such form of pleading.

Giles v. Harris, 189 U. S. 474, 47 L. Ed. 909;
Bradstreet v. Thomas, 12 Peters 59;
Partridge v. Ins. Co., 15 Wallace 573;
Deputron v. Young, 134 U. S. 241;
Reynes v. Dupont, 130 U. S. 354.

II.

THE EVIDENCE ON THIS ISSUE.

Complainant established that its "Ruberoid" roofing was sold in all foreign countries, so that as far as **complainant's trade-mark** is concerned, it unquestionably established a trade-mark which was used in foreign commerce and in trade in all of the United States

and territories and among the Indian tribes. About the sufficiency of this evidence there can be no question (Rec., pages 16, 17, 32).

The evidence in respect to the sales of "RubberO" roofing by the defendant company was as follows:

Mr. Porter, who was an officer of the Graham Paper Company, the St. Louis agent of the complainant, testified that the "RubberO" roofing of the defendant company was sold in competition with the complainant's "Ruberoid" throughout all the territory included in the Graham Paper Company's agency (Rec., pp. 44, 45), and he testified further that this agency included the States of Missouri, Illinois, Arkansas, Iowa and **Oklahoma and Indian Territories,** and that defendant's "RubberO" roofing was sold generally throughout all this district (Rec., pp. 44-45). Mr. Turpenning, the defendant's secretary, testified that defendant's "RubberO" was sold generally in St. Louis, Missouri, and the territory contiguous thereto (Rec., p. 54). This was the evidence upon which the case was submitted to Judge Finkelnberg, in the St. Louis Circuit Court. No point or claim was made by learned counsel for defendant company **at the trial and argument of the case in the Circuit Court before Judge Finkelnberg** that either the pleadings or the proofs were insufficient to show that the infringing trade-mark was used in commerce with Indian tribes; but the case was tried in the *nisi prius* court upon the theory that both the allegations and the proofs were sufficient to establish that the trade-mark, "RubberO", was used in such manner as to make out a case of infringement under the United States statutes. The opinion of Judge Finkelnberg, deciding the case in the lower court, shows that no such point or argument as is made here was made before

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him, nor was this alleged defect of allegation and proof called to his attention in any manner (Rec., p. 86). On the contrary, it affirmatively appears from his opinion that the case was tried before him upon the theory that if the complainant had a valid trade-mark in "Ruberoid" and if "RubberO" was so sufficiently similar thereto as to constitute infringement, then there was an **infringement within the provisions of the Federal statute.** In other words, they never claimed in the lower court that the sole ground of Federal jurisdiction was that of **diverse citizenship,** but they tried the case there, as the record shows, upon the theory that the Federal court had jurisdiction, because the pleadings and evidence made out a case of infringement under the Federal statute; and the same thing is true with respect to the theory on which the defendant tried its case in the Circuit Court of Appeals for the Eighth Circuit. No claim or contention was made in that appellate court that the evidence was insufficient to make out a case of infringement under the Federal statute. The opinion of the Court of Appeals and the dissenting opinion of Judge Sanborn both show conclusively that no such question was presented to or considered by them in their decision of the case. It is fundamental in this court, as in all courts, that a party must try his case in the appellate court on the same theory upon which it was submitted to the *nisi prius* court.

Rodriguez v. Vivioni, 201 U. S. 371;
San Pedro C. D. A. Co. v. U. S., 146 U. S. 120;
Cincinnati v. Hamilton & Dayton R. Co., 177 U. S. 615.

It is true that a party may raise the question of entire failure of jurisdiction of the subject-matter at any

stage of a case, and if it clearly appears from the record that there is no jurisdiction the Court will so hold whenever its attention may be directed to that fact. But it is also true that if the allegations in the pleadings can, **by any reasonable construction,** be made to give the court jurisdiction, even though they may be imperfect, and if the evidence by any **reasonable inference** can be held to sustain the jurisdiction, an appellate court will not favor such contentions when raised there for the first time.

If the defendant in this case intended to set up the contention that the Federal Court had no jurisdiction on the distinct ground that the infringing trade-mark was not within the provision of the Federal statute, it was its duty to call the attention of Judge Finkelnberg and of the Circuit Court of Appeals to that fact, and while the evidence in this case is not as specific and definite upon that particular question as it might be, it is sufficient to sustain the jurisdiction of the court when that claim is now made for the first time. This is so because the testimony of Mr. Porter to the effect that the infringing trade-mark "RubberO" was used in sales of roofing to the general public in Oklahoma and the Indian Territories is sufficient to establish sales in commerce with Indian tribes, because it is a matter of common knowledge, and of which this court must take judicial notice, that the Indian tribes in Oklahoma and Indian Territory number about 100,000 individuals and constituted in 1906 a very large proportion of the inhabitants of those territories and were generally diffused throughout the entire district in such manner that the statement that any goods were sold generally in that territory affords a reasonable and natural inference that they were sold in commerce

with Indian tribes, because these tribes are scattered so generally over all that district. If the defendant intended to claim that this evidence was insufficient to establish that fact by any reasonable intendment or inference even, it should have called the attention of the trial court to this claim; but all presumptions that can possibly be indulged in reference to the sufficiency of that testimony must now be given effect to in order to defeat this belated contention of the defendant.

Bank v. Rogers, 3 C. C. A. 666;
Callaghan v. Meyers, 128 U. S. 617;
Camden v. Stewart, 144 U. S. 119;
Lansing v. Stanisics, 36 C. C. A. 306;
Kunsmiller v. Hill, 29 C. C. A. 658;
Kingberly v. Arms, 129 U. S. 524.

In the cases of Warner v. Searle & Hereth Co., 191 U. S. 195; Ryder v. Holt, 128 U. S. 525; Leschen Rope Co. v. Broderick & Bascom Rope Co., 201 U. S. 166, and Elgin Watch Co. v. Illinois Watch Co., 179 U. S. 665, which are the cases cited and relied upon by counsel for defendant to support their contention, the claim that the Federal Court had no jurisdiction on the ground that a right arising under Federal statutes was involved, was presented and passed upon in the *nisi prius* courts. Therefore, even if the pleadings and evidence were similar in those cases to what we have in in this case, those decisions would not be applicable to this case on the record here presented.

Respectfully,

FREDERICK N. JUDSON and
JOHN F. GREEN,
Counsel for Complainant.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1910.

STANDARD PAINT COMPANY,
Appellant,
vs.
TRINIDAD ASPHALT MANUFACTURING COMPANY,
Appellee.

No. 108.

APPEAL FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

Statement, Brief and Argument for Appellee.

W. B. HOMER,
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Counsel for Appellee.

St. Louis Law Printing Co., Printers, Rookery, 211 N. Fourth. Main 3749.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1910.

STANDARD PAINT COMPANY,
Appellant,
vs.
TRINIDAD ASPHALT MANUFACTURING COMPANY,
Appellee.

No. 106.

APPEAL FROM THE UNITED STATES CIRCUIT COURT OF APPEALS, FOR THE EIGHTH CIRCUIT.

Statement, Brief and Argument for Appellee.

STATEMENT.

This is a suit in equity brought by the Standard Paint Company against the Trinidad Asphalt Manufacturing Company, in the Circuit Court of the United States in and for the Eastern Division of the Eastern Judicial District of Missouri, in May, 1905. The purpose of the suit is to restrain the defendant from infringing the trade-mark of complainant.

The bill of complaint alleges that "the Standard Paint Company, a corporation organized under the laws of the State of West Virginia, and a citizen of

said state, having its principal office and factory at Bound Brook, in the State of New Jersey, brings this bill of complaint against the Trinidad Asphalt Manufacturing Company, a corporation duly organized under the laws of the State of Missouri, with its principal office in the City of St. Louis in said state" (Record, p. 4).

There is no allegation that the defendant is a citizen of the State of Missouri.

The bill of complaint contains an allegation that "complainants have advertised said roofing very extensively under the name 'Ruberoid' roofing, and built up a large and valuable trade therein in all parts of the United States and in foreign countries" (Record, p. 4). It contains no allegation that it has sold its product among the "Indian Tribes".

The bill of complaint further contains an allegation that the roofing material in question of complainant "has commanded and still commands an extensive sale throughout the United States and foreign countries" (Record, p. 5). No proof was offered that the complainant had sold its product among the "Indian Tribes".

The only allegation regarding the use of the trademark or the material of the defendant, is that the defendant "has been, since the 18th day of January, 1900, and is now, engaged in manufacturing, advertising and selling to the general public in the City of St. Louis, Missouri, and elsewhere throughout the United States, a roofing material similar in appearance to that made by complainants". And contains no allegation that the defendant has sold its product among the "Indian Tribes".

The proof shows that the complainant exported its

roofing to foreign countries, but that the defendant sold its material only in the United States; nor is there any evidence that the defendant sold its product among the "Indian Tribes".

Complainant registered its trade-mark, "Ruberoid", in the Patent Office at Washington on the 28th day of May, 1901, and the defendant registered its trade-mark, "RubberO", under the statutes of the State of Missouri, with the Secretary of State of Missouri, on the 22d day of November, 1904. These trade-marks are used upon a certain class of roofing which is ready-made; that is, which is ready to be applied on roofs. This roofing is sold in rolls. It is a class of roofing known as "rubber roofing", of which there are some forty varieties. Many of these varieties have the word "rubber" used in their trade-marks or trade names, and all are designated in common parlance as "rubber roofing". They are all alike in general appearance, and in the form in which they are put up and sold.

The evidence shows that the complainant company began to use the word "Ruberoid", as applied to its product, in 1892, as shown by complainant's advertising matter, marked "Defendant's Exhibit, 'Complainant's Advertisement No. 2'" (Record, pp. 3 and 79).

The reason why complainant adopted the word "Ruberoid" as a trade-mark, is shown by the "statement" of the trade-mark itself, where the complainant says that it "has adopted for its use a trade-mark for a solid substance in the nature of soft, flexible rubber". And the statement of the trade-mark also has the following: "The class of merchandise to which this trade-mark is appropriated is solid substances in the nature of soft, flexible rubber in the form of flex-

ible roofing, flooring, siding, sheathing, etc., and the particular class of goods upon which said trade-mark is used is solid substances, in the nature of soft, flexible rubber." The statement at the head of the certificate of registration is: "Trade-mark for certain-named substances, of the nature of rubber" (Record, p. 62).

The complainant company also states as a reason for adopting the name "Ruberoid", as applied to its roofing, was "because of its durability and flexibility" (Record, p. 14), and because the "gum with which, in the liquid state, the roof is saturated, resembles rubber in its crude state", and "it was this close resemblance to rubber, which suggested the name 'Ruberoid'" (Record, pp. 3 and 80).

The material of which complainant's roofing is made is wool felt, or composition felt, and it is coated or saturated with a compound which is manufactured from the residuum of animal fats. None of the material, whether manufactured by the parties to the suit or by other concerns, has in it any rubber at all, but it bears the appearance of, resembles, and is, rubber-like, or "Rubberoid".

The word "Rubberoid" is made up of the word "rubber" with the suffix "oid", which suffix means resembles, or is like. This suffix is used very largely, not only in scientific or medical terms, but also in common words. Examples are: Spheroid, meaning a figure that resembles a sphere, but is not a sphere; asteroid, meaning like a star, when connected with the Latin word *aster,* meaning a star; typhoid, like typhus; varioloid, like variola; epileptoid, like epilepsy; granitoid, like granite; crystaloid, like crystal. So. Rubberoid, like rubber.

This word had been used as a trade-mark by other parties. The Rubberoid Company, a corporation of Bristol and Philadelphia, Pa., registered this word as a trade-mark on the 9th day of July, 1878, which was adopted by that company for use "as a trade-mark for a gum resembling India rubber, produced by the process described in letters patent of the United States, issued to Henry A. Clark, of Boston, Mass., for treating linseed oil, etc., dated Nov. 14, 1876, and April 2, 1878".

The said letters patent show that the invention related "to the treatment of vegetable oils * * * for the purpose of rendering oil more suitable for use as a coating for cloths, which will be water-proof, flexible and elastic, and unaffected by either heat or cold". And the patent describes the effect as applied to cloths "to make a water-proof, elastic and flexible coating" (Record, pp. 74-78).

The most striking difference between the Rubberoid Company's use of the word and of the complainants is that the former used vegetable oils and the latter animal fats as a basis (Record, p. 29). And in both cases the name given to the coating or saturating process was "Rubberoid" or "Ruberoid", and the article which was patented was the saturating or coating compound.

This "Rubberoid Company", which was organized under the laws of the State of Connecticut, in 1878, had ceased to do business on February 16, 1906.

On the 8th of January, 1884, the James D. Frary & Son Company, of the State of Connecticut, registered a trade-mark, which consisted of the word "Rubberoid", and stated that the class of merchandise to which it was to be applied was a composition which

was used as a substitute for hard rubber. At the time complainant applied for the registration of its trade-mark, and before such registration was allowed by the Commissioner of Patents, it purchased this "Frary trade-mark" (Record, pp. 65-107 and 38).

The defendant's trade-mark, "RubberO", was duly registered on the 22d day of November, 1904, in the office of the Secretary of State of the State of Missouri, in accordance with the statutes of said state.

There is no evidence or claim that the goods of the defendant were inferior in any way to those of the complainant. The labels used on the merchandise of the defendant were so entirely unlike those of the complainant that no one could possibly purchase the goods of one for those of the other. Both the trial Court and the Court of Appeals held that there was no imitation of the arrangement, color or general appearance of the labels, and no similarity, unless it existed in the words or symbols themselves.

The trial Court enjoined the defendant from the use of the word or symbol RubberO.

The Court of Appeals found the alleged trade-mark of complainant to be invalid, and reversed and remanded the cause, with directions to dismiss the bill.

The opinion of the Circuit Court of Appeals, Eighth Circuit, is reported in 163 Fed. 977; 90 C. C. A. 195.

BRIEF.

I.

The decision of the Circuit Court of Appeals in this cause was final, and this Court will not take jurisdiction thereof.

Warner v. Searle & Hereth Co., 191 U. S. 195, 206;
Ryder v. Holt, 128 U. S. 525;
Leschen Rope Co. v. Broderick, 201 U. S. 166;
Elgin National Watch Co. v. Illinois Watch Co., 179 U. S. 665;
Trade-mark Cases, 100 U. S. 82;
Allen B. Wrisley Co. v. George E. Rouse Soap Co., 90 Fed. 5;
Illinois Watch Co. v. Elgin National Watch Co., 94 Fed. 667, 671.

II.

The complainant's trade-mark is descriptive of the article upon which it is used, of its qualities, ingredients and characteristics, and is therefore void.

(*a*) This appears from the description of the trade-mark and the material upon which it is used, as contained in the statement filed in the Patent Office.

(*b*) From the complanant's own statement in its advertising matter, as well as in the testimony of its own witness.

(*c*) Under the decisions of this and many other courts.

Dela. & Hud. Canal Co. v. Clark, 13 Wall. 311, 323;
Goodyear India Rubber Cloth Mfg. Co. v. Goodyear Rubber Co., 128 U. S. 598;
Brown Chem. Co. v. Meyer, 139 U. S. 540;
Raggett v. Findlater L. R., 17 Eq. 29;

Bickmore, Etc., Co. v. Mfg. Co., 67 C. C. A. 439, 134 Fed 833;
Marvel Co. v. Pearl, 66 C. C. A. 226, 133 Fed. 160;
Computing Scale Co. v. Standard Computing Scale Co., 55 C. C. A. 459, 118 Fed. 965;
Brennan v. Dry Goods Co., 47 C. C. A. 532, 108 Fed. 624, 99 Fed. 971;
American Washboard Co. v. Mfg. Co., 43 C. C. A. 233, 103 Fed. 281;
Bennett v. McKinley, 13 C. C. A. 25, 65 Fed. 505;
Brown Chemical Co. v. Meyer, 31 Fed. 433, affirmed in 139 U. S. 540;
Rumford Chemical Works v. Muth, 35 Fed. 524;
Indurated Fibre Co. v. Amoskeag, Etc., Co., 37 Fed. 695;
Harris Drug Co. v. Stucky, 46 Fed. 624;
Jaros, Etc., Co. v. Fleece Co., 65 Fed. 424;
Leonard v. Wells, 53 L. J. Ch. 233, 32 W. R. 532;
Re Roach, 10 Pat. Off. Gaz. 333;
In re Goodyear Rubber Co., 11 Pat. Off. Gaz. 1062;
Ex parte Pikling, 24 Pat. Off. Gaz. 899;
Scott v. Standard Oil Co., 106 Ala. 475;
Burke v. Cassin, 45 Cal. 467;
Larrabee v. Lewis, 67 Ga. 561;
Gilman v. Hunnewell, 122 Mass. 139;
Trask v. Wooster, 28 Mo. App. 408;
Van Beil v. Prescott, 82 N. Y. 630;
Town v. Stetson, 3 Daly (N. Y.) 53;
Gessler v. Grieb, 80 Wis. 21;
Alff v. Radam, 77 Tex. 630;
Newcomer v. Scriven Co., 94 C. C. A. 77;
Carbolic Soap Co. v. Thompson, 25 Fed. 625;
N. Y. Asbestos Mfg. Co. v. Ambler Asbestos Air Cell Covering Co., 9 Fed. 85;
N. Y. Asbestos Mfg. Co. v. Ambler Asbestos Air Cell Covering Co., 62 N. Y. Supp. 339;
Green v. Mfrs. Belt Hook Co., 158 Fed. 640;
Scriven v. North, 134 Fed. 366, 67 C. C. A. 348;
Wrisley Co. v. Soap Co., 87 Fed. 589;
Pratt v. Astral Refining Co., 27 Fed. 492;

Chalmers Knitting Co. v. Columbia Mesh Knitting Co., 160 Fed. 1013;
Florence Mfg. Co. v. Dowd, 178 Fed. 73;
Chance v. Gulden, 165 Fed. 624, 92 C. C. A. 58;
Wolf v. Hamilton, 165 Fed. 413, 91 C. C. A. 363; Sanborn, J., dissenting;
Rice Stix Dry Goods Co. v. J. A. Scriven Co., 165 Fed. (C. C. A.) 639; Sanborn, J., dissenting;
Searle & Hereth Co. v. Warner, 112 Fed. 674;
Warner v. Searle & Hereth Co., 191 U. S. 195;
Leclanche Battery Co. v. Western Electric Co., 23 Fed. 276;
Rumford Chemical Works v. Muth, 35 Fed. 524;
Caswell v. Davis, 58 N. Y. 223;
Coats v. Merrick Thread Co., 149 U. S. 562;
Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537;
The Amoskeag Mfg. Co. v. Spear, 2 Sanford Superior Court 599.

III.

The word used as a trade-mark had, when adopted by complainant, and long before its registration, become a word in general use. It had been used as a trade-mark by others, and had found a place in the dictionaries, as a word describing substances which resembled rubber, without being rubber; that is, it was a word made up by adding the common suffix "oid", meaning "like", to the word rubber.

Dadirrian v. Yacubian, 98 F. 872, 39 C. C. A. 321;
Goodyear Rubber Co. v. Rubber Co., 128 U. S. 594, 604.

IV.

There was no infringement of the complainant's trade-mark by the defendant.

Columbia Mill Co. v. Alcorn, 150 U. S. 460, 467;
Kann v. Diamond Steel Co., 89 Fed. 706; 32 C. C. A. 324, 329;

Dunlap v. Willbrant Surg. Mfg. Co., 151 Fed. 223, 233 (C. C. A.);
Diamond Match Co. v. Saginaw Match Co., 142 Fed. 727 (C. C. A.);
Marvel Co. v. Pearl, 133 Fed. 160, 66 C. C. A. 226;
Chalmers Knitting Co. v. Columbia Mesh Knitting Co., 160 Fed. 1013;
Elgin Watch Co. v. Ill. Nat. Watch Co., 179 U. S. 665, 694;
Howe Scale Co. v. Wyckoff, Seamans and Benedict, 198 U. S. 118, 140;
Chance v. Gulden, 165 Fed. 624;
Searle & Hereth Co. v. Warner, 112 Fed. 674;
Warner v. Searle Hereth Co., 191 U. S. 195.

ARGUMENT.

1. Under the allegations in the bill of complaint and the facts proven in the case, it would seem that this Court would not take jurisdiction of this case or take into consideration the issues determined by the lower courts.

The allegation of the bill regarding the citizenship of the parties, and relating to the use of the trademark in question, are the following:

> "The Standard Paint Company, a corporation organized under the laws of the State of West Virginia, and a citizen of said State, having its principal office and factory at Bound Brook, in the State of New Jersey, brings this bill of complaint against the Trinidad Asphalt Manufacturing Company, a corporation duly organized under the laws of the State of Missouri, with its principal office in the City of St. Louis, in said State." (Record, p. 4.) And complainant further alleges that "complainants have advertised said roofing very extensively under the said name 'Ruberoid' roofing, and have built up a large and valuable trade therein in all parts of the United States and in foreign countries." (Record, p. 4.) The bill referring to complainant's roofing only has a further allegation "that said roofing material has become widely and favorably known throughout all the United States and in many foreign countries, as a useful, durable, economical and valuable roofing material, and has acquired a high reputation as such, and has commanded and still commands an extensive sale throughout the United States and foreign countries." (Record, p. 5.)

Regarding the acts of the defendant, the only allegation is as follows: That the defendant "has been since the 18th day of January, 1900, and is now, engaged in

manufacturng, advertising for sale and selling to the general public in the City of St. Louis, Missouri, and elsewhere throughout the United States, a roofing material similar in appearance to that made by complainant."

The proof shows that the complainant exported its roofing to foreign countries. There is no evidence whatsoever that the defendant ever sold its merchandise in foreign countries, or among the Indian tribes. Indeed, the testimony for defendant shows that it has never made any such sales, or intended to make any such sales (Record, p. 54). The statement upon page 11 of appellant's "Statement, Brief and Argument", that the defendant sold its "RubberO" roofing to the "Indian tribes of the Indian Territory" is an error. The record contains neither an allegation nor evidence of any such fact.

Under the allegations and proof, the jurisdiction of the United States Circuit Court rested upon the diversity of citizenship, and in all such cases, the judgment of the Circuit Court of Appeals is final, and no appeal is allowed to this court. When the jurisdiction is obtained by virtue of the registration of a trade-mark under the Act of Congress of March 3, 1881 (21 General Statutes, 502), there must be proof that the product of both the complainant and the defendant is used in commerce with foreign countries, or with the Indian tribes, and that such product so sold by the complainant must bear the registered trade-mark and that goods of the defendant so sold in foreign countries, or among the Indian tribes, must bear the alleged infringing mark.

There being no such allegations as the foregoing in complainant's bill of complaint, this Court will not

take jurisdiction of the case on appeal from the Court of Appeals.

The Circuit Court took jurisdiction of this case solely upon the ground of diverse citizenship and could not have taken jurisdiction for the reason that the same was a case arising under the Constitution or laws of the United States, because there is nowhere in the pleadings any reference to any Act of Congress.

The Circuit Court could take no jurisdiction of a case simply involving unfair competition, unless there was diversity of citizenship. A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 201 U. S. 166.

This question of jurisdiction of trade-mark cases seems to be fully covered by the recent decision of this Court in the case of Warner v. Searle & Hereth Co., 191 U. S. 195, where, at page 204, the Court says:

> "Obviously the act was passed in view of the decision that the prior act was unconstitutional, and it is, therefore, strictly limited to lawful commerce with foreign nations and with Indian tribes. It is only the trade-mark used in such commerce that is admitted to registry, and it can only be infringed when used in that commerce, without right, by another than its owner."

And the Court continues, at page 206, as follows:

> "The bill was filed in February, 1898, and must be treated as alleging that the trade-mark was then in use in foreign or Indian commerce, although the proofs do not make out that fact after December 26, 1882.
>
> The certificate of registry was good for thirty years, as matter of evidence, but when it was sought to enjoin the wrongful use, it should have been made to appear that the trade-mark was then being used in that commerce, and that use was interfered with, without right, by defendant. And if the presumption of continuing use in such com-

merce flows from the registry, nevertheless, to make out infringement, it must appear that the alleged counterfeit or imitation was being used on merchandise intended to be transported to a foreign country or in lawful commercial intercourse with an Indian tribe.

We so held, in effect, in Ryder v. Holt, 128 U. S. 525, and we see no reason to depart from that ruling.

But the evidence in this record does not show that defendant used the name of its preparation on merchandise intended to be so transported, while the sales proved were sales in the City of Chicago, and northern district of Illinois, and there is nothing to indicate that the preparation was intended to be used in foreign or Indian trade.

In short, even if it were assumed that there could be a trade-mark in the use of the word 'Pancreopepsine', which would be invaded by the use of the word 'Panero-Pepsin', the Circuit Court could not, by virtue of the act, enjoin such use because it was not used in the commerce to which the act related."

2. The opinion of the majority of the Court of Appeals on the question of the complainant's trade-mark being descriptive, contains a very full statement of the reasons for this opinion, as well as a citation of numerous precedents.

Upon this question, however, the most persuasive fact is that the complainant has stated for itself that the name was adopted because it was a proper description or characterization of the goods or merchandise upon which its trade-mark was used.

The complainant, even in its bill of complaint, follows the name "Ruberoid" with the words, "but said roofing has no rubber whatsoever in its composition".

Complainant, in its application to the Patent Office, described its trade-mark as one to be used for "cer-

tain-named substances of the nature of rubber", and in the body of the statement it speaks of the substances in question to be "in the nature of soft, flexible rubber"; and states that it is used upon "solid substances in the nature of soft, flexible rubber". There is no intimation in the trade-mark that the word is to be pronounced other than or different from the word, rubberoid.

It may be said in regard to the pronunciation of complainant's word "Ruberoid", that there was no indication that the word was pronounced by dividing it into syllables, so that the "b" should be connected with the "u". The complainant put no evidence into the record as to the pronunciation of the word. The fact that it may have been pronounced by the complainant's officers with the "b" connected with the "u", was brought out on cross-examination, for the purpose of showing that if it were so pronounced there might be no infringement by the defendant. It is worthy of mention, however, that this name has always been pronounced in this cause by everyone, at first sight, as Rubberoid, and the printer of this record was evidently of the same opinion, for, in dividing the word at the end of the line he has placed the "b" in the first syllable (Record, top of page 19 and bottom of page 207).

The printer of appellant's brief also connects the "b" with the first syllable (see lines 4 and 22 on page 7 of Appellant's "Statement, Brief and Argument").

Again, the testimony in the case shows clearly that the term "Ruberoid" was adopted because of a resemblance of the roofing in question to rubber.

Mr. Richards, chief witness for the complainant, and its manager, testified:

"Q. 9. Please state what is your understanding of the expression 'Ruberoid', that you have used as a trade name?

A. The only understanding I have is that it is a trade name, adopted when the roofing was first made, because of its durability and **flexibility**" (Record, p. 25).

XQ. 30. I call your attention to Complainant's Exhibit 'Advertising Matter, No. 4'—'In appearance this 'gum', with which, in a liquid state, the roofing is saturated, resembles rubber in its crude state. In fact, it was this close resemblance to rubber which suggested the name 'Ruberoid', now so universally and so favorably known.'" This is a proper quotation from this exhibit, advertising matter, is it not?

A. From that issue it is, yes, sir.

XQ. 31. It is a fact, then, that it got its name from its resemblance to rubber, is it not?

Complainant's Counsel: This line of examination objected to on the ground that this witness has already testified that he was not connected with The Standard Paint Company at the time of the adoption of the trade-mark Ruberoid, and he therefore can have no knowledge of the facts inquired into.

A. I can explain a certain thing as to that. The gentleman who wrote that article was not connected with the company when the company was formed, and he wrote it for advertising purposes only. The manager of our advertising department wrote it for advertising purposes.

XQ. 32. If I remember rightly, you stated this was done under your supervision?

A. My supervision, yes, sir.

XQ. 33. You were connected with the company at the time the application for the registration of the trade-mark was made, were you not?

A. Yes, sir.

The statement quoted in the above evidence is contained in the Complainant's Exhibit, "Advertising Matter No. 4", as follows (Record, p. 25):

"Ruberoid roofing is made of the finest quality of selected wool felt obtainable. This individual feature of the roofing, however, is the material with which every fiber of this wool is thoroughly saturated. I refer to ruberoid compound, or 'Gum', which is manufactured solely and exclusively by the Standard Paint Company, and which is not and cannot be used in any other prepared roofing. It is this fact which places ruberoid roofing in a class by itself, for none of the saturations commonly used equal it in efficiency and permanency. We venture to figuratively dissect a piece of ruberoid roofing that we may make clear its peculiar characteristics. We will look at it with a section of ruberoid compound.

In appearance this 'gum' with which, in a liquid state, the roofing is saturated, resembles rubber, which suggested the name 'Ruberoid', now so universally and favorably known. Holding a piece of this ruberoid compound between the fingers one finds that it has all the elasticity of rubber as well as all its toughness. There the similarity ceases, however, for there is absolutely no rubber composition in ruberoid, and it partakes of none of the corrosive or oxydizing nature of the former material" (Record, p. 80).

The record contains no testimony in contradiction of the foregoing evidence.

The word well describes the character or characteristics of the goods of both complainant and defendant, as well as of some forty other varieties of the same class of goods known as rubber roofing. The characteristics of all these goods are that they resemble rubber. Each and all of these manufacturers and vendors have equal right to use the word. Indeed, it appears that for a long time prior to the use of the word by complainant, the word itself was used to describe merchandise similar to the complainant's and defendant's products.

It would seem, therefore, that the complainant will not now be permitted to deny that it is distinctly a descriptive word, and that the same was adopted originally by complainant because of its being descriptive.

The law regarding the validity of trade-marks, as defined by the courts, relating to trade-marks being descriptive, and therefore void, is set forth in the opinion of the majority of the Circuit Court of Appeals in this case as follows:

> It is the settled rule that no one can appropriate as a trade-mark a generic name or one descriptive of an article of trade, its qualities, ingredients or characteristics, or any sign, word or symbol which, from the nature of the fact it is used to signify, others may employ with equal truth. Canal Co. v. Clark, 13 Wall. 311, 323; Goodyear Co. v. Rubber Co., 128 U. S. 598; Brown Chemical Co. v. Meyer, 139 U. S. 540. A reference to a few of the many cases in which it has been applied may more clearly signify its purport than the bare statement of the rule itself. The following have been held to be descriptive terms, and therefore not the subject of trade-mark: "Nourishing Stout", as applied to a malt liquor (Raggett v. Findlater, L. R. 17 Eq. 29); "Gall Cure", to a medicine (Bickmore, Etc., Co. v. Mfg. Co., 67 C. C. A. 439; 134 Fed. 833); "Whirling Spray", to a syringe (Marvel Co. v. Pearl, 66 C. C. A. 226; 133 Fed. 160); "Standard" and "Computing", to scales (Computing Scale Co. v. Standard Computing Scale Co., 55 C. C. A. 459; 118 Fed. 965); "Steel Shod", to boots and shoes with soles studded with nails (Brennan v. Dry Goods Co., 47 C. C. A. 532; 108 Fed. 624; 99 Fed. 971); "Aluminum", to a manufactured article composed in part of that metal (American Washboard Co. v. Mfg. Co., 43 C. C. A. 233; 103 Fed. 281); and "Instantaneous" to a tapioca ready for use (Bennett v. McKinley, 13 C. C. A. 25; 65 Fed. 505); "Iron Bitters" (Brown Chemical Co. v. Meyer, 31 Fed. 433, affirmed in

139 U. S. 540); "Acid Phosphate" (Rumford Chemical Works v. Muth, 35 Fed. 524); "Indurated Fiber", to wares made of wood pulp (Indurated Fiber Co. v. Amoskeag, Etc., Co., 37 Fed. 695); "Cramp Cure" (Harris Drug Co. v. Stucky, 46 Fed. 624); "Hygienic", to underwear (Jaros, Etc., Co. v. Fleece Co., 65 Fed. 424); "Valvoline", to lubricating or valve oil (Leonard v. Wells, 53 L. J. Ch. 233; 32 W. R. 532); "Croup Tincture" (*Re* Roach, 10 Pat. Off. Gaz. 333); "Crack-proof", to rubber goods (*In re* Goodyear Rubber Co., 11 Pat. Off. Gaz. 1062); "Crystalline", to artificial stones (*Ex parte* Pikling, 24 Pat. Off. Gaz. 899); "Fire-proof Oil" (Scott v. Standard Oil Co., 106 Ala. 475); "Aromatic Schiedam Schnapps" to gin (Burke v. Cassin, 45 Cal. 467); "Snowflake", to crackers and biscuit (Larrabee v. Lewis, 67 Ga. 561); "Cough Remedy" (Gilman v. Hunnewell, 122 Mass. 139); "Selected Shore Mackerel" (Trask v. Wooster, 28 Mo. App. 408); "Rye and Rock", to a mixture of rock candy and rye whiskey (Van Beil v. Prescott, 82 N. Y. 630); "Dessicated Codfish" (Town v. Stetson, 3 Daly [N. Y.] 53); "Headache Wafers" (Gessler v. Grieb, 80 Wis. 21); "Microbe Killer" (Allf v. Radam, 77 Tex. 530). Rubberoid easily falls in the above class, when applied to articles with no rubber in their composition, but appearing to have and possessing its qualities and characteristics."

To the above-mentioned cases, among others, might well be added the case of Rice-Stix Dry Goods Co. v. J. A. Scriven Co., 165 Fed. 639, in which case the majority opinion was written by Munger, D. J., and concurred in by Vandevanter, C. J. (Sanborn, C. J., dissenting).

In determining this case the term "electric-seam" was held to be descriptive, and the Court said, at page 643:

"In Trinidad Asphalt Manufacturing Company

> v. Standard Paint Company (decided by this Court August 11, 1908), 163 Fed. 977, are collated many cases illustrative of descriptive terms, and supporting the settled rule that no one can appropriate as a trade-mark a generic name or one descriptive of an article of trade, its qualities, ingredients or characteristics, or any sign, word or symbol which from the nature of the fact it is used to signify, others may employ with equal truth."

The Court arrived at the same opinion in the case of Newcomer v. Scriven, 94 C. C. A. 77, in which case Justice Lurton, then Circuit Judge, wrote the opinion.

Also the following cases may be considered: "Cresylic", when applied to an ointment made of soap (Carbolic Soap Co. v. Thompson, 25 Fed. 625); "Air Cell Fire Board", as applied to fire-proof covering (N. Y. Asbestos Mfg. Co. v. Ambler Asbestos Air Cell Covering Co., 9 Fed. 85); likewise the case of N. Y. Asbestos Mfg. Co. v. Ambler Asbestos Air Cell Covering Co., 62 N. Y. Supp. 639); "Stud", as applied to belt fastener (Green v. Mfrs. Belt Hook Co., 158 Fed. 640); "Porosknit", when applied to underwear (Chalmers Knitting Co. v. Columbia Mesh Knitting Co., 160 Fed. 1013); "Keep-clean", as applied to tooth brushes (Florence Mfg. Co. v. Dowd, 178 Fed. 73); "Pancreopepsine", as applied to the use of pancreatin and pepsin as a medicine (Searle & Hereth Co. v. Warner, 112 Fed. 674, affirmed in Warner v. Searle and Hereth Co., 191 U. S. 195); "Disque" or "Pile-Leclanche", as applied to electric batteries (Leclanche Battery Co. v. Western Electric Co., 23 Fed. 276); "Acid Phosphate", as applied to a medicinal preparation (Rumford Chemical Works v. Muth, 35 Fed. 524); "Ferro-Phosphorated Elixir of Calisaya Bark", as applied to a medicine (Caswell v. Davis, 58 N. Y. 223). Also cases upon the

general doctrine. See Coats v. Merrick Thread Co., 149 U. S. 562; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537; The Amoskeag Mfg. Co. v. Spear, 2 Sanford, Superior Court, 599.

There would seem to be no impropriety in referring to the fact that the distinguished judge—Sanborn—who dissented from his associates, has in his opinions, for years, held and promulgated views regarding trade-marks differing from the other judges of his court. These views are shown by opinions in the following cases: Shaver v. Heller & Merz Co., 108 Fed. 821; 48 C. C. A.; Wulf v. Hamilton, 165 Fed. 413; 91 C. C. A. 363; Rice-Stix Dry Goods Co. v. Scriven Co., 165 Fed. 639 (C. C. A.).

It appears from a comparison of the foregoing cases that the word "Rubberoid" is descriptive of not only the complainant's and the defendant's roofing, but that of about forty other concerns engaged in the same business. All of the products of these concerns possess some of the characteristics of India rubber, and from this fact were known to the trade as, and called by it, "rubber roofing", though in none of them was rubber an ingredient.

(A number of these were introduced as exhibits by appellee, and are now in the custody of the marshal of this court.)

3. The word "Rubberoid" is not a fanciful one, and owes nothing to the complainant for its existence or its descriptive form. It was part of our common vocabulary before complainant began operations. Its use appears in the Patent Office upon applications for compositions resembling but not containing rubber. The statement contained in complainant's trade-mark does not note the fact that it contains no rubber, but the

evidence of the complainant, both written and oral, is to that effect.

The witness Gifford, a librarian, who has devoted his attention to the study of words, testified as follows:

"Q. 8. I will ask you if you have looked up and considered the word "rubberoid" or "ruberoid"?

A. Yes, sir.

Q. 9. What do you understand to be the meaning of that word or words?

A. Something like rubber, or resembling rubber.

Q. 10. How do you arrive at that?

A. Simply because the suffix "oid" is a very common suffix in scientific terms, and has that distinct meaning, and nothing else. It means like, or resembling the word to which it is added as a suffix.

Q. 11. Is that the universal meaning of the suffix?

A. It is, so far as I know.

Q. 12. Can you illustrate that by words in common use?

A. Yes, sir; if you wish an example. I can illustrate it by several words. A very common one is "typhoid", which, in its origin means resembling typhus, and there are numerous examples in mathematics. "Sphereoid" means a figure that resembles a sphere, but is not a sphere, and "asteroid" means like a star, joined right on, of course, to the original word "*aster*". A common word that we hear of in geology is "amygdaloid". That simply refers to a geological structure in which there are certain cavities which resemble almonds in shape. That is where the name has come from, "resembling almond".

Q. 13. Have you examined dictionaries for this word 'rubberoid?' Have you found it?

Objected to as immaterial, incompetent and irrelevant.

A. I have found it in several dictionaries.

Further objected to on the ground that the dictionaries themselves would be the best evidence.

Q. 14. Have you the definition as it is in the Standard Dictionary?

A. I have. I have a copy of that.

Q. 15. Have you it here?

A. Yes, sir.

Mr. Green: That may go in as a correct copy.

Witness: I made a copy of the definition as given in the Standard Dictionary.

Q. 16. Just give it, please.

Witness reads 'Rubberoid: Compositions in imitation of commercial India rubber.' There were three forms given here—rubberite, rubberide and rubberoid.

Q. 17. What is the imprint of the copyright?

A. On this copy of the Standard Dictionary the copyrights are 1890, 1893 and 1894."

Judge Sanborn, writing the dissenting opinion in the court below, says:

> "The root of ruberoid is rubere, to be red, and some of its derivatives are rubify, rubific, rubescent, rubicund, rubidity."

This explanation of the word was discovered by the Judge and not by the complainant or its counsel. It has appeared that the word ruberoid was chosen by the complainant simply because it properly described the characteristics of its manufacture. It is also not apparent where the dissenting Judge found that "the record is clear and uncontradicted that the word ruberoid signified nothing to those who first saw it and heard it until the complainant taught the trade". The evidence is quite to the contrary and that their purpose in choosing the word was that it might be understood that it was like rubber. It is scarcely necessary to repeat the common English words in which the suffix "oid" is used to signify a resemblance. It would have been little more descriptive if the complainant had used as its trade-mark "rubberlike".

The fact that the complainant spelled it with one "b" instead of two can hardly make any difference. There is no rule or custom in the language which connects a consonant with a previous vowel in preference to a succeeding vowel. If it were important there could be given a very long list of words where the consonant is connected to and pronounced with the preceding vowel. It is such a slight change. It is not such a change as would attract the attention of anyone.

For similar reasons it was held that the word "Matzoon" could not be appropriated as a trade-mark for a medicinal beverage because of its similarity to "Madzoon" (Dadirrian v. Yacubian, 39 C. C. A. 321, 98 Fed. 872).

As the Court below said:

> "Before this controversy arose complainant publicly declared it selected the word ruberoid for a trade-mark because of the resemblance of its product to rubber. It advertised the fact to the world and pointed to the common characteristics. The truth of its statement is so obvious and the connection between the misspelled name and the thing so manifest we need not search for some remote likeness to other words found in the lexicons that have no possible application to the artificial roofing in question. That the roofing of complainant possesses characteristics of rubber in composition is plain to the most ordinary inspection, and it is also plain that the average person would take the word adopted as signifying that fact."

An inspection of the various "rubber roofings" shown by the exhibits now in possession of the Marshal of this court will prove the possession of such characteristics.

The defendant's trade-mark "RubberO" can scarcely be called a word. It is rather a "symbol". In order to

emphasize the ending of the word or symbol with a capital "O", it has been universally used with the letter "R" larger than the other letters of the word, thus making a striking symbol. It is so unusual to commence a word with a capital letter and also end it with one. It appears from the evidence (Record, pp. 52 and 54) that the defendant uses for its trade-marks words of a similar character. As for example: "Black RoofO," "ActiniO". These latter trade-marks were used for roofings which did not resemble rubber.

There has been some question raised as to the date when the complainant commenced to use the word "Ruberoid" upon its roofing. In its bill of complaint it alleges "that your orator for more than twelve years has been and is now engaged in the business of manufacturing, vending, exporting and otherwise dealing in a certain kind of roofing material for covering houses and other buildings called by them 'Ruberoid' roofing", and that it "more than twelve years since adopted, as a trade-mark and trade name, for said roofing, the word 'Ruberoid'." (Record, p. 8.)

This complaint was sworn to April 26, 1905. It would seem from this that the bill intends to allege that the complainant used this trade-mark prior to the 26th of April, 1893. If it had been the intention of the pleader to say that the trade-mark was adopted in 1891 he would have alleged 14 years instead of 12. This matter became important when defendant's first answer was filed and it was discovered that the word "Rubberoid" appeared in the dictionaries in 1890. And when Mr. Richards came to testify he testified as follows (Record, p. 13):

"Q. 7. I mean the Ruberoid roofing?

A. We began to manufacture Ruberoid roofing in 1891; that is, we put it on the market commercially. We manufactured it previous to that experimentally, but it was put on the market as a success in 1891, as Ruberoid. We manufactured it continually since that time, and it has increased very largely; there has been no cessation of manufacture.

Q. 27. Prior to the time when the Standard Paint Company adopted the word "Ruberoid" as a trade-mark or trade name, in 1891, do you know whether any other person, firm or corporation had ever used that word in connection with roofing materials?

A. I know they had not; that is, we never heard of it.

Q. 28. You would have heard of it at the time, if such a thing had existed, because of your intimate contact with the dealers in your capacity as salesman?

Defendant's Counsel: Question objected to as leading and showing that it is impossible that the witness could answer the question any way.

A. Covering the whole United States. I should have heard of it.

* * * * * * * *

XQ.1. As I understand you, you have been connected with the Standard Paint Company from its inception?

A. Between 11 and 12 years.

XQ. 2. You were not then with it at the time of the incorporation?

A. No, sir (Record, p. 22).

XQ. 34. Can you give the exact date when you became connected with the company?

A. August, 1904."

Attention of both witnesses Richards and Jellenik was called to Defendant's Exhibit Complainant's Advertisement No. 2, as follows:

Mr. Richards testified (Record, p. 29):

"XQ. 80. I show you a booklet and ask you what it is?

A. That is one of our issue of Ruberoid Roofing circulars.

Defendant's Counsel: I will ask the Notary to mark this, for identification, 'Defendant's Exhibit "Complainant's Advertisement, No. 2".' So marked.

XQ. 81. Can you tell about the date when it was issued, from an examination of it?

A. I can trace it; I can't tell now without tracing it. The way I can identify it is by the first picture, the launching of Emperor William's yacht; so it was later than 1902."

Mr. Jellenik testified (Record, p. 37):

"XQ. 42. You spoke about the time this roofing was first put upon the market and you stated that you could not state it accurately, but it was about 1891?

A. Yes, sir.

XQ. 43. Might it have been 1894?

A. Impossible.

XQ. 44. Well, then, you say about 1891——

A. (Interrupting) By which I wish to be understood as meaning a very few months either after 1891 or prior to the close of 1891 as the time when it first became to be commercially used.

XQ. 45. (Handing witness paper.) I call your attention to the statement in defendant's exhibit for identification, Complainant's Advertisement No. 2, being the first statement in the printed matter—I mean after the title page—when Ruberoid was first placed upon the market in 1892, it attracted considerable attention, and I ask you if you now notice that statement in that printed matter?

A. Yes."

Defendant's Exhibit Complainant's Advertisement No. 2 is as follows (Record, p. 79):

"RUBEROID.

When Ruberoid was first placed on the market in 1892 it attracted considerable attention, because it was the first and it is now the only prepared roofing made that could be used with equal efficiency on very light, temporary structures, or a large brick, stone or iron building."

Under this evidence it certainly will have to be conceded that the complainant did not use the word "Ruberoid" prior to the year 1892, at which date it was a word in common use to describe a material which bore a resemblance to rubber, but contained no rubber.

The reading of this record seems to make it clear that the complainant did not use the word claimed as a trade-mark until it had gone into general use by the world at large and that such use continued until the complainant registered its trade-mark and so on to the present time.

The opinion of the dissenting Judge in the decision below placed some emphasis on the alleged fact that the complainant has built up a large business, and states "that the defendant in 1904 commenced to make and sell a similar roofing under the name of 'rubbero' [RubberO], and the complainant's sales decreased $8,000 in the territory where the latter article was sold and nowhere else".

It is respectfully submitted that the evidence does not warrant any such statement. The only testimony regarding the matter was that of an attorney. Felix Jellenik (Record, p. 31). His testimony upon this subject is found on pages 34 to 37. The cross-examination is as follows:

"A. I know that there are roofings similar in appearance to that manufactured by the complainants, offered and sold on the market.

XQ. 6. How can you, then, say that it is the effect of the sale of defendant's material that has lessened the sale of the complainant's material?

A. Because, as I have testified, there has been a falling off in the district in which this defendant's roofing is offered and sold.

XQ. 7. Are not these other roofings, to which reference has been made, sold in the same district?

A. I don't know.

XQ. 8. Do you know in what district the defendant company sells its goods?

A. Only in a general way; that it is the country contiguous to St. Louis.

XQ. 9. You do not know, then, to what extent they sell their goods?

A. I do not.

XQ. 10. At what points has the falling off occurred?

A. Within that territory, the exact limits of it I cannot specify.

XQ. 11. Well, you mean the State of Missouri, for instance?

A. Yes.

XQ. 12. How has there been a falling off in the State of Missouri?

A. That I cannot tell you specifically.

XQ. 13. What other districts did you refer to?

A. I would not undertake to name them, that is not a part of the complainant's business that I give any attention to as a rule.

XQ. 14. You, then, are not familiar, as a matter of fact, with the extent to which there has been any falling off, yourself?

A. I can only tell it from the records of the complainant company, which show about the sales made by our agents at St. Louis and in that territory.

XQ. 15. Well, how much at St. Louis?

A. I haven't got any detailed figures; I only know about the total amount.

XQ. 16. Do you know how much the sales of the Graham Paper Company had fallen off?

A. Not specifically, no.

XQ. 17. You know them, as your representatives, at St. Louis?

A. I believe they are the agents of the complainant company.

XQ. 18. You cannot give us any idea of the amount of falling off at St. Louis, can you?

A. I cannot.

XQ. 19. Or in Missouri?

A. I cannot.

XQ. 20. Or in any other state, surrounding?

A. No.

XQ. 21. This is not a part of your share in the business, I suppose, either?

A. No.

XQ. 22. So that, what you know about it is what you have been told by some one else connected with the company?

A. No; from reading the reports of our agents and from the amount of sales shipped to that territory; and I get the money for those sales.

XQ. 23. Do you mean to say that you yourself can testify anything in regard to the falling off of the sales at St. Louis, or in Missouri?

A. Only from the sources that I have named.

XQ. 24. Well, from those sources, how much has been the falling off?

A. As far as I know, about $8,000.

XQ. 25. How did you learn that; do you mean that that is the falling off in the Graham Paper Company's business?

A. From that territory; I don't know whether the complainant company also sells goods through traveling agents of its own in that territory or not; I am not familiar with its manner of doing business there.

XQ. 26. When you use the words "$8,000.00" from that territory, what territory do you mean?

A. The territory covered by the agencies established at St. Louis and thereabouts.

XQ. 27. Well, what do you mean by thereabouts?

A. I mean the surrounding country.

XQ. 28. Do you mean the State of Illinois?

A. I cannot tell whether that is a part of that territory or not; I don't know.

XQ. 29. Do you mean the whole State of Missouri?

A. I don't know as to that.

XQ. 30. Do you mean Arkansas or Kentucky? Can't you explain it on the record?

A. I can explain that my source of information is simply that from the moneys received from the western sales coming from the region of St. Louis, St. Louis and the country thereabouts, there have been about $8,000, or perhaps a little more, that we have received less in the last few months than in the corresponding period of last year.

XQ. 31. In order that we may understand about it, "Western" is a very large word. You don't mean to include Chicago or west of that, do you?

A. I cannot say; I only know that is the territory to which my testimony relates, but its outlines I cannot give you; I don't know specifically just what it does include.

XQ. 32. Then, as a matter of fact, you don't know whether the falling off has been in the places where the defendant company has made sales or not, do you?

A. I do know that, because I know of sales it has made in territory very close to St. Louis.

XQ. 33. And you don't know where its sales are made, do you?

A. Not except in the specific instances in which I heard about it.

XQ. 34. Those specific instances were at St. Louis?

A. I really don't just now recollect where the specific instances were, but I received the impression at the time I heard of it that they were at St. Louis or to some people in that territory.

XQ. 35. Now, you are a lawyer, and I wish you would state it in such a manner that we can understand exactly what you do mean?

A. Well, I must answer that I think I have stated it very clearly already.

XQ. 36. I understood you to say in answer to my previous question, that you did not know in regard to it specifically. Do I understand you correctly?

A. I did not know except in the manner in which I have already testified I received the information.

XQ. 37. From whom was that information received?

A. From the cashier of the complainant company as to the moneys received and from Mr. Richards as to the sales in that territory.

XQ. 38. Mr. Richards is familiar with this whole matter, isn't he?

A. I think he is; he ought to be.

XQ. 39. Much more familiar with the facts are garding it than you are?

A. Certainly.

XQ. 40. And the agents of the company at St. Louis and thereabouts would be able to make this thing much more clear than you can?

A. They may be more specific as to the facts and places, but not as to the results to which I have just testified.

XQ. 41. Well, you got it, as I understand, from the cashier and from Mr. Richards?

A. Yes, sir."

It appears therefore that this witness himself knew nothing about this matter. Mr. Richards, who was on the stand as a witness, was not interrogated about the matter. The other employes of the company were not put upon the stand, excepting Mr. Porter of St. Louis, whose testimony regarding the matter was as follows (Record, p. 45):

"Q. Have you brought with you today a statement of the sales by your company of 'Ruberoid' roofing?

Objected to by Mr. Green, as we had not gone into that.

A. No, sir.

Q. Have you looked into that question at the suggestion of counsel?

A. No, sir.

Q. Have you looked into it at the suggestion of the New York office of the Standard Paint Company?

A. No, sir.

Q. Have you made any statement to them regarding the sales and the comparison between the sales of the last year and the sales for the year before?

A. No, I don't remember of any statements. They keep all the records of our sales; they don't ask us for what they are. They know better than we do."

It is respectfully submitted that under such evidence as this it must certainly be regarded that there is no proof of any decline in the sales of the complainant caused by sales of the defendant.

INFRINGEMENT.

4. In all cases where exclusive rights to trade-marks are invaded it is invariably held that the essence of the wrong consists in the sale of goods of one manufacturer or vendor for those of another, and that it is only when this false representation, directly or indirectly, is made that a party who appeals to a court of equity can have relief. This doctrine is equally true when applied to what is termed "unfair or fraudulent competition" in business.

> "So it cannot be said that the defendants were personating the complainants' business by using such a description or brand as to lead customers to suppose that they were trading with the appellant. Even in the case of a valid trade-mark, the similarity of brands must be such as to mislead the ordinary observer."
>
> Columbia Mill Co. v. Alcorn, 150 U. S. 460, 467.

The rule seems to be clearly settled as to the method of determining in what case one trade-mark is the infringement of another. The only difficulty is in applying the rule. We have cited a number of cases under the IVth point of our brief, if the Court should find it necessary or convenient to make reference to decisions upon this subject.

We do not believe that this Court will enter into the question of unfair competition. Indeed, this Court has decided that it has no jurisdiction upon an appeal of this question. Leschen Rope Co. v. Broderick, 201 U. S. 166.

However, in the Court below an argument was made upon this question, and we have therefore set forth the distinctions between the label of the complainant and that of the defendant.

Apparently the only allegation of similarity in the Bill of Complaint, and the only proof of such similarity, rests in the widths and thicknesses of the rolls of roofing. It will have to be conceded that both complainant's and defendant's roofings, as well as a vast number of other kinds of "ready roofing", are similar in appearance and are cut into widths and are made into rolls similar in form.

Upon this subject the answer states as follows:

> "This defendant says that it is true that the roofing of complainant and defendant are both cut into widths and made into rolls similar in form, and that their similarity is the same as that used by all manufacturers of ready made roofing." (Record, p. 49.)

This is testified to by complainant's manager, James N. Richards. On page 28, referring to a large number

of kinds of rubber roofing of which he has testified, he says:

> XQ. 56. These which you have heard of, like your own roofing, contain no rubber, I suppose? A. Personally, I have no knowledge of what they contain. It is the appearance and the representation of the name would be the only thing that would attract my attention, as they would appear in the market.
>
> XQ. 57. They have the same appearance, have they? A. The roofings spoken of; yes, sir.
>
> XQ. 58. These are put out, are they, in the market in a way similar to Ruberoid—I refer, of course, to the rolls? A. Well, for that matter, all prepared roofing is put out in the same way, all in rolls; it is the universal custom.
>
> XQ. 59. Prepared roofing has been put up in rolls, I suppose, for a great many years? A. Yes. Tarred felt roofing and the asphalt gravel surface roofings have all been put up in rolls and put on the market in the same way.
>
> XQ. 60. For how many years have you known this to be done; the tarred felt roofing, for instance? A. I presume, as far as I know, as long as I have been connected with the trade it has been done.

And again, on re-examination (Record, p. 28):

> By Mr. Briesen (Q. 64.) Can you state the names of some of the other felt roofings that are on the market and that do not contain any sound like or resemblance to the word "Ruberoid?" A. Yes, sir—the Amitite Roofing, the Lincoln Roofing, the Flint-kote Roofing, and they make also a similar kind that they call Rexoid. There are various others.

Re-cross examination, by Mr. Homer (Record, p. 31):

> XQ. 92. These roofings that you have just mentioned, they are similar in their appearance to the

roofing of the complainant? A. The appearance is similar; yes, sir.

XQ. 93. The form in which they are put up is the same, is it? A. Very much the same. They are all put in rolls.

And defendant's manager, Mr. Terpening, testified to the same effect, as follows (Record, p. 50):

Q. 26. State whether there is known in the trade a variety of roofings which go under the general name of "rubber roofings?" A. There are very many of them; as many as forty.

Q. 27. State whether you are familiar, to any extent, with the materials of such roofing? A. I am.

Q. 29. State whether or not they are made of rubber? A. There are none of them, so far as my knowledge extends, that contain any rubber.

After the introduction of several rolls of rubber roofing, viz: Compo Rubber Roofing, Period Roofing, Indruroid Roofing, Perfection Rubber Roofing, Galvanized Rubber Roofing, Flint-kote Roofing, Original Rubber Roofing, the witness continued (Record, p. 51):

Q. 40. State whether all of the various roofings which are shown to you are put up and sold in substantially the same manner as the roofing of the complainant? A. Yes, sir.

Q. 41. Are they sold under different plys? A. yes, sir.

Q. 42. What are the usual plys which are sold? A. One, two and three-ply; some of them half plys.

Q. 43. State whether the exterior appearance of these rolls is similar to that of the complainant's? A. In my opinion, it is.

The form of the rolls and of the material being made in various thicknesses seems to be the only ground alleged of similarity in which the manu-

factured product is presented to the public. A reading of the bill does not lead one to the conclusion that the counsel who prepared the same expected to make any claim of unfair competition, and the objections to evidence, as indicated by the counsel in New York, are to the same effect. As it is said on page 24:

> "Complainant's Counsel: This whole line of testimony objected to; it is quite immaterial to any issue in this suit, which is purely a trade-mark suit, involving the word 'Ruberoid', and the imitation thereof."

However, as counsel argued this question before the trial court, it may be necessary to consider it here.

The wrapper and label of the goods are dissimilar in every respect. The wrapper of the complainant is light brown manila and that of defendant is a bright red. The printed matter on the complainant's wrapper is stenciled or printed immediately upon the wrapper, while that of defendant is a bright green label, which is pasted upon the roll. The size of the complainant's printed matter is 19 inches by 12 inches, while that of defendant is 11 inches by 10 inches. The latter has a line around the whole label making a kind of frame work. The type of the complainant is described by a witness as follows:

> "It is a plate which is known as a reverse plate, showing the brown through black, while that of the defendant is black type upon a green label."

The inspection of the two labels shows that no person ever could be deceived into buying defendant's product for that of complainant's.

The printing upon complainant's roll, being in a large black rectangle, is as follows (reduced in size):

"STAND ON END.
"RUBEROID
(Trade-Mark Registered)
"ROOFING
"Strong, Durable and Easy to Lay
"Unaffected by Changes of Temperature.
"NO TAR.
"Outlasts Tin and Iron.

"Directions for Laying inside of each Roll
Copyrighted by The Standard Paint Company, 1901.
"STAND ON END.
" 'Ruberoid' appears every four feet on under side of all genuine Ruberoid Roofing.
(Trade-Mark Registered.)
"The Standard Paint Company,
"Sole Manufacturers."

On opposite page is the defendant's label (reduced in size):

It appears on the defendant's label that the roofing is manufactured only by Trinidad Asphalt Mfg. Co., St. Louis, Mo., U. S. A., the name of the manufacturer appearing prominently twice on the label. A very marked feature of this label is the picture of a bull dog. The fact that this picture of a bull dog is a distinguishing feature of the label is emphasized by the testimony of the complainant's manager (Record, p. 22):

> Q. 63. I call your attention to the second inside page of Exhibit, "Defendant's Circular", and ask you to state how the roll of roofing represented there in an upright position corresponds with the appearance of the roll of roofing made by the Trinidad Asphalt Manufacturing Company? A. My recollection is that it is the same. I identify it by the Bull Dog brand, and the word "RubberO" was on it. In general appearance it is the same.

(A roll of complainant's and a roll of defendant's roofing was introduced in evidence by defendant, and these exhibits are now in the custody of the Marshal of this court, and may be examined.)

It is not at all necessary that this brief should be extended for the purpose of reiterating the differences between the two labels, as they are different in all respects There are, indeed, no resemblances.

> "Certainly, an ordinarily intelligent man, able to see and read, and willing to take a few seconds of time to examine the two brands, would inevitably discover that one was made by the complainant and the other by the defendant."
>
> (E. Regensberg v. Juan F. Postuorade Mfg. Co., 136 Fed. R. 966.)

In examining this question it must be taken into consideration that the purchaser of roofing does not buy a single roll, but that he buys a large amount, sufficient to cover a building. His attention, therefore, would be brought more markedly to the name than in case of a buyer purchasing a single article from a grocer, or any other retailer of small goods.

Regarding the two words, "Ruberoid" and "RubberO", the differences seem to be marked. If it be maintained by the complainant that its word is pronounced "Ru-beroid", then there is, of course, no great similarity in sound. As the burden rests upon the complainant to show to the satisfaction of the Court that there is such a similarity in these trademarks as would deceive the ordinary purchaser purchasing with ordinary care, the defendant would have a right to insist upon these differences in sound without being inconsistent with the argument already made, regarding priority of use.

The defendant's word or symbol is a strikingly un-

usual one. It is distinctly fanciful, made by adding the capital "O" to the word "rubber". Conceding that defendant had the right to use the word "rubber", and the broad occupation of the field by the great variety of names and forms in which the word "rubber" is used, it is not easy to see what better or more distinctive word it could have chosen. As the words are written and pronounced the emphasis both to the eye and to the ear is upon their final syllables.

Certainly, under this trade-mark of the defendant it has never been able, and never will be able, to palm off its goods as the goods of the complainant.

Appellee, therefore, respectfully prays this Court to dismiss appellant's appeal or affirm the judgment of the Circuit Court of Appeals.

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